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TRANSCRIPT OF RECORD.

SUPREME COURT OF THE UNITED STATES.

OCTOBER TERM, 1886.

No. ~~180.~~ 164

JOHN W. BURT AND FRED. PACKARD, APPELLANTS,

vs.

ALEXANDER F. EVORY, ALONZO HESTON, AND J. B. BELCHER.

APPEAL FROM THE CIRCUIT COURT OF THE UNITED STATES FOR THE DISTRICT OF MASSACHUSETTS.

FILED OCTOBER 12, 1886.

SUPREME COURT OF THE UNITED STATES.

OCTOBER TERM, 1888.

No. 439.

JOHN W. BURT AND FRED. PACKARD, APPELLANTS,

vs.

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INDEX.

	Original.	Print.
Caption	1	1
Bill of complaint	2	1
Answer	8	5
Replication	9	7
Decree for injunction and account	10	7
Motion for dissolution of injunction	12	8
Master's report	13	8
Defendants' exceptions to master's report	31	21
Complainants' " " "	32	21
Petition for rehearing	32a	22
Final decree and defendants' appeal	33	23
Evidence for complainants	34	23
Deposition of Henry L. Brevoort	35	24
Evidence for defendants	44	30
Deposition of Edward Crocker	44	31
Albert H. Spencer	48	33
Evidence for complainants in reply	68	48
Deposition of Henry L. Brevoort	68	48
Further evidence for defendants	80	56
Deposition of Fred. Packard	80	58
Exhibits	82	58
Complainants' Exhibit Assignment—Assignment of Evory & Heston to Belcher, January 26, 1877	82	58

JUDD & DETWEILER, PRINTERS, WASHINGTON, APRIL 25, 1889.

	Original.	Print.
Defendants' Exhibit Babbitt—Letters Patent of the United States, granted Samuel Babbitt, No. 46,622, dated March 7, 1865—"Improvement in Gaiter Boots"	83	58
Letters Patent of the United States, No. 59,375, granted Alexander F. Evory and Alonzo Heston, dated Nov. 6, 1866—"Improvement in Boots and Shoes." (Complainants' Exhibit No. 1.)	85	60
Letters Patent granted David Brown and Wm. S. Wooton, No. 49,076, dated Aug. 1, 1865—"Improvement in Shoes." (Defendants' Exhibit Brown & Wooton.)	86	60
Letters Patent granted Fred. Packard, No. 205,129, dated June 18, 1878—"Improvement in Shoes or Gaiters." (Complainants' Exhibit No. 2.)	88	64
Opinion of the Court	89	65
Rescript	92	67
Assignment of errors and prayer for reversal	93	77
Clerk's certificate	95	68
Bond to party	96	68
Citation	97	69
Acknowledgment of service of citation	98	70

1 UNITED STATES OF AMERICA, } ss:
Massachusetts District, }

At a circuit court of the United States for the first circuit, begun and holden at Boston, within and for the district of Massachusetts, on Thursday, the fifteenth day of October, in the year of our Lord one thousand eight hundred and eighty-five, before the Honorable Le Baron B. Colt, circuit judge.

In Equity.

ALEXANDER F. EVORY *et al.*, Complainants,
v.
JOHN W. BURT *et al.*, Defendants.

The bill of complaint in this cause was filed in the clerk's office on the ninth day of December, A. D. 1880, and was duly entered at the October term of this court, A. D. 1880, and is in the words and figures following:

2 *Bill of Complaint.*

(Filed Dec. 9, 1880.)

To the honorable the judge of the circuit court of the United States for the district of Massachusetts, in the first circuit:

Alexander F. Evory, a citizen and resident of the State of New York; Alonzo Heston and J. B. Belcher, citizens and residents of the State of Michigan, all citizens of the United States, bring this their bill against John W. Burt and Fred. Packard, composing the firm of Burt & Packard, and doing business in the town of Brockton, State of Massachusetts.

And thereupon your orators complain and say that heretofore and before the sixth day of November, 1866, your orators, Alexander F. Evory and Alonzo Heston, being then citizens of the United States, were the true, original, and first inventors or discoverers of a certain new and useful invention, to wit, an improvement in boots and shoes, and that the said invention was not known or used by others before their invention or discovery thereof, and was not at the time of the application for letters patent therefor in public use or on sale with the consent or allowance of your said orators as the inventors and discoverers thereof, contrary to the provisions of the statutes of the United States in such case made and provided.

3 That your said orators made application in writing to the Commissioner of Patents of the United States for the granting of letters patent for said invention and paid into the Treasury of the United States the fees required by law, and then and there also duly complied in all other respects with all the necessary conditions and requirements of the statutes of the United States in such case made and provided, prior to the granting of the letters patent hereinafter mentioned.

That on the sixth day of November, 1866, letters patent of the United States, bearing date on that day, were issued to your said orators, Evory and Heston, according to law, whereby there was granted to them and their heirs, executors, administrators, or assigns, for the term of seventeen years from the sixth day of November, 1866, the full and exclusive right and liberty of making, constructing, using, and vending to others to be used the invention or discovery aforesaid, a description whereof was given in the words of your said orators in the schedule annexed to the said letters patent and was made a part of the same.

That the said letters patent were issued in the name of the United States of America, and were signed by the acting Secretary of the Interior, and were countersigned and sealed with the seal of the Patent Office by the Commissioner of Patents, and were numbered 59375, and were issued and delivered to your said orators, Evory and Heston.

That thereupon, after the issuing of the said letters patent as aforesaid, your said orators put the invention into use and manufactured large numbers of shoes embodying said invention, and granted licenses to others so to do in cases where they deemed it advisable so to do and when such licenses could be granted by them without detriment to their own business.

And your orators pray that said letters patent and the schedule annexed thereto as aforesaid may be deemed and taken as part of their bill, and to the originals of said letters patent and schedule or a duly authenticated copy thereof, now in your orators' possession and ready to be produced, they crave leave to refer; and your orators

4 show that by assignment in writing, dated Jan. 26, 1877, duly signed, delivered, and recorded in the Patent Office by your orators, Evory and Heston, your orator, J. B. Belcher, became and now is the owner of an undivided one-half part of all of the right, title, and interest in said letters patent and all claims for infringing of the same.

And your orators further show that said letters patent have been in controversy in several suits in equity in the circuit courts of the United States, have been uniformly sustained as against all defences, and large numbers of persons have acquiesced in the rights of your orators under the same.

And your orators further show that by instrument in writing, duly executed and recorded in the Patent Office, your orators, the said Evory and Heston, granted to your orator, The National Rubber Company, the exclusive right to manufacture and sell boots and shoes made of rubber and containing the invention described and claimed in said letters patent.

And your orators, the said Evory and Heston, have ever since the date of said patent, and the National Rubber Company has ever since the date of said license, been and now are entitled to all the rights, interests, and privileges thereby secured unto them in and to the said invention or discovery in the said letters patent and license particularly set forth, and are now and ever since the dates thereof

have been entitled to the exclusive use of the said invention and improvement within the limits aforesaid.

And your orators further show unto your honors that the said invention or discovery so patented aforesaid unto the said Evory and Heston is of very great utility, and that the same has been extensively introduced into public use, and that the public have generally acquiesced in your orators' exclusive right to the same; and your orators would, but for the wrongful acts of the said defendants and others acting in concert with them, have made large gains, profits, and advantages from the manufacture, use, and sale of the said invention; and your orators would, but for the wrongful acts and doings of the said defendants and others acting in concert with them, now be enabled to use the said improvement in boots and shoes, to which they are entitled to the exclusive right as aforesaid, with profit and advantage, but that by the said wrongful acts and doings they are now prevented and hindered from so doing.

5 And your orators further show unto your honors, upon information and belief, that the said defendants, well knowing the premises and the rights and privileges secured unto your orators, and in order to deprive them of the profits, benefits, and advantages which might and otherwise would have accrued to them, at the town of Brockton, Mass., and elsewhere, and within the said district of Massachusetts and elsewhere, and without the license and permission of your orators, have, ever since the sixth day of November, 1866, unlawfully and wrongfully made or caused to be made, sold or caused to be sold, used or caused to be used, shoes or gaiters constructed in accordance with the description and drawing of letters patent granted to the defendant, Frederic Packard, dated June 18, 1878, No. 205,129, and also other shoes and gaiters, each and all containing the said invention, discovery, improvements, and combinations, consisting, as therein in the schedule of your orators' letters patent No. 59375 set forth, of "a shoe when constructed with an expansion-gore flap, C D, the external fold C of which is attached to and in front of the quarter B, and the internal fold D of which is attached to and in rear of the vamp A, the said several parts and pieces being respectively constructed and the whole arranged for use substantially in the manner and for the purpose set forth," the exclusive right to which is secured to your orators, as hereinbefore set forth, and which said unlawful making, use, and sale by the defendants as aforesaid is a violation and infringement of your orators' exclusive rights and privileges, and that the said defendants have derived and received and are still deriving and receiving from such use great gain and profit, but to what amount your orators are ignorant and cannot set forth, but your orators pray that the defendants may be required to make a disclosure of all such gains and profits.

And your orators in like manner aver that the defendants, though requested to desist from such unlawful use and to pay to your orators such gains and profits as the defendants have actually made, refuse so to do; by means whereof your orators are and have been greatly injured, and are now prevented from putting the said invention or discovery into successful operation, and are deprived and

prevented from receiving the gains and profits to which they are lawfully entitled from the exclusive rights and privileges so
6 granted and secured to them as aforesaid, and which they would have derived and acquired and would now derive and acquire but for the said wrongful acts of the said defendants.

And your orators pray that the said defendants may be compelled, by a decree of this honorable court, to account for and pay over unto your orators all such gains and profits as have accrued or arisen to or been earned or received by the said defendants, and all such gains and profits as your orators would have received but for the said wrongful acts and doings of the said defendants, and all damages your orators have sustained thereby; and that this honorable court will assess the same or cause them to be assessed under its direction, and will increase the same, in its discretion, as provided by law.

And that the defendants, their associates, attorneys, solicitors, clerks, servants, agents, and workmen, may be perpetually enjoined and restrained by the decree of this court from directly or indirectly making or causing to be made, using or causing to be used, or vending to others to be used, in any manner, any boots and shoes containing or embodying the said invention granted by the said letters patent as issued aforesaid, and from infringing upon or violating the said letters patent by the use or sale of the said boots and shoes in any way whatsoever; and that the said defendants may be decreed to pay the costs, charges, and disbursements of this suit; and that your orators may have such other relief as the equity of the case may require and as to your honors may seem meet.

To the end, therefore, that the said defendants may, if they can, show why your orators should not have the relief hereby prayed, and may full, true, direct, and perfect answer make, according to the best of their or their clerks' agents' or workmen's knowledge, remembrance, information, and belief, to the several matters hereinbefore averred and set forth, as fully and particularly as if the same were here repeated paragraph by paragraph and they were severally and specifically interrogated, may it please your honors to grant to your orators a writ of *subpœna ad respondendum*, issuing out of and under the seal of this honorable court, directed to the said defendants, John W. Burt and Frederic Packard, com-
7 posing the firm of Burt & Packard, commanding them to be and appear and make answer unto this bill of complaint, and to perform and abide by such order and decree herein as to this court may seem required by the principles of equity and good conscience.

May it also please your honors to grant to your orators a provisional or preliminary injunction, issuing out of and under the seal of this honorable court, enjoining and restraining the defendants, their attorneys, solicitors, clerks, servants, workmen, and agents, to the same purport, tenor, and effect hereinbefore prayed for in regard to said perpetual injunction.

And your orators will ever pray, etc.

ALEXANDER F. EVORY,
J. B. BELCHER,
By BETTS, ATTERBURY & BETTS, *Att'ys.*
ALONZO HESTON,
By BETTS, ATTERBURY & BETTS, *Att'ys.*

BETTS, ATTERBURY & BETTS,
Complainants' Solicitors.
FREDERIC H. BETTS, *Of Counsel.*

UNITED STATES OF AMERICA, } ss:
South. District of New York, }

On this seventh day of December, 1880, before me came Alexander F. Evory, to me personally known, who, being by me duly sworn, did depose and say that he is one of the complainants in the foregoing bill of complaint named, and that he has read the said bill subscribed by him and knows the contents thereof, and that the same is true of his own knowledge except as to matters which are therein stated to be on information and belief, and as to those matters he believes it to be true.

ALEXANDER F. EVORY.

Sworn to before me this seventh day of December, 1880.

THOMAS HUNT,
[SEAL.] *Notary Public, New York County, New York State.*

8 On the twenty-second day of January, A. D. 1881, the following answer was filed:

Answer.

(Filed Jan. 22, 1881.)

The answer of John W. Burt and Fred. Packard to the bill of complaint of Alexander Evory, Alonzo Heston, and J. B. Belcher.

The respondents, saving and reserving to themselves the benefit of exception to the many and manifest uncertainties of the said complainants' bill of complaint, for answer to such parts thereof as they are advised it is a material for them to answer, say—

That they believe that on the sixth day of November, 1866, letters patent of the United States were granted to said Evory and said Heston, as alleged in said bill of complaint; but whether the said Belcher acquired any title or interest in and to said letters patent they have no information except by reason of the allegations of said complainants; but these respondents deny that said Evory and Heston are the original and first inventors of a shoe constructed with an expansive gore flap attached to the rear of the vamp for the purpose of excluding dirt or water, as in and by said letters patent is alleged; and they deny that they have made, used, and sold or

caused to be made, used, and sold shoes and gaiters constructed in accordance with the description and drawing of said letters patent; and they deny that they have in any way infringed said letters patent or in any way deprived the said complainants of any right to which they may be entitled by virtue of the grant thereof.

These respondents, further answering, admit that they have made and sold shoes or gaiters constructed according to the invention shown and described in letters patent of the United States, granted to Fred. Packard June 18, 1878, and numbered 205,129, but they deny that the making and vending of such shoes or gaiters was or is in violation of the rights of said complainants under the letters patent alleged to belong to them.

These respondents, further answering, say that the alleged invention of the said Evory and Heston is fully shown and described in certain printed books or publications—that is to say, in a patent issued from the Patent Office of England to —— ——, and
9 numbered 1954, of the year 1860; and also in a patent granted to —— ——, and numbered 185, of the year 1856.

These respondents, further answering, say that shoes or gaiters constructed in the manner shown and described in and by said complainants' bill of complaint and by their alleged letters patent were made and sold in this country by Jacob O. Patten, of Philadelphia, in the State of Pennsylvania, from 1856 to 1861.

Therefore these respondents deny all and singular the material allegations of said bill of complaint, without this, that there is any other thing material to be confessed, traversed, or denied, and not herein confessed, traversed, or denied, in said bill of complaint contained, and pray to be hence dismissed with costs in their behalf most wrongfully sustained.

JOHN W. BURT.
FRED. PACKARD.

GEO. D. NOYES,
Of Counsel for Respondents.

UNITED STATES OF AMERICA, *District of Massachusetts:*

On this twentieth day of January, 1881, personally appeared John W. Burt and Fred. Packard, who, being duly sworn, made oath that the allegations of the foregoing bill of complaint are true except so far as made on information and belief, and as to them they believe them to be true.

Before me—
[SEAL.] HAMILTON L. GIBBS,
Notary Public.

On the twenty-fifth day of February, A. D. 1881, the following replication was filed:

Replication.

(Filed Feb. 25, 1881.)

The replication of the complainants to the answer of the respondents.

The repliants, saving and reserving unto themselves, now and at all times hereafter, all and all manner of advantage of exception to the manifold insufficiencies of the said answer, for replication thereunto say that they will aver and prove their said bill to be
10 true, certain, and sufficient in the law to be answered unto, and that the said answer of the defendants is uncertain, untrue, and insufficient to be replied unto by the repliants, without this, that any other matter or thing whatsoever in the said answer contained material or effectual in the law to be replied unto, confessed and avoided, traversed or denied, is true; all which matters and things the repliants are and will be ready to aver and prove as this honorable court shall direct, and humbly pray as in and by their said bill they have already prayed.

BETTS, ATTERBURY & BETTS,
120 *Broadway, New York City, Complainants' Solicitors.*

This cause was thence continued from term to term to the October term, 1882, when, publication of the testimony having passed in the clerk's office, this cause was set down for hearing and fully heard; and on the third day of February, A. D. 1883, the opinion of the court was announced and the following decree entered in accordance therewith.

Decree for Injunction and Account.

This cause came on to be heard at this present term upon the pleadings and proofs, and was argued by counsel for the respective parties; and now, upon consideration thereof, to wit, Febru-
11 ary 3, 1883, it is ordered, adjudged, and decreed as follows, viz., that the letters patent referred to in the complainants' bill, being letters patent of the United States granted unto the said Alexander F. Evory and Alonzo Heston, No. 59375, for a new and useful improvement in boots and shoes, dated November 6, 1866, is a good and valid patent, and that the said Evory and Heston were the original and first inventors of the improvements described and claimed therein, and that the said defendants have infringed the said patent and upon the exclusive rights of the complainants under the same.

And it is further ordered, adjudged, and decreed that the complainants recover of the defendants the profits which they have received or made or which have accrued to them from said infringement by the manufacture, use, or sale of the improvement described and secured by said letters patent at any and all times since the sixth day of November, A. D. 1866, and, in addition thereto, the damages which the complainants have sustained thereby.

And it is further ordered, adjudged, and decreed that it be referred to Henry L. Hallett, Esq., a master of this court, to take and report to the court an account of the profits which the said defendants have received or which have arisen or accrued to them from the infringement of the patented invention by unlawfully making, using, or vending the same as alleged in the bill, and to ascertain and report the damages, if any, in addition to the profits which the complainants have sustained thereby since the sixth day of November, A. D. 1866.

12 And it is further ordered, adjudged, and decreed that a perpetual injunction be issued against the defendants according to the prayer of the bill.

And it is further ordered, adjudged, and decreed that the complainants recover of the defendants their costs of suit.

This cause was thence continued from term to term to the October term, 1883, when, to wit, November 19, the following motion was filed:

Motion for Dissolution of Injunction.

(Filed Nov. 19, 1883.)

And now comes the said defendants and move that the injunction heretofore granted in said cause be dissolved.

And for cause for the dissolution of said injunction the defendants say that it appears from the record that the patent in suit was granted Nov. 6th, 1866, and that it has expired.

JOHN W. BURT,
FRED. PACKARD,
By GEO. D. NOYES,
Sol'r & of Counsel.

On the same day, it appearing that notice of said motion was given to the complainants, the same was allowed by the court.

This cause was thence continued to the May term, 1884, when, on the thirteenth day of October, the following report of the master was filed:

13 *Master's Report.*

(Filed Oct. 13, 1884.)

To the honorable the judges of said circuit court:

I, Henry L. Hallett, the master to whom the above-entitled cause was referred by a decree of said circuit court, dated February 3, 1883, report in print. The following papers were filed before me:

Defendants' account.
Complainants' charge.
Defendants' discharge.

Defendants' Account.

(Filed March 24, 1883.)

The undersigned, in pursuance of notice from the master, to whom the above cause was referred by the decree of the court therein, to file a statement in detail of the number of shoes made by them embodying the invention described in letters patent granted to Evory & Heston November 6, 1886, No. 59375, and of the dates when such sales were made, and of the names of the parties to whom sold, and of the gains, profits, and advantages which have
14 arisen or accrued from the alleged infringement, respectfully file the following statement:

That between the years 1873 and 1878 they were manufacturing a shoe known in the trade as the Alexis shoe; that since that year last mentioned they have made 49,406 pairs of the said Alexis shoe, some of which contained a gore piece attached to the front edge of the quarter and the rear edge of the vamp, on each side of the shoe; and that they have not made or sold any other shoes embodying the invention supposed to be contained in said patent. The shoes containing the invention were sold at the same price with those without it, and no separate account was kept of the two classes, although the cost of the new style was a little in excess of the old. Our books do not show the cost of the shoe alleged to infringe, nor any receipts therefrom, nor any gains, profits, or advantages by reason of the construction of the new style, and we have received no such gains, profits, or advantages as are mentioned in the notice given, as aforesaid, in pursuance of said decree. We hereby offer and submit our books and accounts to the examination of the complainants in said cause, and to give them any other information they desire touching the matters enquired of.

JOHN W. BURT.
FRED. PACKARD.

Complainants' Charge.

(Filed June 22, 1883.)

The complainants complain of the defendants and charge, by their solicitors, Betts, Atterbury & Betts—

1. That the defendants have made, since 1878, the date of the Packard patent, 49,406 pairs of Alexis shoes.

2. That of said shoes, 49,406 pairs, 48,000 embody and contain the invention described and claimed in the letters patent granted to Evory & Heston and in this case in suit.

3. That said shoes were manufactured and sold in the market in direct conflict with the manufacturers and sales of the shoes made by the complainants herein.

15 4. That the profit realized by the defendants on such shoes was at least fifty cents per pair.

5. That said profit, but for wrongful manufacture and sale of the

defendants' shoes, could have been made and realized by the plaintiffs.

6. That the use of the invention of the complainants increased the sale of said Alexis shoes, and the patented improvement was the reason of their marketability in the market, where they were in conflict with the shoes made by the complainants or their licensees.

7. That the improvement introduced in defendants' shoes in infringement of complainants' patent was the reason of the marketability and sale of said shoes manufactured by the defendants.

8. That the complainants have heretofore granted licenses to various parties in which the right to manufacture these shoes containing the said invention was granted at the rate or royalty of three cents per pair, and that said royalty has been paid.

9. That the complainants have heretofore granted licenses and accepted royalties to various parties for the use of the said invention in the manufacture of rubber shoes, and that said royalties have been both at so much per pair and at so much gross for license to manufacture.

10. That the value of the Evory and Heston invention in shoes was twenty-five cents per pair.

11. That by reason of these wrongful acts of the defendants the complainants have suffered damage to the amount of $25,000.

Respectfully submitted,

BETTS, ATTERBURY & BETTS,
Complainants' Solicitors.

Defendants' Discharge.

(Filed July 2, 1883.)

The defendants having heretofore filed their statement of all the facts supposed by them to be material to this hearing, and having therein given the said complainants all the information possible in relation to the alleged infringement of the patent in suit, now
16 deny each and every allegation of the complainants' charge, filed June 22d inst., and aver that the said complainants have not lost any profits nor suffered any damage by reason of the infringement complained of; and these defendants deny that the alleged invention of the complainants has been in any way of value to said defendants or loss to said complainants; therefore they pray to be hence discharged.

GEORGE D. NOYES,
Counsel for Defendants.

Master's Report Resumed.

The facts as proved before me show that the defendants were manufacturers of shoes at Brockton, Mass., and that prior to 1878 they had made and sold a shoe called the "Alexis," in large quantities; that in 1878 they became the owner of the Packard patent so called, and began to make shoes under it.

The court have held that this patent infringes the Evory & Heston patent, of which the complainants were the owners. The Alexis shoe had been on the market for a long time prior to either the Evory & Heston patent of 1866 or the Packard patent of 1878. The object of both these patents was to improve the Alexis shoe and make it dirt and water proof by the insertion of an expandable gore or gusset connecting the vamp and quarter and closing up the aperture which was in the old Alexis.

The defendants admit in their account that during the period covered by this accounting they have made 49,406 pairs of Alexis shoes, and according to the testimony of Edward Crocker, their business manager, and Walter Bradford, their fireman [foreman], a large proportion of these shoes contained the infringing device. Neither of them were willing to swear that more than one thousand of the Alexis shoes so made by them were without the expandable gore or gusset.

I find that 48,000 infringing shoes were made and sold by the defendants. The defendants made no difference in their selling price between those shoes which had and those which did
17 not have the infringing device, and it does not appear that their sales were increased by its use. I therefore find defendants derived no profit from their infringement.

It appears from the evidence that of the three complainants only one, John B. Belcher, was engaged in making or selling shoes, and that he was a retail dealer at Charlotte, Michigan, and made shoes to order for his retail trade, under the Evory & Heston patent. I do not find from his testimony that he was damaged in his business by the sale of the defendants' shoes. The whole number of shoes made and sold by him under the Evory & Heston patent, from 1878 to 1882, when he went out of the business, was less than a thousand pairs.

There is evidence showing that the complainants had an established royalty, for shoes made under their patent, of three cents a pair, and that they issued licenses and sold stamps to persons who desired to use their patent. This royalty was a fixed one, and was paid by their licensees.

And I find that defendants should pay this royalty to the complainants on the 48,000 infringing shoes made by them, amounting to $1,440.

Respectfully submitted,

HENRY L. HALLETT, *Master.*

18 July 25, 1884.—I submitted to counsel the foregoing as a first draft report.

August 5, 1884.—The complainants filed with me the following paper:

Complainants' Exceptions to Master's Draft Report.

The complainants except to the draft report of the master herein as follows:

1. That the master should have found that the complainants were entitled to the profit made on 48,000 pairs of infringing shoes.
2. That the master should have found the profit on each pair of infringing shoes to have been fifteen cents.
3. That the master should have found that the complainants were entitled to $7,200 profit.

Respectfully submitted,

BETTS, ATTERBURY & BETTS,
Complainants' Solicitors.

August 5, 1884.—The defendants filed with me the following papers:

Defendants' Request to Amend Their Account.

And now come the defendants and move to amend the account filed by them March 24, 1883, by erasing the figures 49,406, stated therein, in consequence of a clerical error in the examination of their books, and inserting the figures 42,703, in lieu of said figures, before the word "pair," in the second paragraph of said account.

By GEO. D. NOYES, *Solicitor.*

Defendants' Objections to Masters' First Draft Report and Requests for Findings.

And now come the defendants and respectfully object to the draft of the report of the master submitted July 25, because—

1. It appears by the opinion of the court that the infringement of the complainants' patent consists only in the manufacture of
19 shoes having a single gore and constructed according to Complainants' "Exhibit Packard Shoe," and because the contrary appears to be implied in said draft report.
2. Because it appears by the evidence that the only patterns of shoes made by the complainants under their patent were "Exhibit Evory & Heston Shoe" and "Exhibit Shoe Received by Express," and that these were made by Belcher from 1876 to 1882 at retail only, he being in business with Heston a part of the time.

And the master is requested to find and report the facts as stated in the second objection, or else to report the evidence in relation to said exhibits, viz., the interrogatories and answers of John B. Belcher, numbered 9, 11, 47, 49, 51, 52, 53, 54, 79, 93, 94, 134.

(MASTER'S NOTE No. 1.—I find as requested.)

3. Because, on the evidence, the report ought to find that the business of the defendants in the manufacture of the infringing shoe was prudently and providently conducted, and for the sole purpose of making as much profit as possible from the gore and the shoes containing it.

And the master is requested to find the fact to be as stated above, or else to report the evidence thereon, viz., the interrogatories and answers of Edward Crocker, numbered 1, 30, 31, 56, 66, 97, 100, 102,

127, 129, 166, 176, 247, 248, 249, 252, 255, 270, 271, 276, 277; interrogatories and answers of John W. Burt, numbered 3 and 8; interrogatories and answers of Fred. Packard, numbered 2, 3, 4, 7.

(MASTER'S NOTE No. 2.—I find as requested.)

4. Because, on the evidence, the infringing shoe was of the class known to the trade as the Alexis, one pattern of which did not contain a gore, and because the entire number of both kinds was 42,703 pairs, of which 30,000 contained the gore arranged as in the infringing exhibit.

And the master is requested to find that the infringing shoes numbered 30,000, or else to report the evidence thereon, viz., the interrogatories and answers of Edward Crocker, numbered 5, 6, 7, 8, 28, 34, 236; the interrogatories and answers of Walter Bradford, numbered 9, 10, 11, 12, 16.

(MASTER'S NOTE No. 3.—The defendants' motion, printed above, for leave to amend their account by substituting 42,703 pairs as the whole number of Alexis shoes made by them, instead of 49,406 pairs, as stated in their account, is allowed, the evidence cited sustaining the motion.

I do not change my findings as to the number of Alexis shoes embraced in the account so amended which did not contain the infringing device. Under the account as amended I find that defendants made and sold 41,297 pairs of infringing shoes.

As requested by the defendants, I will annex to my report that portion of the evidence asked for above, which relates to the number of Alexis shoes covered by their account which did not contain the infringing device.)

5. Because, on the evidence, the admission of evidence of license was objected to, and it was contended that, as no damages were sustained by the complainants in their own business in consequence of the infringement, evidence of a license fee to others was not material or relevant.

And the master is requested to hold that all the evidence in relation to a license fee was offered by the complainants, and that as a matter of law it is inapplicable to the facts of the case as stated in said draft report, and that no license fee was established within the meaning of the law, or else to report the evidence on these points to the court, viz., interrogatories and answers of John B. Belcher, numbered 32, 33, 36, 43, 96, 97, 104, 106, 109, 120, 121, 123.

Interrogatories and answers of John C. Balderston, numbered 4, 6, 8, 9, 16, 43, 44, 46.

Interrogatories and answers of John W. Burt, numbered 3, 5, 7.

Interrogatories and answers of Fred. Packard, numbered 2, 3, 4, 5.

Interrogatories and answers of Edward Crocker, numbered 247, 248, 270, 271, 272. "Exhibit License No. 1," "Exhibit License No. 2," "Exhibit National Rubber Company License," "Exhibit Shoe Received by Express," "Exhibit Stamps."

(MASTER'S NOTE No. 4.—I decline to find as requested. The evi-

dence as to a license fee was introduced by the complainants. I will annex to my report the evidence asked for, and will return the exhibits into court as requested.)

6. Because it ought to appear that on the evidence the fact that the infringing shoe was on the market did not interfere with the system of licensing adopted by the complainants in 1876, or occasion the refusal of any license by persons solicited to take it.

And the master is requested to find the fact as stated above, or else to report the evidence on this point, viz., interrogatories and answers of John B. Belcher, numbered 125 and 126. Interrogatories and answers of H. P. Baldwin, numbered 1, 4, and 5. Interrogatories and answers of Samuel C. Sutter, numbered 4 and 5.

(MASTER'S NOTE No. 5.—I find as requested.)

7. Because it follows from the facts stated in said draft report that the complainants are not entitled to recover a royalty fee of the defendant or any sum whatever.

By their solicitor and counsel, GEORGE D. NOYES.

As stated above, I alter my findings as to the number of infringing shoes made and sold by defendants, and now find that defendants should pay a royalty of three cents a pair on 41,297 pairs, amounting to $1,238.91.

Respectfully submitted,

HENRY L. HALLETT, *Master.*

22 September 18, 1884.—I submitted the foregoing to counsel as a second draft report.

October 1, 1884.—The defendants filed with me the following paper:

Defendants' Requests and Objections to Master's Second Draft Report.

1. And now comes the defendants and respectfully object to the report of the master in this cause, submitted to counsel September 18th ultimo, and request the master to revise the second paragraph of the original report on page four, and to strike out all of said paragraph except the words "the Alexis shoe had been on the market a long time prior to the Evory & Heston patent of 1866 or the Packard patent of 1878."

(MASTER'S NOTE No. 6.—I see no reason for doing this.)

2. And the defendants also object to said report because the master declines to hold as requested by them under the fifth objection heretofore made.

3. And the defendants further object to the finding of the master that defendants should pay a royalty of three cents a pair on 41,297 pairs, amounting to $1,238.91, and request the master to sustain the seventh objection heretofore made by them.

4. The master is also requested to find that Belcher did not file an account as requested in reply to interrogatory 104, but sent and filed an affidavit stating that his account of sales was lost.

(MASTER'S NOTE No. 7.—I find as requested.)

By their solicitor and counsel, GEO. D. NOYES.

October 1, 1884.—The plaintiffs filed with me the following paper:

Plaintiffs' Requests on Second Draft Report.

The plaintiffs request that the master will certify to the court the following interrogatories and their answers, in explanation
23 of those certified for the defendants, viz., testimony of Edward Crocker, interrogatories 23 to 27, inclusive; interrogatories 33 and 35; testimony of Walter Bradford, interrogatories 13, 14, 15; testimony of J. B. Belcher, interrogatories 34, 35, 38, 105.

(MASTER'S NOTE No. 7.—I will append the testimony requested.)

Respectfully submitted,

BETTS, ATTERBURY & BETTS,
Solicitors for Defendants.

I now make the foregoing as my final report.

Respectfully submitted,

HENRY L. HALLETT, *Master.*

As requested by the defendants, I annex to my report the following testimony taken in the hearing before me:

Evidence Asked for by Defendants under the Fourth Objection.

A portion of the evidence of Edward Crocker.

Int. 14. Can you state, as a matter of fact, whether the large majority of the shoes sold by the defendants and included in the 49,406 mentioned in defendants' statement did not consist of the two classes of shoes spoken of in your answer to the third interrogatory in your testimony given in the printed case?

(Objected to and admitted.)

Ans. I should think that a majority of them were—that is, with what we call the stay piece put in.

24 Int. 15. Then, if I understand your last answer, you mean to say that a majority of all the Alexis shoes made by you since 1878 were of the pattern shown in Defendants' "Exhibit Packard Shoe," in which there was the small piece sewed onto the rear of the vamp and the front of the quarter?

Ans. Yes, a majority. We made some without any stay piece at all.

Int. 28. Do you think it likely that you have manufactured since 1878 one thousand pairs of the old-style Alexis shoe?

Ans. I have no means of knowing.

Int. 34. Then, as far as you know, the only means of obtaining information as to the number of Alexis shoes of any particular pattern made and sold is the memory of the employees of the firm?

Ans. So far as I know, that is the only means.

Int. 226. Have you been able to find any more definite basis than what you have previously testified on, as to the proportion of Alexis shoes, other than the old-style Alexis, which have been made by you since 1878?

Ans. I have made more full inquiries and am willing to admit 30,000 pairs of Alexis shoes were made with the stay piece and sold by us.

A Portion of the Evidence of Walter Bradford.

Int. 11. Can you tell, from your recollection, what proportion of the Alexis shoes so said to have been made and sold by the defendants were of the kind which had the stay piece sewed on the vamp and to the quarter?

Ans. I cannot tell what proportion. I should say a large proportion; most of them were made that way.

Int. 16. Would you be willing to swear that since July, 1879, the firm of Burt & Packard had made a thousand pairs of the old-style Alexis shoes?

(Objected to and admitted.)

Ans. I can't swear any nearer than I have, either with or without the stay. I can't tell; they may have made more.

25 *Evidence Asked for under the Fifth Objection.*

A portion of the evidence of John B. Belcher.

Int. 32. Did you ever grant any licenses for the manufacture of leather shoes under the Evory & Heston patent?

Ans. I did.

Int. 33. At what rate or royalty were those licenses?

(Objected to and admitted.)

Ans. Three cents per pair.

Int. 36. Did manufacturers to whom you applied to take licenses uniformly accept your license agreement?

(Objected to and admitted.)

Ans. They did not, all of them.

Int. 43. Have you any of the licenses before referred to in your examination with you; and, if so, will you produce them?

Ans. I have, and will do so; there are two.

(They are severally marked "Exhibit License No. 1" and "Exhibit License No. 2.")

(The admission of these licenses objected to by defendants, but admitted.)

Cross-int. 96. You have licensed, as you have stated, certain parties under the Evory & Heston patent for a new and useful invention, consisting of a double extension-gore flap used in the

manufacture of boots and shoes. Have you granted any license of any other form than "Exhibit License No. 1" and "Exhibit License No. 2?"

Ans. I don't remember the form of the other licenses; one I remember was written. I don't know whether No. 1 and No. 2 are alike.

Cross-int. 97. Will you look at the two Exhibits, "License No. 1" and "License No. 2," and state whether or not you have granted licenses of any other form than these?

Ans. It is impossible for me to tell.

Cross-int. 104. Will you make and file with the master, as a part of your evidence in this case, a copy of your account with each of your licensees and a statement of all stamps furnished by you
26 to any parties, and their names and residences, sworn to before a U. S. commissioner or a notary public?

Ans. I will, as near as I am able to. I desire to say that I did not furnish stamps for rubber goods, but only for leather goods.

Cross-int. 106. You made a great many applications for dealers to buy stamps or take licenses which were refused, did you not?

Ans. A great many declined.

Cross-int. 109. Do you know whether or not these licensees which you have mentioned manufactured goods alleged to be under the patent in suit without paying the royalty agreed upon?

Ans. I do not know positively.

Cross-int. 120. You say that Mr. L. Pratt was in the business at Charlotte; did you ever sell him any stamps?

Ans. I did not.

Cross-int. 121. Did you ever ask him to buy any?

(Objected to and admitted.)

Ans. I don't remember doing so.

Cross-int. 123. Do you have any reason to believe that Mr. Pratt would have bought stamps of you or taken a license of you if he had not purchased such shoes with a gore piece between the quarter and the vamp as Burt & Packard supplied him with?

Ans. I have no means of knowing what he was disposed to do.

A Portion of the Evidence of John C. Balderston.

Int. 4. Have you or the National Rubber Co. ever purchased a license to manufacture under the Evory & Heston patent?

(Objected to and admitted.)

Ans. The National Rubber Company purchased the exclusive right to manufacture rubber and cloth overshoes, known by the trade as snow-excluders, from Evory & Heston, or the owners of that patent.

Int. 6. Will you please state to the best of your recollection what sum, if any, you paid for this license right?

(Objected to and admitted.)

Ans. Either four thousand dollars or three thousand dollars; I can't say which.

27 Int. 8. Did the National Rubber Company ever bring suit as licensees under the Evory & Heston patent?

Ans. They did, against the L. Candee Company of New Haven, Conn.

Int. 9. Was that suit compromised?

Ans. The L. Candee Company paid the National Rubber Company damages. That suit was settled for twelve thousand dollars in cash.

(The above questions objected to and admitted.)

Int. 16. You have stated that after this license was given the National Rubber Co. united in a suit against the L. Candee Co.; that suit was in the Connecticut district, was it not?

Ans. It was at Hartford.

Int. 43. You paid the license spoken of for the purpose of enabling you to manufacture the two classes of rubber overshoes you have spoken of?

Ans. We were manufacturing the snow-excluders and monitors under the Williams patents, and we bought the right to use the Evory & Heston patent in connection with the Williams. We thought it better to control all the patents applicable to this class of shoes.

Int. 44. You paid a license, claiming on your part that the Evory & Heston patent was invalid, and for the purpose of protecting yourselves against annoying litigation, did you not?

(Objected to and admitted.)

Ans. My anwser to that would be this: We bought the Evory & Heston patent, to the best of my knowledge, to prevent the L. Candee Company from making "snow-excluders," which they were doing under the Evory & Heston patent. I understood they were licensees of Evory & Heston.

Int. 46. Is it not a fact that the license of the L. Candee Company was revoked by Evory & Heston, and that it was considered expedient by your company for them to take the place of the L. Candee Company as licensees?

Ans. My understanding is that after our company purchased the license from Evory & Heston we revoked the license of the L. Candee Company.

28 *A Portion of the Evidence of John W. Burt.*

Int. 3. Will you state whether or not at the time the price of your shoe with a gore was fixed you had any knowledge of there being any other similar shoe on the market?

Ans. No.

Int. 5. Will you state whether or not Belcher or either of the complainants ever asked you or your firm to take a license under the Evory & Heston patents?

Ans. They did not, to my knowledge.

Int. 7. Had you or your firm, prior to the beginning of this suit, known or learned of licenses granted under the Evory & Heston patent?

Ans. I had not.

A Portion of the Evidence of Fred. Packard.

Int. 2. At the time the price of the shoe which had a gore between the vamp and the quarter was put onto the market what knowledge had you of Evory & Heston or a patent granted to them? Please to state whether you had any as concisely as you can.

Ans. I had none.

Int. 3. What knowledge, if any, had you of any similar shoe?

Ans. I had none.

Int. 4. Will you state whether or not you were ever asked to take a license under the Evory & Heston patent?

Ans. I was not.

Int. 5. Was the firm ever asked, to your knowledge?

Ans. It was not.

A Portion of the Evidence of Edward Crocker.

Int. 247. At the time you were called as a witness by the complainants you testified that when the patented shoe of Mr. Packard was put onto the market it was sold at the same price as the old-style Alexis. Will you state whether at that time you or your firm had any knowledge of the Evory & Heston patent or of any shoe made under it?

29 Ans. We had not.

Int. 248. Will you state whether or not, down to the time of the testimony of Mr. Belcher in this hearing, your firm, or you as its financial agent, had any knowledge that licenses for the manufacture of any form of leather shoes had been granted under the Evory & Heston patent, either in writing or by the sale of stamps?

Ans. No, sir.

Cross-int. 270. Had your firm, or you as its financial agent, down to the time of the testimony of Mr. Belcher, had any knowledge of any royalty or compensation or equivalent of any value for the use of the Evory & Heston patent or of any rights thereunder?

Ans. No.

Cross-int. 271. Had you in any way ever heard of any such royalty or compensation?

Ans. Never heard of any. I saw a list of names printed in the record in the rubber suit, as I understood it, that they claimed had paid shop rights to them.

Cross-int. 272. What rubber suit was that?

Ans. I think, the L. Candee suit. I speak from memory.

The following testimony is appended at the request of the defendants:

A Portion of the Testimony of Edward Crocker.

Int. 23. Other than the shoes made with the stay piece sewed in, of which class of shoes did you make the most, those with no stay piece at all or those made with a continuous vamp or tongue provided with side wings and also slots intermediate of said flaps and the body of the tongue?

Ans. I think we made a majority of the Alexis shoe with the stay piece in.

Int. 24. Exclusive of the shoes made with pieces sewed onto the vamp and to the quarter, of which two classes of Alexis
30 shoes have you made the most, those without any stay piece or those with an extension of the vamp so as to make a stay piece?

Ans. I am unable to say; have no means of knowing.

Int. 25. What were your means of knowing when you were asked as to the proportion of the shoes made with the stay piece sewed in?

Ans. No means of knowing as to the numbers of any except as to general knowledge of the goods as they went through the factory.

Int. 26. Have you not the same means of knowledge with regard to those other two kinds about which I have asked you?

(Objected to. Admitted.)

Ans. Yes; only the same means.

Int. 27. Can't you then state, with regard to these other two kinds, the proportions of each which were sold?

Ans. I have no means of ascertaining.

Int. 33. Would the bills which you have rendered to your customers show whether the Alexis shoes bought by them were of any one of these three kinds?

Ans. I think not.

Int. 35. In whose charge is the order book and the general business connected with filling the orders—I mean in the factory?

Ans. Walter Bradford.

A Portion of the Testimony of Walter Bradford.

Int. 13. What proportion was made with no stay piece whatever?

Ans. Since July, 1879, they have either been made with the stay piece or without any stay piece at all, as in the old Alexis shoe.

Int. 14. There have been no shoes, then, made since July, 1879, in which the stay piece was a part of the whole vamp—I mean the stay piece and vamp one continuous piece of leather?

Ans. Not to my knowledge.

Int. 15. Would you have been likely to have known of the manufacture of any such kind of shoes by the defendants if they
31 had been made by them any time since July, 1879—I mean with the whole vamp?

Ans. I should if there was any quantity of them made.

A Portion of the Testimony of J. B. Belcher.

Int. 34. Was the royalty provided by those licenses ever paid?
Ans. It was.
Int. 35. Did you personally conduct the negotiations for licenses?
Ans. I did.
Int. 38. Can you state what was said at your interview with either Baldwin & Co. or Fargo & Co.?

(Objected to.)

Ans. I can give the substance of what was said: They declined upon the ground that the same invention was claimed by others and being manufactured by others, and they feared litigation would result.
Int. 105. Did you always sell your stamps at uniform price?
Ans. Always; three cents a pair.

This cause was thence continued to the October term, A. D. 1884, when the following exceptions to master's report were filed:

Defendants' Exceptions to Master's Report.

(Filed Oct. 29, 1884.)

The report of the master in said cause having been filed, the defendants allege exceptions to the said report as follows:
1. That the objection made to the evidence of a license fee and to the sufficiency thereof to charge the defendants with the payment of $1,238.91, or any other sum, ought to have been sustained.
2. That the evidence was insufficient to show that a license fee for the use of the complainants' invention had been established within the meaning of the law.
3. That on the findings of the report and on the evidence the master should also have found that the complainants are not entitled to recover even nominal damages.

GEO. D. NOYES,
Solicitor and of Counsel.

32 At the same term the following exceptions to master's report were filed:

Complainants' Exceptions to Master's Report.

(Filed Nov. 3, 1884.)

The complainants except to the report of the Hon. Henry L. Hallett, master herein, filed on the 13th of October, 1884, as follows:
1. Because that the said master found that the complainants were entitled to no profit on the infringing shoes made by defendants, whereas he should have found that the complainants were entitled to the profit made on 48,000 pairs of infringing shoes.

2. Because that the master found that there was no profit made by the defendants to which the complainants were entitled, whereas he should have found that the complainants were entitled to the profit made on each pair of infringing shoes, amounting to fifteen cents per pair.

3. Because that the master found that the complainants were entitled to no profit, whereas he should have found that the complainants were entitled to $7,200 profits.

Respectfully submitted,

BETTS, ATTERBURY & BETTS,
Complainants' Solicitors.

This cause was thence continued to the May term, 1885, when the same was set down for hearing and fully heard upon the defendants' exceptions to master's report.

This cause was thence continued under advisement to this present October term, A. D. 1885, when, on the tenth day of November, the rescript of the court is filed, in accordance with which an order is entered overruling defendants' exceptions to master's report.

32*a* On the twenty-third day of November, A. D. 1885, the following petition for rehearing is filed:

Petition for Rehearing on Additional Evidence.

(Filed Nov. 23, 1885.)

The respondents in the above cause respectfully show to the court that, since the interlocutory decree therein was entered, it appears from evidence of John B. Belcher, one of the complainants, taken before the master, that a large part of the whole number of shoes made under the patent in suit were like the shoe of Norris, described in the evidence, and that the same were sold by said Belcher, no objection to the construction shown being made by any customer. The respondents further show that the said evidence of said Belcher proves the error of the opinion and statement of the complainants' expert in relation to the difference between the Norris shoe and that described in the patent in suit; that the court formed its opinion in accord with that of said expert in relation to said Norris shoe on the assumption of a fact proved by said Belcher to be inconsistent with the opinion expressed.

The respondents further show that said Belcher, in his evidence before the master, put in evidence the shoe marked "received by express" as a sample of one of the classes of shoes made under the patent in suit and for which a license was charged.

Wherefore, inasmuch as the record shows that the complainants have suppressed, in the principal case, facts inconsistent with the correctness of the opinion of the court in relation to the
32*b* Norris shoe, and unknown to the respondents until stated by said Belcher as aforesaid, and known by them, said complainants, or some of them, to be fatal to the opinion of their expert in

so far as the same was adopted by the court, these respondents pray for a rehearing of the case on the whole evidence and that the bill may be dismissed with costs.

GEO. D. NOYES,
Counsel for Respondents.

On the sixteenth day of January, A. D. 1886, the foregoing petition for rehearing is denied by the court.

On the twenty-ninth day of January, A. D. 1886, the following decree is entered:

33 *Final Decree.*

(Jan. 29, 1886.)

COLT, *J.:*

And now, to wit, Jan. 29, 1886, it is ordered, adjudged, and decreed by the court that the master's report in this cause be, and the same is hereby, affirmed, and that the said complainants recover of the said defendants the sum of twelve hundred and thirty-eight dollars and ninety-one cents ($1,238.91) damages, and their costs of suit, taxed at seven hundred and eighty-eight dollars and seventy-four cents ($788.74).

From this decree the defendants, in open court, claim an appeal to the Supreme Court of the United States, and give good and sufficient security that they will prosecute their appeal to effect and answer all damages and costs if they fail to make their plea good, and said appeal is allowed.

A true record.

JOHN G. STETSON, *Clerk.*

The following is the evidence used at the hearing of said cause before said circuit court:

34 *Evidence for Complainants, Taken Pursuant to the Sixty-seventh Rule of the Supreme Court of the United States, in Equity, as Amended, before me, Joseph Gutman, Jr., Examiner.*

NEW YORK, *March* 16, 1881.

Present: C. Wyllys Betts, Esq., of counsel for complainants; George D. Noyes, Esq., of counsel for defendants.

Counsel for complainants offers in evidence letters patent of the United States granted to Evory and Heston for improvement in boots and shoes, dated Nov. 6, 1866, No. 59375. It is marked "Compl'ts' Exhibit No. 1."

Also letters patent of the United States granted to Fred. Packard for improvement in boots and shoes, dated June 18, 1878, No. 205,129. It is marked "Compl'ts' Exhibit No. 2."

(Objected to as immaterial.)

35 *Deposition of Henry L. Brevoort.*

Direct examination by C. WYLLYS BETTS, Esq., of counsel for complainants:

Int. 1. What is your name, age, residence, and profession?

Ans. My name is Henry L. Brevoort; I am thirty-two years of age; I reside in the city of Brooklyn; I am by profession a mechanical engineer.

Int. 2. What experience have you had as expert in patent cases?

Ans. I have for the last six or seven years been almost exclusively engaged in examining patents and patented machinery. I have been very frequently called to testify in suits relating to patents and patented inventions, and I have been frequently so called in suits relating to articles relating to wearing apparel and the like, including various suits relating to the construction of boots and shoes.

Int. 3. Look at the patent put in evidence and state whether or not, in your opinion, the article described in the patent of F. Packard, No. 205,129, contains the invention described and claimed in the patent of Evory and Heston, No. 59375, and give your reasons for any opinion you may express.

Ans. I have frequently read both patents, and I am clearly of the opinion that the thing described in the Packard patent, No. 205,129, does contain the invention described, claimed, and shown in the patent granted to Evory and Heston, No. 59375.

I will first state what I understand to be described and claimed in the Evory and Heston patent, and I will then compare the invention which I understand to be claimed in that patent with the shoe or gaiter which is the thing shown and described in the Packard patent.

The Evory and Heston patent describes, as I understand it, a shoe formed with expansible gore flaps arranged upon either side of a shoe, and so arranged that by the unfolding of the flaps the wearer's foot may be inserted within the shoe, and by folding which flaps over and upon the outside of the shoe after the foot has been inserted a neat and close fit may be made around the ankle of the

36 wearer. I understand that a buckle or a lacing may be used in the Evory and Heston patent to keep the flaps in the proper position and to preserve the desired closeness of fit after the shoe is put on. I do not understand that the Evory and Heston invention includes gore flaps, however, made so as to give expansibility to the shoe to admit of its being placed upon the wearer's foot, but I understand that the Evory and Heston invention relates to the gore flaps only when constructed in such a way as to bear a special relation to the shoe proper.

The claim of the Evory and Heston patent is for an expansible gore flap, the external fold of which is attached to and in front of the quarter, and the internal fold of which is attached to and in the rear of the vamp, the claim ending with the following words: "The said several parts and pieces being respectively constructed and the

whole arranged for use substantially in the manner and for the purposes set forth."

Now, there is but one form of shoe shown in the drawing, and from the description and drawing, when taken together, I am enabled to understand the method or manner in which the flaps are to be arranged in relation to the shoe proper, and I understand that the arrangement consists in so locating and arranging the flaps as that they shall give the desired expansibility, while, at the same time, when closed around the ankle of the wearer, these flaps shall lie upon the outside of the shoe proper, in contradistinction to being turned within the shoe. By the Evory and Heston arrangement the portions forming the flaps do not come in contact with the foot of the wearer. I understand that to obtain these results it is necessary that the external fold should proceed from the front of the quarter and the internal fold from the rear of the vamp, and that by such construction of parts a shoe having the arrangement of the Evory and Heston patent shall result.

The shoe described in the Packard patent is likewise a shoe provided with flaps, so that when the shoe is to be put upon the foot the desired amount of expansibility may be had by the unfolding of the flaps, and that after the shoe is upon the foot of the wearer the desired neatness of fit may be obtained by folding the flaps
37 around the ankle of the wearer upon the outside of the shoe, and in which position they are to be retained by the suitable fastening devices.

The flaps on the Packard shoe are composed of an extension of the quarter upon each side of the shoe forward, and of a piece attached to the rear of the vamp, which piece forms the internal fold. The arrangement of parts composing the flaps in the Packard shoe is substantially the same arrangement of parts as is found described and claimed in the Evory and Heston patent, with the exception that the external fold, or the portion which corresponds with the part marked "C" in the Evory and Heston patent, is in the Packard patent made of one piece with the quarter, and is an extension forward thereof for the purpose of forming the fold, while in the Evory and Heston patent the external fold is formed of a piece sewed to the front of the quater, and becomes, by reason of such sewing, practically continuous with the quarter. This is merely a structural difference, admitting of the use in the Evory and Heston shoe of smaller pieces of leather—smaller than would be required in the Packard shoe. The external fold in the Packard shoe is attached to the rear of the vamp as in the Evory and Heston shoe. The Packard shoe consequently has, in my opinion, the same arrangement of parts as is found described and claimed in the Evory and Heston patent. Indeed, in the Packard patent the special advantage of the Evory and Heston arrangement is recognized where the specification of the Packard patent says: "When the shoe is on the foot and the parts buckled or laced, the wings or flaps are folded externally over the tongue piece from the lower portion of the slots at each side, thus bringing the laps outside and leaving no projecting portions inside to hurt the foot."

The Evory and Heston shoe possesses the advantage of being water-tight all the way to the top, which is an advantage the benefit of which is not so fully had in the Packard shoe, although the Packard patent says that the shoes made in accordance therewith will prevent sand and dirt from working its way into the shoe, and that it effectually excludes snow and water, though in these respects I do not think it is as good as the Evory and Heston shoe.

It is clearly my opinion that the shoe shown and described in the Packard patent, No. 205,129, does contain the invention
38 which is described, shown, and claimed in the Evory and Heston patent, No. 59375, the Packard shoe containing substantially the same parts and the arrangement of parts as are referred to in the claim of the Evory and Heston patent.

In both cases the flaps fold forward over and upon the vamp of the shoe, and in both cases the flaps are secured in their closed position by means of equivalent closing instrumentalities.

Cross-examination by GEORGE D. NOYES, Esq., of counsel for defendant:

Cross-int. 4. In your opinion, would the Evory and Heston patent cover a shoe made in what is called the gaiter style—that is, a shoe which is laced from the toe joints of the foot to the ankle?

Ans. As I understand that which is described in the question, I think it would not.

Cross-int. 5 (*de bene*). How many flaps are there in the shoe described in the Packard patent?

Ans. There is the extension of the quarter forward, which forms the external flap, and then there is the internal fold, which unites the front of such extension to the rear of the vamp, and this is true of both sides of the shoe, the flaps upon either side being arranged in the same way.

Cross-int. 6 (*de bene*). If I understand you, then there are in the Packard shoe two flaps on each side of the shoe. Is that correct?

Ans. It is. There are two pieces which are necessary to the formation of the expansible gore flaps. In putting on either the Evory and Heston or the Packard shoe it is necessary that there should be a giving of the leather of the shoe other than that due alone to the infolding of the flaps.

Cross-int. 7. How many flaps are there in the Evory and Heston shoe as described and claimed in their patent?

Ans. There is the forward extension of the front of the quarter, which forms the outer fold of the flap upon either side of the shoe, which extends from the rear of the vamp to the forward margin of the extension of the quarter, and in the Evory and Heston shoe, as in the Packard shoe, these flaps, when folded forward, lie upon
39 the exterior surface of the vamp, the vamp being the leather covering the front of the foot and the instep, a portion of which is marked with "A" in the Packard patent.

Cross-int. 8 (*de bene*). Do you understand that the Packard patent describes and claims more than one form or pattern for a shoe?

Ans. It describes that the vamp may be made of a single piece of

material with the portions forming the internal fold, which would then have to be folded forward upon the outside of the vamp proper when the shoe is upon the wearer's foot.

Cross-int. 9 (*de bene*). Suppose that the vamp is not made in the way described in your last answer, and that a gore piece is attached to the vamp and quarter or back of the shoe, is that fabric within the description of the Packard patent?

Ans. I cannot say with certainty without seeing a shoe so made; but, as I understand the question, a shoe would result which would not have the advantages of the Packard patent; but I may be in error from a misconception of what it is intended to describe in the question.

Cross-int. 10 (*de bene*). I mean a gore piece which would serve to keep water from entering between the vamp and quarter, but which would not be folded between the vamp and quarter.

Ans. As I understand such a construction, I should not suppose it would come within the Packard patent, in that I do not understand that it would possess the benefits of the Packard and the Evory and Heston construction; for the fold, as I understand it, would be within the shoe proper and not outside of it, as is described in the Evory and Heston and Packard patents.

Cross-int. 11. Did you ever see any shoes manufactured from leather according to the Evory and Heston patent in suit?

Ans. I have seen the Patent Office model of the Evory and Heston shoe, and, in a previous case brought under the Evory and Heston patent, I saw some shoes which I believe were made by the inventors or licensees—at least, they were shoes which contained the Evory and Heston invention. All of the shoes I refer to are made of leather.

Cross-int. 12. In shoes made of leather under the Evory and Heston patent, would it, in your opinion, be necessary to use a different kind of leather for forming the so-called gore flap from that which is used in forming the body of the vamp and quarter? What I mean is this: Supposing the gore flap to be made of the same material with the body of the vamp and quarter in a shoe to be made of leather, would not such a shoe be too clumsy to be worn with ease, and is not the construction shown in the Evory and Heston patent adapted to the manufacture of a rubber shoe rather than to a leather shoe?

Ans. I think it would be advantageous both in the Evory and Heston patent and Packard patent to make the flaps or a portion of the flaps out of leather thinner than the body of the shoe, although I do not think that it is absolutely essential to so construct it. I think that the Evory and Heston patent refers to a leather shoe, for the reason that the patent speaks of and the drawing shows that the parts are to be sewed together, which is not the common way of making rubber shoes.

Cross-int. 13. Does not the Evory and Heston patent say in substance that two flaps are to be sewed together in the construction of the shoe there described and claimed?

Ans. It does, I think.

Cross-int. 14. You have stated your opinion to be that a gaiter shoe having an expansible front attached to the quarter is not within the Evory and Heston patent in suit. Why not, if, when the shoe is on the wearer's foot, it fits neatly to the foot?

Ans. Because I did not understand that the shoe described in the question was to be one having the flaps arranged so as to fold in the particular way which I understand to be the feature of the Evory and Heston patent, to wit, upon the outside of the shoe proper.

Cross-int. 15. By "outside of the shoe proper" do you mean that the flap is to fold on the outside of the quarter in the Evory and Heston patent?

Ans. No; I mean that they fold forward upon the outside of the vamp, the flaps when folded lying upon the leather which is between these folded flaps and the wearer's foot.

Cross-int. 16. And between the vamp and the quarter?

Ans. The vamp and the quarter, or at least that portion
41 which forms the shoe proper, meet, and the two flaps lie outside of such portions and upon the outside surface of the vamp.

Cross-int. 17. That seems to be clear. Now, suppose a shoe to be constructed in such a manner as to have the quarter extending as far as the instep part of the foot, under the Evory and Heston patent, would the fold of the gore flaps be outside the quarter, or would it be between the vamp and the quarter?

Ans. It would be between the outside of the vamp and the forward extension of the quarter. The extending of the forward end of the quarter beyond the rear edge of the vamp, by having the leather continuous, would be in substance accomplishing the same result as Evory and Heston accomplishes by extending his quarter forward beyond the rear edge of the vamp, and it would be an accomplishment of the desired object by practically an equivalent means. The essentials of the Evory and Heston shoes are, first, that the vamp and quarter should meet when the shoe is in position upon the foot; second, that the quarter should be extended forward over the vamp a suitable distance; third, that the lower and the front edge of the extension of the quarter should be united by an inner fold to the rear edge of the vamp. In this way a shoe results in which the foot is encased by a vamp and quarter, and two folds exist upon either side which are outside of the outer surface of the vamp. Now, whether the forward extension of the quarter is made by sewing a piece on the quarter or by increasing the size of the quarter is immaterial, so long as the quarter is extended forward a sufficient distance beyond the rear edge of the vamp or front portion of the shoe.

Cross-int. 18. In the construction just indicated it follows, does it not, that there will be three thicknesses of material to the shoe as it fits the foot?

Ans. Yes; but the inside one, or the material which touches the foot, will always be either the vamp proper or the quarter proper of the shoe.

Cross-int. 19. Does it not also follow that there is a fourth layer of material to the shoe as it is made to fit the foot, in the case supposed?

42 Ans. It does not follow, at the place where the flaps are folded over the vamp, there would be three thicknesses of material.

Cross-int. 20. Do you understand that under the patent in suit it is essential that the folds should be self-acting, or would a shoe in which they are or might be arranged and fitted by hand be within the patent?

Ans. I think they are to be self-acting, in that the mere act of closing the shoe upon the foot will cause the thicknesses of leather to lie in proper position and assume the same position at each closure.

Cross-int. 21. Then, if I understand you, a shoe made in that way, but which may require an adjustment of the parts in order to effect a fit, would not be within the patent in suit?

Ans. Not if the person putting the shoe on had at each time to determine the fold and crease, it leaving the wearer liable to having the shoe fold up at unexpected places. A shoe so constructed would not, I think, be practically useful.

Cross-int. 22. When you speak of the extension of the quarter in order to put on the invention described and claimed in the patent, what do you mean? You mean that the amount of the extension has reference to the length of the vamp, do you not?

Ans. I mean that the forward edge of the extension of the quarter is to be carried forward, over and beyond the vamp and the rear edge thereof.

Cross-int. 23. But if the forward edge of the quarter is extended so far toward the toe that a front lacing is required, as in a gaiter shoe, such a construction is not within the patent in suit; is that so?

Ans. In the shoe which I understand to be inquired about the invention would not be found, for the reason that the shoe would not be a shoe with expansible gore flaps lying upon the outside of the vamp; and, further, in the Evory and Heston shoe the forward extension of the quarter need only be sufficient to enable the shoe to be opened, and need not and should not be an extension necessary for the covering of the foot of the wearer, the wearer's foot being sufficiently covered by the quarter and vamp alone.

Cross-int. 24. In the case supposed, where lacing was spoken

43 of, I intended that the vamp should be shortened to an extent to which the quarter is lengthened. What do you say to that case? Would a shoe so constructed, and having a so-called gore flap, be within the patent in suit?

Ans. It is difficult to tell without seeing a shoe; but if the flaps lay on the outside of the vamp and the forward edge of the extension of the quarter came beyond the rear edge of the vamp, then, I think, it would come within the invention, providing the inner fold was properly applied—that is, to the extension of the quarter and the vamp.

Cross-int. 25. Will you look at the shoe upper maked "Evory and

Heston patent," and shown you for purposes of identification, and state whether or not it is made in accordance with the description of the patent in suit, and whether it is within the claim of said patent?

Ans. I have examined the shoe upper shown me. It seems to be a substantially correct representation of the upper of the Evory and Heston shoe, with the exception that the extension of the quarter forward is not sewn to the front edge of the quarter as in the manner shown in the drawing of the patent, and that there are three lace holes instead of two. I refer to the fact that in the patent the quarter extension is shown as laid on the quarter and then sewed thereto. I mark my initial in the upper shown me.

Cross-int. 26. I suppose that if that shoe were buckled behind or on the heel part it would constitute the same shoe as if buckled in front.

Ans. I think so; then there would merely be an extension of the back over the quarter, which would accomplish the same result practically.

HENRY L. BREVOORT.

Attest: JOSEPH GUTMAN, JR., *Examiner.*

MARCH 23, 1881.

Present: C. Wyllys Betts, Esq., of counsel for complainants.

Complainants' counsel offers in evidence a shoe stamped Packard's Patent Alexis, 1878. It is marked "Exhibit Packard Shoe."

Attest: JOSEPH GUTMAN, JR., *Examiner.*

44 *Evidence for Defendants, Taken Pursuant to the Sixty-seventh Rule of the Supreme Court of the United States, in Equity, as Amended, before me, Charles H. Swan, Examiner.*

BOSTON, *April* 7, 1882.

Present: C. W. Betts, Esq., of counsel for complainants; George D. Noyes, Esq., of counsel for defendants.

Deposition of Edward Crocker.

Direct examination by GEORGE D. NOYES, Esq., of counsel for defendants:

Int. 1. What is your name, age, residence, and occupation, and how long have you been engaged in said occupation?

Ans. Edward Crocker; sixty-eight years old; reside at Brockton, Mass.; I am financial agent of Messrs. Burt & Packard, and have been so since January, 1873.

Int. 2. Are you acquainted with Fred. Packard; and, if so, will you please to state whether he is one of the firm of Burt & Packard above mentioned?

Ans. I am acquainted with him, and he is one of that firm.

Int. 3. Will you please to look at the patent granted to Fred.

Packard June 18, 1878, and state in what respects, if any (so far as any fact is concerned), shoes made under that patent by said Burt & Packard differ from the pattern shown in the drawing and description thereof?

(Objected to by complainants' counsel as immaterial and incompetent, in case the evidence now to be introduced is in contradiction of the allegations of the answer of the defendants.

Counsel for defendants here suggests that the question is asked strictly in conformity to the allegations of the answer, and for the purpose of showing that the purport of said answer ought not to be extended beyond the literal terms thereof.

45 Complainants' counsel replies that this objection is only taken lest there should be some discrepancy between the answer and the evidence, in which case it must be insisted upon.)

Ans. As a matter of fact, the first shoes that were made after the issue of said patent, were made with an extension of the front or vamp of the shoe in such shape as that it could be sewed onto the front of the back so as not to enclose the shoe so tight on the ankle as to prevent the foot from entering the shoe. Afterwards, for the purpose of economy, that portion of the front or vamp of the shoe which permitted the expansion so as to allow the foot to enter the shoe was cut off and a small piece was sewed on to take the place of it.

Int. 4. If I understand you, the front of the shoe in the first style above mentioned was cut precisely in accordance with the drawing of the patent; is that correct?

Ans. That is true.

Int. 5. Will you please to look at the upper now shown you and state if this upper represents the second style adopted, and whether any other style of goods having a similar device for keeping out dirt and water has been made by said Burt & Packard under the patent of June 18, 1878?

Ans. To the first part of the question I answer, yes; to the latter, not to my knowledge. In explanation, I would not say that a sample might not have been got up in the factory simply for experiment.

Int. 6. When you used the word "sample" in your last answer to what do you refer?

Ans. To samples got up in the factory for the purpose of developing the shoe.

Int. 7. Of what pattern were the samples referred to made?

Ans. I have never known of any other than the first and second above described.

Int. 8. As financial agent of Burt & Packard, are you acquainted with all the styles of manufacture, sale, or use of shoes made by Burt & Packard under said patent?

Ans. I am.

Int. 9. Will you please to state to what class of shoe the

46 exhibit now shown you, marked "Exhibit Packard Shoe, J. G., Jr., ex'r," belongs, and how is it known in the trade?

Ans. Known as the "Alexis." We call it simply the "Alexis."

(The upper above referred to is here offered in evidence, and is marked "Defendants' Exhibit Packard.")

Cross-examination by C. W. BETTS, Esq., of counsel for complainants:

Cross-int. 10. Was the shoe which has been offered in evidence and marked "Exhibit Packard Shoe, J. G., Jr., ex'r," manufactured by the defendants?

Ans. I think it was.

Cross-int. 11. Can you tell when it was made?

Ans. I cannot here; I have no record.

Cross-int. 12. It is in all respects like the shoes that were made and put on the market by the defendants, is it not?

Ans. It is.

Cross-int. 13. Can you tell at about what time the defendants commenced to manufacture and put on the market shoes like the Exhibit Packard Shoe?

Ans. I think about the time, or shortly after, the issue of the Packard patent; and I think a few of them during the year the patent was issued.

Cross-int. 14. And have they continued to manufacture such shoes up to the present time?

Ans. They have, more or less; they have not always used this patent in all this class of goods; some had them made without the extension front.

Cross-int. 15. Can you tell about how many shoes have been made by the defendants under this Packard patent from the time of its issue up to the present?

(Objected to as wholly immaterial and irrelevant.)

Ans. I cannot.

Direct examination resumed:

Int. 16. Will you please to look at the Complainants' Exhibit Packard Shoe again, and examine closely the structure of the
47 shoe where the stay is connected with the quarter and front part, and state whether that shoe is a fair sample of goods of that description sent out from Burt & Packard's factory?

Ans. This is not perfect.

Cross-examination resumed:

Cross-int. 17. How is it not perfect?

Ans. In that one of the stays or extension fronts is not properly put in. It makes a fold which was not intended.

Cross-int. 18. You mean, do you not, that the extension or gore piece on the left-hand side of the shoe is a little too wide, or that the quarter ought to be extended a little farther forward?

Ans. I couldn't vary my answer from the first. It is not properly put in.

Cross-int. 19. It ought to have been put in so as to fold forward

flat against the vamp, you mean, do you not, instead of with a wrinkle?

Ans. It has that effect when properly put in.

Direct examination resumed:

Int. 20. Will you please to state whether, when shoes of the "Alexis" pattern are sent out from Burt & Packard's factory the stay piece is ever folded or intended to fold?

Ans. It is not.

Cross-examination resumed:

Cross-int. 21. You mean, do you not, that it is not folded or intended to fold with a wrinkle, as in the left-hand stay piece of the complainants' Exhibit Packard Shoe?

Ans. It is not intended to fold at all.

Cross-int. 22. It is intended to be constructed and to operate as shown in the right-hand stay piece of that shoe, is it not, and in the stay pieces of the Defendants' Exhibit Packard?

Ans. It is intended to lie flat, and just fill the space between the back and the front of the shoe, the same as if the front were cut whole and attached to the front of the back.

EDWARD CROCKER.

Attest: CHARLES H. SWAN, *Examiner.*

48 *Deposition of Albert H. Spencer.*

BOSTON, *April* 7, 1882.

Direct examination by GEORGE D. NOYES, Esq., of counsel for defendants:

Int. 1. State your name, age, residence, and occupation.

Ans. Albert H. Spencer; forty-four years old; I live in Boston, and am a solicitor of patents, and have been accustomed to testify as a mechanical expert and examine and compare inventions for some seven years.

Int. 2. Will you please to state whether or not you have examined letters patent of the United States granted to Alexander F. Evory and Alonzo Heston, dated Nov. 6, 1866, No. 59375, and whether you understand the invention therein described; and, if so, will you please to state whether in your opinion the Complainants' Exhibit Packard Shoe, J. G., Jr., ex'r, or any shoe made in accordance with the shoe as shown in the drawings of Packard's patent, dated June 18, 1878, is like the shoe described and claimed in said Evory and Heston patent, and herein please to give reasons for your opinion?

Ans. I have examined the patent in suit referred to and understand the alleged invention therein set forth, and before considering the latter part of the question I will state what I understand that invention to be.

The Evory and Heston patent specification states: "Our said in-

vention consists in a novel mode of constructing shoes and gaiters, whereby the ordinary elastic goring at the sides and the tedious lacing up at the front are both dispensed with, while at the same time the tops will expand to receive the foot and fit neatly and closely around the ankle when the shoe is on, being also water-tight to the extreme top of the shoe."

The novel mode of construction illustrated in the drawing is then described in the following words:

"A represents the front of the shoe, and has attached to its rear edge *a*, as shown, a gore flap (marked 'D'). B represents the
49 back of the shoe, and has attached to its front edge *b*, as shown, a corresponding gore flap (marked 'C').

"The front and back are sewed together at those parts of their contiguous edges marked '*a' b'*,' and the flap C is arranged upon the flap D, bringing their corresponding edges *c d* upon each other, which are then sewed together, the two flaps thus arranged forming a double extension gore upon each side of the shoe, which readily expands to admit the foot, and which may then be folded forward over the instep and be secured by a buckle or knot or by suitable lacings, as desired."

This is the complete description of the thing shown in the drawing, and the specification has no suggestion of any modification of this construction, but, on the other hand, has a lengthy disclaimer of a form of extension gore previously patented for the same purpose and applicable to the same class of shoes. The effect of the disclaimer is to explain the peculiar advantages of the specific construction made known as the Evory and Heston invention. The disclaimer is followed by an exceedingly specific and limited statement of claim, which is as follows:

"A shoe when constructed with an expansion gore flap, C D, the external fold C of which is attached to and in front of the quarter B, and the internal fold D of which is attached to and in rear of the vamp A, the said several parts and pieces being respectively constructed and the whole arranged for use substantially in the manner and for the purpose set forth."

From all this I understand the invention set forth in said patent to be a shoe having in lieu of the elastic goring found in the ordinary congress gaiter a non-elastic double gore piece, composed of two pieces of corresponding shape, attached to each other at one edge so as to lie flat upon each other, and at the other or opposite edges attached, one to the quarter or rear part of the shoe and the other to the vamp or front part of the shoe, so that such rear and front parts, while not connected by an elastic gore, are connected by an expansion folding gore, affording abundant space for insertion of the foot and preventing the entrance of dirt or water between the rear and front parts so connected by the folding gore piece.

The patent terms this expansion device a "gore flap," a
50 "double extension gore," and an "expansion-gore flap," which expressions characterize the device which is substituted for the ordinary flat elastic gore, in that said device is an extension outwardly, and is a flap projecting from the point of junction of the rear

and front parts of the shoe and requiring to be fastened outside of the front part of the shoe by lacing or other means, the fastening devices being passed through or attached to the forward part of the two gore flaps, uniting them to each other so as to make three thicknesses of stock—one composing the vamp or front part of the shoe, and two outside of this, on each side of the shoe, composing the double extension-gore flap or the "expansion-gore flap C D" referred to in the claim.

These gore flaps, where united to the front and back parts of the shoe, rise as high as do those parts of the shoe, in a manner similar to the elastic goring for which they are substituted, and they are inserted between or attached to the front and back parts at the ankle, as are the elastic gorings in congress gaiters. The alleged advantages of this position over a location at the heel of the shoe are stated in the disclaimer to which I have referred.

From this statement of my understanding of the patent in suit, based upon its language and drawings, I am clearly of the opinion that the shoe, Complainants' Exhibit Packard Shoe, J. G., Jr., ex'r, is not like or substantially like the shoe described in the Evory and Heston patent. There are several reasons for this opinion. In the first place, this shoe is not of a kind adapted for the application of the Evory and Heston invention; it is not designed to have and does not have the front and back portions of its upper so united by an elastic or an expansion gore piece as to bring those parts together around the ankle by any attaching devices connected with such gore pieces, but is, on the contrary, of another type, in which the quarters extend forward and lap over the upper part of the vamp, the attaching devices being in the usual way connected directly with the front edge of the quarters, and the little triangular stay piece at the lower front edge of the quarter not extending up nearly to the top of the shoe or reaching above the very lowermost limit of the fastening devices. The Exhibit Packard Shoe has no expansion-
gore flap or double extension gore, or no gore flap of any kind,
51 as the term is used in the patent in suit—that is, it has no extension gore or other gore outside of the shoe proper, and no gore running to the tops of the front and back part of the shoe so as to keep out dirt and water; nor has it any device whatever serving to enlarge the opening for the insertion of the foot, but instead of this it has a strengthening stay inserted between the gore part of the quarter and of the tongue or vamp, serving to limit the opening and prevent the shoe from being expanded to the extent which it otherwise might be opened. This limiting stay is designed to lie flat between the quarter and tongue or vamp, and would so lie if properly attached, or if the shoe had not been distorted at some time.

With a shoe of this construction no possible advantage is derived from the wrinkle or fold which appears in the stay inserted on the left side of this shoe, but such fold is a serious injury to the shoe, because it makes a bunch along the side of the shoe which would be painful to the wearer.

In my opinion, no shoe made in accordance with the patent to

Packard of June 18, 1878, can embrace the invention set forth in the patent in suit, for the reason that the shoe decribed in the Packard patent has no extension-gore flap corresponding at all to the "double extension gore" or the "expansion-gore flap C D" of the patent in suit. The Packard patent shows a flat piece of leather lying, in use, between the quarter and the tongue or vamp constituting the front part of the shoe. Two figures of the drawing show this piece, which lies between the quarter and tongue when the shoe is in use, as made of one continuous piece or integral with the front of the shoe; and in Fig. 2 such piece is shown as stitched to and permanently connected with the vamp or front, while in the shoe shown in Fig. 4 this piece may be of either construction. In either case this piece is essentially a part of the tongue or vamp to which the invention relates, and is no part of the quarter, but lies, like other parts of the vamp, within the quarter at its front edge on each side of the shoe. The Packard patent states concerning the invention therein disclosed: "A represents the body portion of the tongue, which is of the usual form; and the portion thereof marked 'B' represents my improvement, which consists of a wing or flap,
52 either integral with the main portion of the tongue or formed of a separate piece and united thereto. This flap is cut in form shown, so that whether the tongue be made of one or two pieces the corner slot or opening C is left between it and the other part of the tongue, for the purpose to be hereinafter explained." The subsequent explanation of this feature is in the words: "When the shoe is on the foot, and the parts buckled or laced, the wings or flaps are folded externally over the tongue piece from the lower portion of the slots at each side, thus bringing the laps outside and leaving no projecting portions inside to hurt the foot."

Both clauses of the claim present as the essential feature of the invention a tongue or instep piece having projecting wings with "slots or openings C intermediate of said flaps and the body of the tongue." By reason of this construction these wings projecting from the sides of the tongue or vamp may be turned back and laid flat upon its outer surface and between such outer surface and the inner surface of the quarter.

The slots or openings C permit the parts B of the vamp to be thus turned back and to lie flat between the vamp proper and the quarter, as they could not do otherwise. This peculiarity of construction is wholly unlike the "double extension gore" or "expansion-gore flap C D" of the patent in suit. The Packard invention is entirely independent of the bellows action of the shoe described in the patent in suit—that is, the expansion is not due to a double or folding gore piece, but to a flat or single piece projecting from each side of the vamp, and so nearly detached from the vamp by reason of the deep slots C C as to be capable of turning back on the outside of the vamp of which it is a part, while its outer edge is attached to the front edge of the quarter below the fastening devices.

Int. 3. Suppose that the wings of the vamp you have spoken of, or the piece which is shown in Complainants' Exhibit Packard Shoe and in Defendants' Exhibit Packard, were altogether omitted from

the cut of the tongue or vamp, what would be the effect on the shoe, so far as its capacity to receive the foot is concerned?

Ans. The opening at the top of the shoe would, in that event, be enlarged, since the wings, when attached to the quarters, limit
53 the extent to which the upper part of the tongue or vamp can separate from the quarters.

Int. 4. Will you look at the shoe upper now shown you and state whether or not it represents the upper of the shoe described and claimed in the Evory and Heston patent?

Ans. I see no respect in which the shoe upper now shown me does not correspond with and properly represent the shoe upper shown, described, and claimed in the Evory and Heston patent.

(The upper inquired of is put in evidence and marked "Exhibit Evory and Heston Shoe."

Objected to by complainants' counsel as an improper representation of a shoe constructed according to said patent.)

Int. 5. In describing any shoe shown in the Evory and Heston patent, is it proper to regard the gore flap as forming an extension either of the vamp or the quarter of the shoe there described?

Ans. I should say not. The Evory and Heston patent distinctly specifies that the gore flap is of two distinct pieces sewed together at their edges, "the external fold C of which is attached to and in front of the quarter B, and the internal fold D of which is attached to and in rear of the vamp A, the said several parts and pieces being respectively constructed and the whole arranged for use substantially in the manner and for the purpose set forth." The construction and arrangement described and shown and the several parts and pieces referred to forbid the supposition that the parts of the double extension gore are really extensions of vamp and quarter respectively. Furthermore, their function is wholly inconsistent with this supposition.

Int. 6. Now, will you please to assume that it may not be material whether the gore flap of the Evory and Heston patent is made in two pieces or not, and that its function as an extension-gore flap, whether made in two pieces or not, is the same as that already described, can such a gore flap be regarded either as an extension of the vamp or an extension of the quarter of any shoe within the purview of the patent in suit?

Ans. It cannot, without eliminating what little of novelty there is in the patent, in view of the state of the art as known to me.

Int. 7. Are you acquainted with any other patent in which
54 there is a substitute for the old-style elastic gore piece of the congress gaiter above alluded to by you; if so, will you please to state whether in such patent the gore flap is so arranged that it lies entirely outside of the body of the shoe?

(Objected to by complainants' counsel as incompetent, and objection is also here taken to any question relating to prior patents, except those set up in the answer.

Counsel for defendants suggests no patent except those set up in

the answer will be here referred to, except so far as they may illustrate the state of the art at the time the patent in suit was granted.)

Ans. Two copies of United States patents involving the construction referred to in the question, are now before me: that of Samuel Babbitt dated March 7, 1865, and that of Brown & Wooton, dated Aug. 1, 1865. Both of these patents show an extension-gore flap wholly outside of the shoe proper—that is, folding with a double layer of leather outside of the shoe proper when applied to the foot. In both cases these expansion-gore flaps are employed for the purpose of enlarging the opening for the insertion of the foot, and by folding together and fastening down outside of the shoe proper to prevent the entrance of dirt or water. In both cases the functions of the folded gore flaps are the same as are those ascribed in the patent in suit to the construction and arrangement set forth in the Evory and Heston Patent—that is, they serve as a substitute for the elastic gore previously used to admit the foot and exclude dirt and water.

(Counsel for defendants offers in evidence a certified copy of the patents referred to in the foregoing answer, and they are marked "Exhibit Babbit" and "Exhibit Brown and Wooton."
Objected to by complainants' counsel, as said patents are not set forth in the answer.)

Int. 8. Will you please to look at the shoe upper now shown you and state whether or not it represents an upper constructed substantially in accordance with the Babbit patent?

(Same objection.)

Ans. So far as relates to the enlargement of the opening to admit the foot and the employment of a double gore flap folding entirely outside of the shoe upper, it represents the construction set
55 forth in the Babbit patent. The fastening device is somewhat different from that illustrated in said patent.

(The upper referred to is put in evidence and is marked "Babbit Shoe."
Same objection.)

Int. 9. Will you please to examine the pattern of shoe shown in the drawing of the Brown and Wooton patent, and state in what respect, if any, the shoe upper of that pattern differs from the pattern shown in the patent of Babbit?

Ans. The shoe shown in the Brown and Wooton patent is an improvement over Babbit's shoe, in that the expansion-gore flaps extend each way from the vertical opening at the rear, and fasten in front of the shoe around the ankle of the wearer, and bringing the rear edges of the shoe proper at the vertical opening referred to into contact with each without the formation of a ridge due to the folding of the gore piece at the heel in the Babbit shoe. Furthermore, the fastening device is such as to make no opening into the interior of the shoe, which in the Babbit shoe might admit water, in the event of the eyelets being inserted in the side of the shoe

proper. The importance of a smooth finish at the heel, where the expansion gore is attached to the shoe, is as great in the Brown and Wooton shoe as it is in the patent in suit, which requires that a smooth finish be given at each side where the expansion-gore pieces are attached.

Int. 10. Do you understand that a smooth finish, meaning thereby the absence of a fold of the extension-gore flap of the patent in suit, is any part of the invention therein described?

Ans. I do not consider that Evory and Heston were the first to make a shoe having an extension-gore flap which did not fold inwardly against the foot so as to leave a ridge where the gore flap was doubled, since the Brown and Wooton patent, as already stated, shows such construction adapted to give a smooth finish internally.

Int. 11. Will you look at the copy of British patent No. 185 of 1856, and at the copy of the British patent No. 1954 of 1860, and state whether or not you have examined said patents; and, if so, will you state whether or not the alleged invention of Evory and Heston is there substantially shown and described? I also show you a pattern of a shoe upper and inquire whether such
56 pattern is shown in either of the drawings of said British patent; if so, in what figures?

Ans. If the invention of Evory and Heston is a shoe having a folding or double expansion gore broadly, the shoe upper now shown me, illustrating generally Fig. 12 of the first British patent referred to and Fig. 17 of the second of said patents, will anticipate said invention, since said figures show gores inserted between the vamps and quarters in such position as to fold centrally when the shoe is fastened about the foot and to unfold to admit the foot. I have, however, considered that the Evory and Heston invention was limited to the thing specifically described in the patent in suit, for which a limited claim was granted, and that if limited as its terms imply it would not embrace the exact construction of shoes shown in the two British patents and in the shoe upper now shown me.

(Copies of the British patents referred to are here put in evidence and marked "Stephen Norris Patent" and "Norris and Rogers Patent, respectively, and the shoe upper referred to is also put in evidence and marked "Exhibit Norris.")

Int. 12. Will you please to state whether, in view of the invention described in the said British patents, there would be any novelty in attaching the gore to the front line of the quarter and to the rear line of the vamp?

Ans. There would be no novelty in such construction.

Int. 13. Whether or not the fact that in the illustrations given of the invention described in the British patent above referred to the gore flap is folded so that it rests partly against the foot instead of being wholly on the outside of the shoe proper is any substantial objection to such construction, or a different method of folding any substantial improvement?

Ans. I think not; since with such a construction as is shown in the upper Exhibit Norris the gore piece, being of thin, soft leather

does not by its folding at each side of the foot cause any serious discomfort to the wearer. There is no necessity for thick, heavy leather in such internal gore pieces, since they are not exposed to any external wear or to any strain when in use, as they are in the construction shown in the patent in suit. The British patents and Exhibit Norris, as well as the Packard patent and Complain-
57 ants' Exhibit Packard Shoe, show the fastening devices as connected directly with the quarters at their front edges, and not connected to the front edges of the double extension-gore flaps outside of the shoe proper, as in the shoe described in the Evory and Heston patent.

Int. 14. Will you state whether, under the British patents, the pattern of a shoe upper might be cut so as to require the attachment of a gore piece between the front of the quarter and the rear of the vamp, so that when folded such gore flap would lie wholly outside of the vamp of the shoe?

Ans. The illustrations in the British patents referred to are mainly of shoes having the gore pieces folding inwardly; but in the patent No. 185 of 1856 the specification states that "the principal points to be attended to in these improvements are to have the gussets the proper size, and to connect them to the front and back part of the boot or to the back part only thereof by sewing and stabbing or other known means, so that they may when necessary be rendered water-proof; and this applies more particularly to men's boots; and, as regards the fastenings for securing the boots on the feet, I employ any of the known means for that purpose."

(Adjourned.)

APRIL 8, 1882.

Int. 15. Mr. Brevoort, in his deposition in behalf of the complainants in this case, says that in the Packard shoe there are two flaps which are necessary to the formation of the expansible-gore flap; will you please to point out the error, if any there be, in said opinion on that point?

Ans. The primary error in that statement is in the assumption that the Packard shoe has any expansible-gore flap in the sense in which that term is used in the patent in suit, since it is obvious on inspection that said shoe has at each side a single stay piece which is a limitation to such expansion as the shoe would otherwise have, and that such stay piece is radically unlike the double expansion-gore flap of the Evory and Heston patent. It is true that "two pieces are necessary to the formation of the expansible-gore flaps" described and claimed in the patent in suit; but that statement has no application to the Packard shoe, which has no such external and double expansion-gore flap.

58 The Packard shoe, aside from the little triangular piece inserted at each side of the base of the tongue, is of a very old style—a tie or buckle shoe having a broad front piece or tongue, such as I have known from my boyhood. In my opinion, the use

of such flat stay piece does not incorporate into such a shoe the double expansion-gore flap, formed wholly external to and folding upon the outside of the shoe proper, as set forth in the patent in suit. In my opinion, this latter and characteristic and essential feature of said patent cannot be employed in a shoe like the Packard shoe, because there is no occasion whatever for such external gore flap to which the attaching devices are made fast. The Packard shoe, without such or any gore flap, is complete, and provided with fastening devices in the usual form, while in the shoe described in the patent in suit no fastening device whatever is shown or suggested which is not directly secured to both parts of the two expansion-gore flaps. The shoe described in said patent, like the elastic gored shoe for which it is substituted, depends on the gore piece for fastening about the ankle of the wearer. It is not so of the Packard shoe or of the shoe described in the Packard patent, nor of the shoe described in the British patents shown in the drawings to which I have above referred. In each of these shoes the quarters themselves, and independently of the gore pieces, receive the fastening devices, and, without regard to the gore pieces, are fastened about the ankle in the time-honored way.

Cross-examination by C. W. BETTS, Esq., of counsel for complainants:

Cross-int. 16. You were asked in Int. 6 to assume that it may not be material whether the gore flap of the Evory and Heston patent is made in two pieces or not. Now, will you please state whether in your opinion a shoe constructed according to the Evory and Heston patent in every respect, except that the gore flaps are each made of one piece, would include the invention shown in that patent?

Ans. As I understand the question, the shoe supposed would include double expansion-gore flaps made each of a single piece, doubled or folded back so as to bring the internal surfaces of those pieces into contact when the shoe is in use, both lying outside
59 of the shoe proper and having the attaching devices at the forward extremity of said gore flaps, where they are folded as they are in the patent in suit. Such construction would, in my opinion, be within the invention set forth in the patent in suit.

Cross-int. 17. The advantage of having them in two pieces is one of economy, so that smaller scraps can be used, is it not?

Ans. That might be an advantage in an economical sense, although the patent does not suggest it.

Cross-int. 18. Look, if you please, at Defendants' Exhibit Evory and Heston shoe and state if you see any difference between the construction of that shoe and the figures of the Evory and Heston patent.

Ans. The exhibit has three eyelet holes for lacing, while the drawings have two in each of the double gore flaps. Two of the drawings indicate a finished shoe, which the exhibit does not show. Fig. 2 of the drawings has two irregular lines running back the whole length of the vamp, which I do not understand, which are not shown in the exhibit. The shoes shown in the drawings have lacings in

the eyelets, which the exhibit has not. I notice no other differences.

Cross-int 19. Is the construction of that Exhibit Evory and Heston shoe, with the gore flaps, composed of a different material from the body of the shoe in accordance with any instructions found in the Evory and Heston patent?

Ans. I do not think the Evory and Heston patent has a word about the kind of material to be used, whether leather or some other material. The exhibit is of leather throughout, which is the most common material for making shoes.

Cross-int 20. Under whose direction was this exhibit made?

Ans. I don't know anything about it. The defendants', I presume.

Cross-int 21. Now look, if you please, at the seam which united the external fold, marked "C" in the patent, to the front of the quarter and state whether in the exhibit that seam corresponds with the drawings, Figs. 1 and 4, of the patent.

Ans. It would seem from the patent drawings that the rearward edge of the outer fold C of the gore flap lies within or behind the forward edge of the quarter B, which form of seam is a common one in shoemaking, and especially in attaching elastic gore pieces to the quarters and vamps of shoes. The seams on this Exhibit Evory and Heston Shoe are mostly of another well-known form, where the edges to be united are placed upon each other and stitched through and through so as to bring both edges of the leather on the inside, as they are in the part inquired about in the question. This gives a neater external finish, and is therefor preferable except for stiff leather.

Cross-int. 22. With that seam as made on the Defendants' Exhibit Evory and Heston Shoe what would be the result if the same sort of leather used in the body of the shoe had been used in forming the exterior fold C?

Ans. A seam would have resulted precisely like what is shown in said exhibit, where the stock is united by the front and rear seams, which are such as are generally used with such stock.

Cross-int. 23. The outer fold of the flap, when the seam is made as in the exhibit, tends to lie back towards the heel, does it not, just as the internal fold tends to lie forward, and this tendency to lie back would increase if the leather of the fold were thicker?

Ans. There is no such tendency when the shoe is complete, since the seams are hammered or rubbed down in shoemaking.

Cross-int. 24. If this seam were made in a shoe where the external fold was of the same material as the body of the Exhibit Evory and Heston Shoe would not the fastening of the flap forward around the ankle make a ridge within the shoe that would be uncomfortable?

Ans. No; the rear edge of the vamp and the rear edge of the internal fold of the gore flap being united by such a seam through and through as the exhibit shows would give two thicknesses of the stock at that point, lying flat upon each other and extending forward smoothly around the ankle. The external fold of the gore flap secured by such a seam to the front edge of the quarter would, by the fastening devices, be drawn forward outside of the two thick-

nesses of leather just referred to, bringing the front edge of the quarter, or the seam which unites it to the external fold of the gore flap, in contact with the rear edges of said two thicknesses of stock.

61 This would be the smoothest construction, internally and externally, which could be adopted for uniting the two gore flaps to the shoe proper. It is obvious that the kind of seam which has been referred to, as indicated by the drawings of the patent, could not be used in joining the internal fold of the gore flap to the rear edge of the vamp without immediately turning back the said fold upon itself and making three thicknesses in addition to the external fold.

Cross-int. 25. Then, in your opinion, the Defendants' Exhibit Evory and Heston Shoe shows an improvement in the method of constructing the shoe over that shown in the patent?

Ans. No; the two forms of seam are equally well known, and the specification is silent as to the kind of seam.

Cross-int. 26. Do you think that a practical workman in following the Evory and Heston patent would make the sort of seam shown in the Exhibit Evory and Heston Shoe uniting the parts B and C, and would use the soft material for the external fold, instead of making the seam in the manner shown in the drawing, Fig. 1 of the patent, or shown uniting the vamp and quarter of the Defendants' Exhibit Norris, with the same kind of material for the quarter and the external fold?

Ans. I think if a practical workman should ever undertake to make a shoe according to the Evory and Heston patent he would be likely to use the most convenient form of seam in attaching the two pieces of the double gore flap to the parts to which they are united, using the same seam in both cases. I think he would use stock for the gores sufficiently thick and strong, so that it would bear the strain of fastening the shoe, and no thicker, because there are in any event three thicknesses of leather over that part of the foot where the gore comes.

Cross-int. 27. Which do you regard as the neatest seam—that which unites the external fold to the quarter in the Defendants' Exhibit Evory and Heston Shoe or that which unites the vamp to the quarter in the same exhibit?

Ans. The seam which unites the external fold of the gore to the quarter, since it makes a finish which the other seam does not possess, and conceals the raw edge of the leather.

Cross-int. 28. In the patent of Fred. Packard, No. 205,129, do you think there is any difference in principle whether the wing or

62 flap marked "B" is "integral with the main portion of the tongue or formed of a separate piece and united thereto?"

Ans. No.

Cross-int. 29. In the patent of Evory and Heston, do you think the principle would be embodied in a shoe constructed exactly as therein shown, except that the vamp and quarter were extended upward, say from an inch to three inches, to form a higher shoe?

Ans. The question is ambiguous, in that it does not specify

whether the principle of the Packard patent last inquired about or the principle of the Evory and Heston patent is referred to.

Cross-int. 30. The question relates solely to the Evory and Heston patent. With that understanding, I request the examiner to repeat it.

Ans. If the shoe was otherwise constructed, as shown and described, an upward extension of the vamp and quarter would not, in my opinion, depart from the principle set forth in said patent.

Cross-int. 31. If a shoe were constructed exactly in accordance with the Evory and Heston patent, and the external and internal folds C and D were then cut down, say an inch or more, so that their upper lines did not run upward from the point of fastening, as shown in the drawing, would such a shoe still embody the principle set forth in that patent?

Ans. I think so.

Cross-int. 32. The size of the gore flap, then, is not made in this Evory and Heston patent an essential part of the principle involved?

Ans. A gore flap essential to the principle of the Evory and Heston invention is an extensible one, composed of two pieces folding flat upon each other and connecting extensively the vamp and quarter as do the elastic gores of congress shoes. The size of such gore flaps must be proportionate to the dimensions of the pieces united as elastic gores are, though I do not consider that a slight variation in height would avoid the patent. If the drawings are a guide for all points not specified in the description, the gore pieces should extend to the same height as do the vamp and quarter where united to them.

Cross-int. 33. Now, please look at Complainants' Exhibit 63 Packard Shoe and state whether or not that would be a practically working shoe if the vamp and quarter were stitched together on the lines where the rear of the vamp comes against or near the quarter when the shoe is buckled.

Ans. They are so stitched together at the lower parts of the vamp and quarter in the usual way, and are entirely practical with such construction, with or without the interposed stay piece. The shoe would not be practical if the parts were stitched together at all parts where they come in contact clear to the top of both parts, whether with or without the interposed stay pieces.

Cross-int. 34. Do you regard the tongue A, shown in the Packard patent, as a part of the vamp proper?

Ans. Yes; it is an essential part of the vamp shown, described, and claimed in the Packard patent, and is described as separated from the rings B B by deep slots lettered C. Such slots could not exist without a portion of the stock bounding them on the side opposite to each wing B, and this portion of stock is the part lettered A, which is the tongue of Exhibit Packard Shoe.

Cross-int. 35. Now, suppose the vamp of the Defendants' Exhibit Packard was extended upward from the lines where the wings are attached in the direction of those lines, so that the top of the vamp should be square and the sides straight and slightly converg-

ing toward the top, would that make any practical difference in the operation of this shoe?

Ans. I understand the question to ask if the straightening of the curves in the marginal lines of the vamp in Exhibit Packard immediately above the triangular stay pieces would make any practical difference in the operation of the shoe. I answer, No, if the construction was otherwise as shown in said exhibit.

(Counsel for the respondents here states that the admission of the answer in relation to the manufacture and sale of shoes and gaiters constructed according to the invention shown and described in the patent granted to Packard June 18, 1878, was not intended to be construed, and, as is believed, does not admit of the construction that the defendants have ever made or sold any shoes which were in any sense expansible forward in any manner whatever otherwise than is necessary in any shoe with or without the stay piece
64 shown in said patent; and counsel further says that, unless the construction here given to the answer is acceded to by complainants, the defendants will ask the court for leave to amend.)

Cross-int. 36. Now, please look at the Exhibit Packard, and suppose that the tongue were constructed with straight sides, as in your last answer, and suppose that the wings were extended upwards so as to fill the entire space between the vamp and quarter when the top of the shoe is extended—these extensions of the wings being stitched to the rear of the vamp and front of the quarter on each side, would such an extension of the wings make any difference in the ease with which the shoe was put on?

(Objected to because not relating to any point of the direct examination, and also because there is nothing in the Packard patent or in the Exhibit Packard which would justify any extension of the wings.)

Ans. Yes; Exhibit Packard and Exhibit Packard Shoe both show a peculiarity of defendants' shoes which would prevent the construction suggested in the question. The forward edges of the quarters turn sharply back from a vertical line at the upper edges of the stay pieces, and the eyelets for fastening are inserted in such rearwardly cut parts that it would not be practical to continue the stay pieces above the angle referred to, first, because it would interfere with the lacing, and, second, because it would restrict the opening. Exhibit Packard and Exhibit Packard Shoe show the stay pieces to be entirely free from the devices employed to fasten the shoe around the ankle, which would not be the case if said pieces were extended upward and connected with the front edges of the quarters to the tops thereof. The construction suggested in the question would involve a material departure from Defendants' Exhibit Packard or Complainants' Exhibit Packard Shoe, and would not be a difference of degree merely.

Cross-int. 37. In a shoe in which the buckle and thong were the only means of fastening, such a construction would not interfere with the fastening, would it?

Ans. Neither the buckle nor thong would necessarily be secured to the stay pieces.

Cross-int. 38. You omitted to notice in my former question, cross-int. 35, that it was assumed that the wings when extended upwards should be sufficiently large "to fill the entire space between the vamp and quarter when the top of the shoe is extended." Do you mean to be understood as saying that such a construction would "restrict the opening?"

(Objected to because of the reason already stated, that the Packard patent admits of no construction by which wings are to be employed for the purpose of enabling the vamp to be extended forward; and also because if that construction of the patent be admissible it was not so understood by the defendants when they admitted that they had made and sold shoes constructed under the Packard patent.)

Ans. Yes; I do mean just that; and I mean that any construction of a shoe which connected the wings B to the upper part of the tongue A along the edges of those parts, as the last three questions imply, would omit from shoes so constructed the slots C, which are essential to the Packard invention and to both claims of the Packard patent.

Cross-int. 39. Now, suppose that the quarter of the Exhibit Packard Shoe and of Exhibit Packard, instead of being constructed of two pieces united together at the back, were, for the sake of economy, constructed of three or four pieces stitched together at any convenient places, would such a shoe still contain the essential features of the shoe described and claimed in the Packard patent.

Ans. The Packard patent does not specify, so far as I know, the number of pieces of which the quarters are composed, the invention relating to the vamp or tongue with a wing on each side thereof. To avoid misconstruction I will say that, whether of one piece or of two or more pieces, the quarters are those parts of the shoe which extend forward and lap over the tongue or vamp and have at their extreme forward edges, in these shoes inquired about, devices for fastening the shoe for use on the foot.

Cross-int. 40. This would be the case, would it, wherever the seams uniting these three or four parts together might be?

Ans. In the class of shoes illustrated by Exhibit Packard and Exhibit Packard Shoe the quarters always extend forward and cover the tongue to a greater or less extent, regardless of the gore pieces or of the number of pieces composing the quarters.

Cross-int. 41. And it would be quite immaterial, would it, if one of those lines of stitches uniting the parts together should be
66 upon the quarter of Complainants' Exhibit Packard Shoe in a line directly over the line of the rear of the vamp as it lies when the shoe is buckled?

(Objected to as before, and counsel for defendants requests counsel for complainants to state on the record the object of the question, which appears to be wholly outside the range of the direct examination.

Counsel for complainants states that the object of the question is to learn the views of this expert on the subject.)

Ans. The construction suggested would be ridiculous and wholly unlike anything suggested in the Packard patent or indicated in Exhibit Packard Shoe. When I say that the quarters may be of one piece or of two or more pieces I mean to imply a reasonable construction of the shoe, which would represent what is known to any person accustomed to make or to wear shoes as a proper quarter for a shoe and not an excrescence or a projecting flap, such as has been suggested in this case as a mere extension of the quarter. The quarter of a shoe is as well known as the sole or the heel, and if made in three or four pieces would not be the gore flap of the patent in suit, having its external fold attached to and in front of the quarter. The quarter and the gore flap are two wholly different things.

Cross-int. 42. That does not answer my question, and I therefore put it in a different form. Suppose that I should cut the quarter of the Complainants' Exhibit Packard Shoe on the line under which the rear edge of the vamp lies when the shoe is on the foot (and which line I now scratch on the surface of that shoe, extending it up to the top of the quarter), and, having entirely severed that front part of the quarter from the rear part, suppose I should then stitch it on again, or should stitch on another piece a little larger, so as to cover the row of stiches, but otherwise the same, would this make any difference in the practical working of the shoe or in the principle upon which it works?

(Same objection as before, and counsel for defendants states that the construction placed by complainants' counsel on the defendants' answer implies and ascribes to them a false statement, unless the answer is further explained by inserting after the figures
67 205,129 the following words: "Meaning thereby shoes having an upper of the identical pattern shown in the drawing of said Packard patent.")

Ans. If a seam was formed, as now proposed, along the line drawn by counsel, without otherwise altering the quarter or adjacent parts, no change in the principle would follow.

Direct examination resumed:

Int. 43. Do you mean that if the part were cut off along the mark made by counsel and if a longer piece or a wider piece were sewn on in its place the other parts of the shoe, not being altered, would be represented either by the patent in suit or by the Packard patent?

Ans. No. The change suggested by cross-int. 42 is not suggested in either of the patents, and my answer to that interrogatory is on the assumption that no change in the dimensions, arrangement, or mode of connecting the parts is made other than sewing together two parts of a quarter which were before integral or substituting a piece in place of one cut off sufficiently larger only to provide for the seam, but otherwise the same as before the cutting.

(Counsel for defendants here gives notice to counsel for complain-

ants that by taking evidence on the part of the defendants he does not intend to waive a right to object to the evidence heretofore offered by the complainants as argumentative and fallaciously so, or as insufficient to establish a *prima facie* case.)

Cross-examination resumed:

Cross-int. 44. Do you regard the wing B, as shown in the Packard patent, as a part of the vamp, whether it be integral with the main portion at the toe or formed of a separate piece and united thereto?

Ans. Yes; and the Packard patent so states it.

ALBERT H. SPENCER.

Attest: CHAS. H. SWAN, *Examiner.*

68 *Evidence for Complainants in Reply, Taken Pursuant to the Sixty-seventh Rule of the Supreme Court of the United States, in Equity, as Amended, before me, Joseph Gutman, Jr., Examiner.*

Present: Frederic H. Betts, of counsel for complainants; George D. Noyes, of counsel for defendants.

Deposition of Henry L. Brevoort.

NEW YORK, *May* 26, 1882.

Direct examination by FREDERIC H. BETTS, Esq., of counsel for complainants.

Int. 1. Have you been already examined in this case?

Ans. I have.

Int. 2. Have you examined the specimen of shoe marked "Defendants' Exhibit Babbit Shoe, C. H. S., ex'r," and do you understand the United States letters patent granted to Samuel Babbit March, 7, 1865, and Brown and Wooton, dated Aug. 1, 1865?

Ans. I have examined the exhibits referred to and understand what they show.

Int. 3. Please compare the shoes referred to in the Babbit and Brown and Wooton patents with the construction of shoe described and claimed in the Evory and Heston patent, and state whether they are substantially similar or dissimilar, and state what, if any, advantages or improvements are found in the Evory and Heston shoe as compared with those of Babbit and Brown and Wooton.

Ans. The Babbit patent shows a shoe substantially such as is illustrated in the Defendants' Exhibit Babbit Shoe. The Brown and Wooton patent describes a shoe having projecting from the rear of the quarter two flaps which are united to a third piece, which, when the shoe is upon the foot of the wearer, laps arcund both ways and is fastened forward. In both of these patents there is an

69 opening or vertical slit formed at the extreme back or heel of the shoe, which is closed by the folding of the flaps of the shoe forward. In neither of these shoes is the opening arranged at the front or at the side of the shoe, in either of which places the extent of movement of the foot in the shoe is less than at the heel;

but, on the contrary, it is so located in the shoe as to be directly against the heel; and it is well known that the action of walking always tends to lift the heel in the shoe at each step, and that the tendency to abrasion is greater at the heel than at any other part of the shoe, owing to the greater tendency to movement of the foot in the shoe and to the greater length of movement of the foot in the shoe at that point. Any opening in a shoe of course interferes with the fit of the shoe at the point of opening, and the edges at an opening tend to abrasion of the foot; it is therefore true that in the Babbit and Brown and Wooton shoes the opening is at the most disadvantageous point in the shoe, as respects the tendency of a shoe to abrase the foot. In the Babbit shoe the fastening has to be accomplished, as is shown in the model, by a prolonged strap, which passes entirely around the foot and back again to the rear of the shoe; and in the Babbit patent a shoe is shown which is an uneven or ill-balanced and awkward-looking shoe, having the flaps extending only on one side of the shoe. This latter defect, it is true, does not exist in the Brown and Wooton shoe, which has a flap on both sides, and which, in this way, is given a more even and balanced appearance; but the use of flaps extending from the heel all the way to the front is, in any mode of constructing them, a clumsy form of shoe, requiring a large amount of stock, and which would be unnecessarily stiff and warm to the foot, owing to the fact that there is double material over both sides of the foot from heel to front. The Evory and Heston patent, on the contrary, has no opening at the heel, but has openings on each side, where the necessity of a close fit is not so great as at the heel, and at each opening there is a double extension-gore flap, which fastens together at a single point. The openings in the shoe are at the point where the wear on the foot in a properly constructed shoe is least. Less material is required than is needed for a shoe whose opening is in the rear, with flaps on each side, and the shoe is lighter and cooler to the foot than that of Brown and Wooten, and not uneven and ill-balanced like that of Babbit. I did not think that either the Babbit shoe or the Brown and Wooton shoe, as described in the respective patents, does contain the invention set forth in the claim of the Evory and Heston patent.

70

Int. 4. Have you examined and do you understand the British letters patent of Norris, put in evidence by the defendants, and the construction of shoes therein shown, particularly that of the shoe shown in Fig. 12 of the first of said patents and Fig. 17 of the second of said patents; and have you also examined and do you understand the construction of the model introduced by the defendants, marked "Defendants' Exhibit Norris, C. H. S., ex'r?"

Ans. I have examined the patents referred to in the question, and I think I understand what they show and describe; and I have also examined the exhibit marked "Defendants' Exhibit Norris," and I understand its construction.

Int. 5. Do you agree with the expert for the defendants, Mr. Spencer, when he says that in his opinion the Evory and Heston

invention would not embrace the construction of shoes shown in said two British patents of Norris?

Ans. I do.

Int. 6. Please compare the invention of Evory and Heston with the said Norris shoe, and state whether they are substantially similar or dissimilar, and state any advantages or improvements found in the Evory and Heston shoe.

Ans. I have made the comparison called for in the question, and I do not think that the shoes shown in the Norris patent contain the invention of the Evory and Heston patent. As I understand it, the Norris patents show shoes substantially like Defendants' Exhibit Norris. By examining this exhibit it will be seen that the quarter is carried forward so as to overlap the vamp, the vamp extends but a short distance back, and an internal gusset or gore is sewed to the shortened vamp, then runs back within the shoe for a certain distance, is folded upon itself and again carried forward and sewed to the quarter of the shoe. Thus, when the shoe is upon the foot of the wearer and the flaps are folded forward upon the foot, the gore or gusset is left folded inside of the shoe proper, and is in direct contact with the foot of the wearer. The Norris patents do
71 not state of what material the gusset or gore is composed, and it is evident upon consideration that the Norris construction possesses several disadvantages as compared with the form of shoe as described by Evory and Heston. If the Norris gore or gusset is made of thin leather it is liable to roll up within the shoe, either in the act of putting the shoe on or by the motion of the foot of the wearer, and cause great discomfort; and if it is made of heavy leather, so that the danger of rolling up will be lessened, there will be a heavy projection at the point where the gusset is folded; and as a seam is also formed at the point where the gusset is attached to the vamp, the foot will be subjected to liability to abrasion from two prominent ridges at some distance apart on each side of the foot. It will be seen that the maker of Defendants' Exhibit Norris Shoe appreciated this and sought to avoid it, for the leather at the junction of vamp and gusset has been skived down so as to make the seam as little objectionable as possible; yet it is clear that the two separate ridges on each side of the foot must always exist.

In the Evory and Heston shoe, on the contrary, the expansive gore flaps are attached to the outside of the shoe proper at the point where the edges of the vamp and quarter meet. The edges of the vamp and quarter make practically only a single ridge, as they abut against each other; and, whether the gore flaps be of thick or thin material, they lie on the outside of the shoe and do not interfere in any way with the fit of the shoe or incommode the foot of the wearer.

In my opinion, there is a very clear and important advantage, due to difference of construction, in favor of the Evory and Heston shoe.

Int. 7. Have you examined the defendants' shoes marked "Exhibit Packard Shoe," and do you understand the construction and mode of operation of the same? And, if so, state whether in your opinion said shoe embraces the invention described and claimed in

the Evory and Heston drawing, in view of the state of the art, and give your reasons for any opinion you may express.

Ans. The Evory and Heston shoe described and claimed in their patent consists of a shoe having double expansible gore flaps on each side of the shoe. These double expansible gore flaps on each side of
72 the shoe are arranged to fold together on the outside of the shoe proper and are fastened at a single point, the fastening operating to hold the gore flaps flat on the outside of the shoe and to secure a close and even fit to the whole structure upon the foot. Referring to the prior state of the art, I have to observe that the Evory and Heston shoe differs from the shoes of Babbit and Brown and Wooton in the fact that the Babbit and Brown and Wooton shoes have no expansible gore flaps on each side of the shoe. The extension of pieces in the Babbit and Brown and Wooton shoes are attached at the rear, and they are required to be very long, and, consequently, awkward in shape if made to fold forward and be fastened at the front of the shoe. Besides this, a slit or opening at the heel of the shoe is in a very bad position for the comfort of the wearer. The heel of the foot always projects more or less from the rear line of the upper part of the foot, and it is a necessity for the comfortable fitting of the shoe that the heel should be smooth and not present any obstructions which would wear the foot. All shoes with any opening in the rear necessitating seams are uncomfortable and objectionable. The Evory and Heston shoe has its seams on each side of the shoe at a point where a shoe with the best fit is necessarily somewhat loose, and it provides for a minimum number of projecting edges by having the extension-gore flap pieces outside of the shoe proper, thereby distinguishing the shoes from those described in the British patents of 1856 and 1860, where the gore pieces fold in the interior of the shoe proper. The defendants' shoe is like nothing shown in the state of the art prior to Evory and Heston; it is constructed upon the same leading idea as that of Evory and Heston. In the defendants' shoe there is only a single seam at each side of the foot at the point where the vamp meets the portion of the quarter which overlaps it. The gore piece is attached to the front edge of this vamp, and it, together with the extended portion of the quarter which forms the other flap of the double expansible gore flaps, lies wholly on the outside of the shoe proper. The portions of a shoe which constitute the shoe proper are those pieces of leather which are cut and fitted on the last so as to conform to and fit the foot, and an examination of the Packard shoe immediately shows that the vamp and those portions of the quarter in the rear of the vamp constitute the shoe proper, and
73 that the front end of the quarter and the thin piece attached to the vamp together constitute a double expansion-gore flap on each side of the shoe, and that such gore flaps are situated externally to the shoe, as distinguished from an internal position. This is indeed expressly admitted in the defendants' patent for these shoes, as already alluded to by me in my previous examination. The Exhibit Packard Shoe is not in quite as good form as the Evory and Heston shoe, because in the Evory and Heston shoe the edges of the vamp and quarter meet at the line of opening on

each side, serving to protect the foot of the wearer from the wear of each edge. In the Packard shoe, owing to the fact that the double expansible gore flap is formed in part of an extension of the quarter, there is not this meeting of two edges, but there is only a single edge or seam on each side of the foot.

Int. 8. Referring to the deposition of the defendants' expert, Spencer, said Spencer states, in answer to the eleventh interrogatory, that in his opinion there would not be any novelty, in view of the British patents of Norris, in attaching a gore to the front line of the quarter and to the rear line of the vamp: State whether in your opinion that is all Evory and Heston did, or whether they did more than that.

Ans. Evory and Heston did much more than what is suggested. They placed their gore flaps on the exterior of the shoe proper, as distinguished from the form of construction shown in the British patents, thereby securing a better fit for the whole shoe, and by attaching their fastening for the shoe to the projecting ends of the expansible flaps they accomplish the result of having said flaps lie, necessarily, flat against the foot.

Int. 9. Referring again to said deposition of said Spencer, I find that he states, in answer to the thirteenth interrogatory, that in the Exhibit Norris the gore piece is formed of thin soft leather, which does not by its folding on each side of the foot cause any serious discomfort to the wearer. Please state whether in your opinion the gore or gusset piece shown in the Norris patents are of thin soft leather, and whether they would or would not cause any serious discomfort to the wearer.

Ans. The British patents of Norris do not state of what material the gusset or gore pieces are made. As already stated by me,
74 thin or soft leather for such internal gussets would be quite as objectionable as thick leather, for such thin or soft leather would tend to roll or wrinkle at the side of the foot and cause very serious discomfort.

Int. 10. Referring again to the deposition of said Spencer, I find that in answer to the fourth interrogatory he states that under the British patents of Norris a pattern of a shoe "might be cut" so as to have the gore flaps wholly outside of the vamp. State whether, as matter of fact, any such construction is shown or suggested in said British patents.

Ans. No such construction is either shown or suggested. On the contrary, the express description in said British patents is of an interior gusset or gore flap. Evory and Heston, so far as I know, first described and suggested the desirability of the external gore flap in the form of shoe described by them. Their shoe presents very material points of advantage over that of Norris.

Int. 11. Referring again to the deposition of said Spencer, I find that in his answer to the second interrogatory he refers to the fact that in the Evory and Heston patent the gore flaps which are united to the front and back parts of the shoe proper "rise as high as do these parts of the shoe," while in the Exhibit Packard Shoe the "triangular stay pieces," as he calls them, do not extend up nearly

to the top of the shoe. Do you regard the above differences as material or substantial?

Ans. I do not. It is very clear the Evory and Heston invention is not departed from by making the gore flaps somewhat lower than the sides of the shoe proper. Indeed, I understand Mr. Spencer does not disagree with me in this, as will be seen by reference to his answer to cross-int. 31.

Int. 12. Do you regard it as a material variation from the Evory and Heston shoe that in the Packard shoe the external fold of the expansible gore flaps is constructed of the same piece of material as the quarter and is an extension of the quarter?

Ans. I do not. It is very evident that this variation and form do not alter the substantial construction of the shoe. In a former case, prosecuted under the Evory and Heston patent against L. Candee & Co., the same difference existed between the defendants' shoe and that of Evory and Heston as exists in the present case. In
75 the L. Candee & Co. shoe the outer fold of the flap on each side was formed by an extension of the quarter beyond the line of junction of the vamp and quarter.

Int. 13. In the said deposition of defendants' expert, Spencer, he refers to the fact that what he calls "little triangular stay pieces" in the Exhibit Packard Shoe limit the opening and prevent the shoe from being extended at the top to the extent which it might otherwise be opened. Does this fact at all prevent, in your opinion, the said stay pieces and the extension and quarter from being regarded as an expansive gore flap on each side of the shoe?

Ans. It does not. It is clear that what is meant by the words "expansive gore flap" in the Evory and Heston patent is that such flaps are to permit the shoe to be extended at the top so as to admit the foot of the wearer. The top of the shoe is extended more than it could be extended if there were no opening in the shoe at each side. Of course, the insertion of the expansive gore flaps limits the expansion of the shoe by the limits of the flaps themselves. But, whatever the limits of such flaps may be, the shoe is, by the opening in which they are inserted, permitted to be expanded more than if not opened at that point.

(Adjourned.)

JUNE 27, 1882.

Cross-examination by GEORGE D. NOYES, Esq., of counsel for defendants:

Cross-int. 14. Do you not assume that the invention of the patentees, Evory and Heston, consists solely in the comparative ease or comfort with which different patterns or [of] shoes, in which water or dirt is prevented from getting in between the vamp and quarter, are or may be worn?

Ans. I assume that the invention of Evory and Heston consists in the particular structure of the shoe shown and described in their patent, which structure results in a shoe possessing, among other benefits, that of comfort to the wearer and the ability to keep out

water and dirt below the lowest portion of the upper part of the shoe.

Cross-int 15. Will you please to state whether you have had
76 any experience in wearing the Norris shoe, or in wearing the very well-known Congress shoe like the exhibit, with an elastic gore between, which comes in contact with the foot when the shoe is worn; or in wearing the Babbit or the Brown and Wooton shoe.

Ans. I have worn very often the well-known Congress shoe, like the exhibit shown me herein, which shoe has an elastic gore on each side, which comes in contact with the foot when the shoe is worn. I have not worn any of the other styles of shoe referred to in the question.

Cross-int. 16. So far as your experience relates to an investigation of the similarity or difference of articles of manufacture in dress for the feet, will you please to state whether the choice of individuals as to what is easy or comfortable is determined by the opinion of an expert or by other considerations?

Ans. I think it is principally determined by the experience of those who have worn the particular kind of shoes in question. However, all persons have gathered a certain amount of experience which goes to teach them what would and what would not be comfortable in a shoe. For example, every one knows that a rough spot in the heel of a shoe produces extreme discomfort, and that a fold in the lining of a shoe will very soon produce a sore spot upon the foot; and this experience has been that upon which I have based my opinions in the present case.

Cross-int. 17. In speaking of the Brown and Wooton, the Babbit, and the Evory and Heston shoe you refer to the "extent of the movement of the foot," the "tendency of a shoe to abrade the foot," "an awkward-looking shoe," "a clumsy form of shoe," and you contrast them to the advantage of the Evory and Heston shoe because that shoe has no opening at the heel, but has openings on each side, where the necessity of a close fit is not so great as at the heel. Do you mean by "openings" that, the quarter being short between it and the vamp, a double extension-gore flap instead of an elastic gore is used, and that, being so used, drawing the folds of the flap together causes an "opening" in the sides of the shoe, as shown in Defendants' Exhibit Evory and Heston Upper?

Ans. I mean that every shoe to be put upon the foot must possess some means of expanding to allow it to go on the foot, and
77 that, when on, some method must exist of closing the shoe around the foot so as to enable it to remain satisfactorily in position. Now, there are very many ways known for enabling a shoe thus to expand and then to be contracted, and in referring to the Evory and Heston shoe and the openings therein I refer to those parts of the shoe proper on each side which separate when the shoe is expanded to admit the foot, and which openings are on both sides prevented from admitting dirt to the interior of the shoe by a double extension-gore flap located outside of the shoe proper, this method being used in place of an elastic gore. By the use of the double extension-gore flaps that opening, which necessarily exists

on both sides with the Evory and Heston method of construction, is prevented from acting as an opening for any other purpose than the admission of the foot into the shoe, preventing foreign substances from getting in, and serving as a guard to the opening for everything except the foot; and the Evory and Heston invention goes to the particular arrangement and location of these gore flaps in relation to the rest of the shoe. The question says, "Drawing the folds of the flap together causes an opening in the sides of the shoe." Now, I do not understand that this is the case, for the drawing of the folds of the flaps together causes a closing of the opening in the sides of the shoe, as is clearly shown by experimenting with Defendants' Exhibit Evory and Heston Upper.

Cross-int. 18. In the third answer you use the words "invention set forth in the claim of the Evory and Heston patent." Will you please to quote the words of the description or specification which describe the invention as you understand it, and which distinguish it from that of Norris, Babbit, and Brown and Wooton?

Ans. I quote as follows: "Our said invention consists in the novel mode of constructing shoes and gaiters, whereby the ordinary elastic goring at the sides and the tedious lacing up at the front are both dispensed with, while at the same time the tops will expand to receive the foot, and fit neatly and closely around the ankle when the shoe is on." * * * Then follows the description of the drawing, which describes a construction in which the gore flaps are upon the outside of the shoe proper; and then follows a disclaimer, disclaiming an expansive gore-flap inserting in
78 the ankles of gaiters; and then follows the claim, which claim distinguishes between a shoe having an opening at the back or between a shoe having a gore flap within the shoe proper. Thus the invention of Evory and Heston is distinguished from that of Norris, Babbit, and Brown and Wooton; for none of these patents describe a shoe having expansible gore flaps on each side, and which are located wholly outside of the shoe proper.

Cross-int. 19. Do you think that Mr. Spencer is mistaken in his opinion that the invention described in the patent in suit belongs to a class of shoes patented by reason of substituting a fold of leather for an elastic gore, so as to enable a shoe to be placed on the foot and to keep dirt and water out when the shoe is worn?

Ans. I think that the invention described in the Evory and Heston patent belongs to a class of shoes in which an expansible gore flap of leather or other appropriate material is substituted for an elastic gore, and that the invention is patentable by reason of the novel arrangement and location of the gore flaps in relation to the shoe proper. I think that Mr. Spencer, in his statement, is rather general and not sufficiently specific, and to this extent he is mistaken.

Cross-int. 20. The fifth question of your deposition assumes, as I think, more than Mr. Spencer testified to, and wholly misrepresents the substance of his opinion. What he said was that the quarter of the Norris shoe it is not like the quarter of the Evory and Heston shoe; that it is not capable of containing the expansible gore flap of

the Evory and Heston shoe, and that any shoe having a quarter like that of Norris, or like that of the Packard shoe, would be impractical with a gore flap, C D, of the patent. Are you not of the same opinion?

Ans. If the flaps C D are to be added to the Norris or Packard structures, as they now exist, the result would be a useless structure; but it must be remembered that, in the Packard shoe referred to in the question, the quarter is so constructed as to act not only as a quarter proper of the shoe, but to act also as the portion C of the Evory and Heston gore flap, the only difference being that Packard makes one piece of leather serve the purpose of two pieces in the Evory and Heston patent.

As to the Norris shoe, as I understand it, Mr. Spencer is right, and the quarter of the Norris shoe is not like the quarter of
79 the Evory and Heston shoe, and that the said shoe is not capable of containing the expansible gore flaps of Evory and Heston without an entire reconstruction of the shoe. It must be borne in mind that the Norris shoe is in substance different from the Packard shoe.

Cross-int. 21 (*de bene*). Do you think that you or any one else would be comfortable in shoes with a good fit around the ankle and having a quarter like that shown in the Norris and in the Packard shoe, and in addition to that, the gore flap C D of the patent in suit? If so, do you think that the comfort of such a shoe would exceed that of a shoe made in the same way with that of Norris or Packard, except that the gore flap C D is omitted?

Ans. The Packard shoe has in substance the gore flap C D of the Evory and Heston patent, and I think, although I have never tried it, that I can wear the Packard shoe with comfort. If the Norris shoe was provided with a flap, C D, in addition to the inside gore flaps that it has, I think it would be very uncomfortable, as also would be the case with the Packard shoe if a second set of flaps, C D, were added to it. In the Packard shoe the gore flaps cannot be omitted and leave a practical structure; in the Norris shoe, as there are no gore flaps which are the equivalents of the gore flaps of the Evory and Heston patent, and marked therein "C" and "D," it would be impossible to omit that which the shoe never possessed.

HENRY L. BREVOORT.

Attest: JOSEPH GUTMAN, JR., *Examiner.*

80 *Further Evidence for Defendants, Taken by Consent as if Pursuant to the Sixty-seventh Rule of the Supreme Court of the United States, in Equity, as Amended, before me, Charles H. Swan, Examiner.*

Deposition of Fred. Packard.

BOSTON, *July* 22, 1882.

Direct examination by GEORGE D. NOYES, Esq., of counsel for defendants:

Int. 1. Will you state your name, age, occupation, and whether

you are grantee of letters patent of the United States No. 205,129, dated June 18, 1878?

Ans. My name is Fred. Packard; I am forty-five years of age; I reside in Brockton, and am a manufacturer of boots and shoes.

Int. 2. What pattern of shoe have you or your associate in business, Mr. John W. Burt, used or sold under said patent?

Ans. The only pattern we have made is called the "Alexis." A few samples were made in which the tongue of our old pattern was made with a wing, which was bent and attached to the front of the quarter, the principal object being to keep dirt and water from getting into the shoe between the vamp and quarter. It occurred to me that every practical purpose would be accomplished by cutting the vamp and quarter precisely as they were in the old pattern, and sewing in a stay piece, as shown in the shoe I have here. The shoe, when the vamp was made with the wings, required a binding where the vamp and lower edge of the quarter came in contact. I found that the leather would not cut to advantage by making wings on the vamps, and therefore cut them entirely according to the original design, and sewed a stay piece to the vamp and quarter. All, except experimental patterns, have been made in this way.

Int. 3. Did you at any time make shoes in which the gore
81 or wing made the shoe expansible? State all the facts bearing on the question.

Ans. No. In the shoes we made under the patent the only effect the gore piece had was to prevent the shoe from being expanded in front or at the sides as much as it was in our original pattern of the Alexis shoe. I notice that in the specification annexed to my patent it is said that the "chief point of superiority, however, is the facility with which the shoe having this construction may be put on the foot, as it opens much wider in front than the ordinary pattern, which is always difficult to put on." If the words ordinary pattern refer to "ordinary Alexis gaiter," in the first clause of the paragraph from which I have quoted, the statement quoted is wholly incorrect I have made no invention which is applicable to any other form of shoe than the so-called Alexis; and in this, as I have already stated, the wings of the vamp, or the stay piece, tend rather to restrain the facility with which the shoe may be put on the foot. If the language of my specification can be construed as meaning that in some other pattern of shoe the gore piece facilitates the putting it on, all I have to say is that I have never made any such shoes, and have never seen any such shoes unless having a cut entirely different from mine. The answer of Mr. Burt and myself relates, of course, to such shoes as we have actually made under my patent. What we say is, in substance, that we regard the shoes like the one I have here as made under my patent, but not under that of Evory and Heston, and that we have never made or professed to make any other form or pattern, or claimed that any other form or pattern is within the scope of my patent.

I offer in evidence the shoe above referred to. I have ripped out the stitching of the gore or stay piece on one side, from which it

will be seen that the front does not open so much on the side having the gore piece as it would if detached.

FRED. PACKARD.

Attest: CHAS. H. SWAN, *Examiner.*

82 EXHIBITS.

Complainants' Exhibit Assignment.

Assignment and power of attorney.

Whereas letters patent of the United States were granted to Alexander F. Evory and Alonzo Heston, bearing date of Nov. 6, 1866, and numbered 59375, for an improvement in boots and shoes; and whereas J. B. Belcher, of Charlotte, Mich., is desirous of acquiring an interest in the said patent:

Now, this indenture witnesseth: That in consideration of the sum of one dollar and other good and valuable consideration, the receipt of which is hereby acknowledged, we, the said Alexander F. Evory and Alonzo Heston, each for himself and collectively, do hereby sell, assign, give, and convey to the said J. B. Belcher an undivided one-half (½) of all the right, title, and interest that we or either of us possess in and to the said patent, the same to be held and enjoyed by the said J. B. Belcher, his heirs, administrators, and assigns, as fully as we or either of us could have done had this assignment never been made. We also hereby empower the said J. B. Belcher to act as our attorney, and to sign our names, bring suit, collect royalty, license others to make and sell under said patent, and to do all other lawful things for us in connection with this patent the same as we could do if personally present and acting; this power of attorney to be good until revoked by a written notice to that effect from both parties.

Witness our hands and seals this 26th day of January, 1877.

ALEXANDER F. EVORY. [L. S.]
ALONZO HESTON. [L. S.]

Signed, sealed, and delivered in the presence of—
F. S. BELCHER.
GEORGE W. SQUIRES.

STATE OF MICHIGAN, } ss:
Eaton County, }

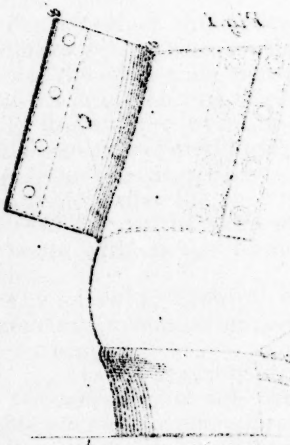
83 DEFENDANTS' EXHIBIT BABBIT. C. H. S., Ex'r.

Letters patent of the United States No. 46622, granted Samuel Babbit March 7, 1865.

Improvement in Gaiter Boots.

Specification.

Be it known that I, Samuel Babbit, of Kokomo, in the county of

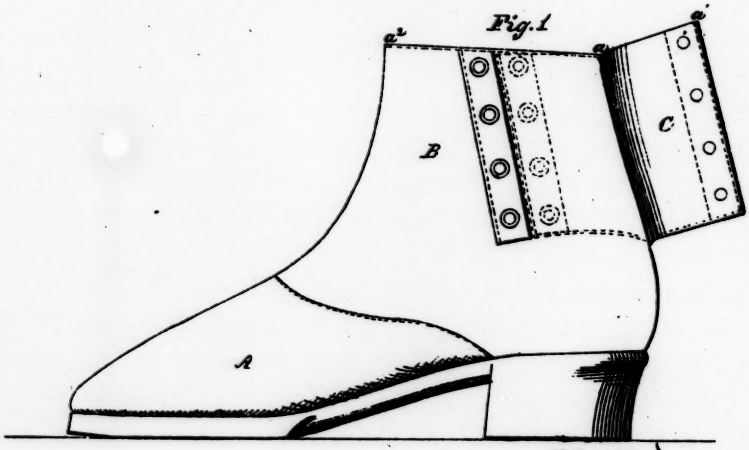


S. Babbit

Gaiter Boots,

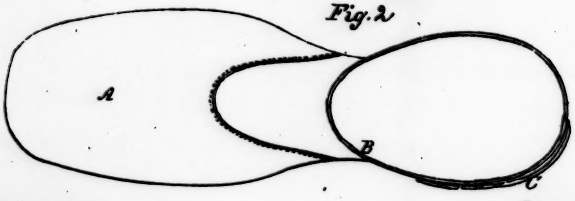
No. 46,622, Patented Mar. 7, 1865.

Fig. 1



No. 439. Burt et al. v. Evans et al. } p. 83a

Fig. 2



Witnesses
C. D. Smith
S. V. Reeve

Inventor
Samuel Babbit
By Munn & Co.
Attorneys

Howard and State of Indiana, have invented a new and useful improvement in gaiter boots, and I do hereby declare the following to be a full and exact description of the same, reference being had to the accompanying drawings (making part of this specification) in which—

(Here follows diagram marked page 83*a*.)

Figure 1 is a side elevation of a gaiter embodying my invention, the shoe being represented in condition to be applied to the foot.

Fig. 2 is a plan of the same as secured upon the foot.

Similar letters of reference denote corresponding parts in the several figures.

The object of this invention is to dispense with the use of the ordinary gore or elastic webbing in the manufacture of gaiter boots, and at the same time so construct the shoe as that the purposes of such webbing shall be subserved.

To this end the invention consists in forming that part of the shoe which covers the ankle with an extension which enlarges the opening to such a degree as to permit the foot to be readily inserted, and which, after the shoe is on the foot, is folded and buckled or fastened against the ankle after the manner of a flap, and this shoe is made without the formation of a joint and is perfectly watertight.

The following description will enable others skilled in the art to which my invention appertains to fully understand and use the same:

84 In the drawings, A represents a gaiter boot, which, with the exception of the part B that surrounds the ankle, may be made after any of the approved or known plans.

In ordinary shoes of this kind the leather terminates at *a*, but I extend the leather back at each side of the shoe as far as a^1, and the extended part may continue from the top downward as far as may be required to insure the ready entrance of the foot.

The main thing to be clearly understood is that the opening in the top of the "ankle" of the shoe through which the foot is inserted is enlarged by as much as or commensurately with the difference in distance from a^2 to *a*, and from a^2 to a^1, supposing the extension C to be thrown back as shown in Fig. 1.

The rear and bottom edges of the two pieces which form the extension C are stitched together, and it is worked with button-holes so as to be turned or folded against the side of the shoe, and buttoned as indicated in red lines after the shoe is on the foot.

Comparatively speaking, no exertion is required to put on a shoe of this kind, and while costing less, it is superior as regards durability, for the reason that the elastic webbing of other gaiter boots, being of more delicate character, is liable to wear out, and perhaps thus renders the shoe worthless while the leather is still in a condition to be serviceable.

The method of fastening the extension C to the side after the shoe is on is an optional matter—that is to say, it may be done in any different way from that represented.

Having thus described my invention, what I claim as new herein and desire to secure by letters patent is—

A gaiter boot constructed with a folding extension, C, substantially as and for the purposes set forth.

To the above specification of my improvement in gaiter boots I have set my hand this eighteenth day of January, 1865.

SAMUEL BABBIT.

Witnesses:

EDWARD H. KNIGHT.
CHARLES D. SMITH.

Ex'd: M. McK., E. A. M.

85 UNITED STATES PATENT OFFICE.

ALEXANDER F. EVORY and ALONZO HESTON, of La Porte, Indiana.

Improvement in Boots and Shoes.

Specification forming part of Letters Patent No. 59375, dated November 6, 1866.

To all whom it may concern:

Be it known that we, Alexander F. Evory and Alonzo Heston, of La Porte, in the county of La Porte and State of Indiana, have invented a new and useful improvement in shoes; and we do hereby make known and declare that the following is a full, clear, and exact description of the same, reference being had to the accompanying drawings, and the letters and figures marked thereon, which form part of this specification.

(Here follows diagram marked p. 85*a*.)

Our said invention consists in a novel mode of constructing shoes and gaiters, whereby the ordinary elastic goring at the sides and the tedious lacing up at the front are both dispensed with, while at the same time the tops will expand to receive the foot, and fit neatly and closely around the ankle when the shoe is on, being also water-tight to the extreme top of the shoe.

To enable those skilled in the art to understand how to construct and use our invention, we will proceed to describe the same with particularity, making reference in so doing to the aforesaid drawings, in which—

Figure 1 represents a side elevation of our invention; Fig. 2, a plan or top view of the same; and Figs. 3 and 4 represent detached views or patterns of the several parts.

Similar letters of reference in the several figures indicate like parts of our invention.

A represents the front of the shoe, and has attached to its rear edge, *a*, as shown, a gore flap (marked D). B represents the back

Emory & Heston,

Shoe Upper,

No. 59,375. Patented Nov. 6, 1866

Fig 1.

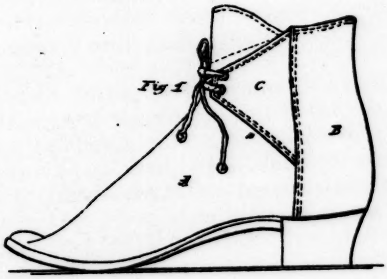


Fig 2.

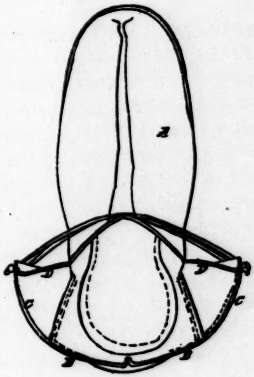


Fig 3.

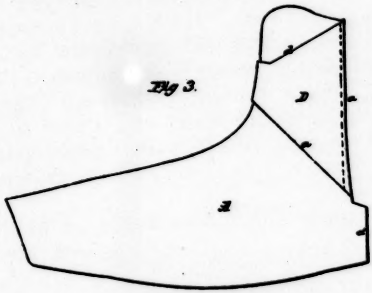
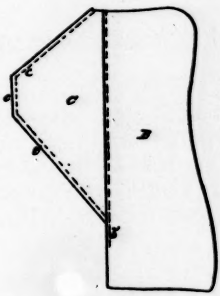


Fig 4.



No. 439.
Burt et al
v.
Emory et al.
} p. 85a

Witnesses;

A. B. Haney
J. St. Westhal.

Inventor;

Alexander J. Emory
Almer Heston
by Coburn & Son

Having thus described my invention, what I claim as new herein and desire to secure by letters patent is—

A gaiter boot constructed with a folding extension, C, substantially as and for the purposes set forth.

To the above specification of my improvement in gaiter boots I have set my hand this eighteenth day of January, 1865.

SAMUEL BABBIT.

Witnesses:

EDWARD H. KNIGHT.
CHARLES D. SMITH.

Ex'd: M. McK., E. A. M.

85 UNITED STATES PATENT OFFICE.

ALEXANDER F. EVORY and ALONZO HESTON, of La Porte, Indiana.

Improvement in Boots and Shoes.

Specification forming part of Letters Patent No. 59375, dated November 6, 1866.

To all whom it may concern:

Be it known that we, Alexander F. Evory and Alonzo Heston, of La Porte, in the county of La Porte and State of Indiana, have invented a new and useful improvement in shoes; and we do hereby make known and declare that the following is a full, clear, and exact description of the same, reference being had to the accompanying drawings, and the letters and figures marked thereon, which form part of this specification.

(Here follows diagram marked p. 85*a*.)

Our said invention consists in a novel mode of constructing shoes and gaiters, whereby the ordinary elastic goring at the sides and the tedious lacing up at the front are both dispensed with, while at the same time the tops will expand to receive the foot, and fit neatly and closely around the ankle when the shoe is on, being also water-tight to the extreme top of the shoe.

To enable those skilled in the art to understand how to construct and use our invention, we will proceed to describe the same with particularity, making reference in so doing to the aforesaid drawings, in which—

Figure 1 represents a side elevation of our invention; Fig. 2, a plan or top view of the same; and Figs. 3 and 4 represent detached views or patterns of the several parts.

Similar letters of reference in the several figures indicate like parts of our invention.

A represents the front of the shoe, and has attached to its rear edge, *a*, as shown, a gore flap (marked D). B represents the back

Emory & Heston,

85a

Shoe Upper,

No. 59,375, Patented Nov. 6, 1866

Fig 1.

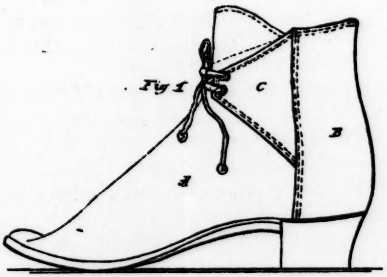


Fig 2.

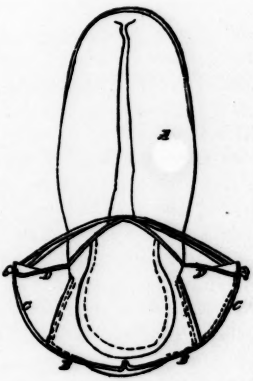


Fig 3.

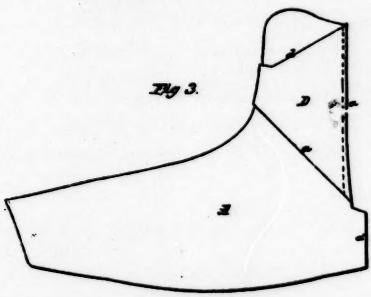
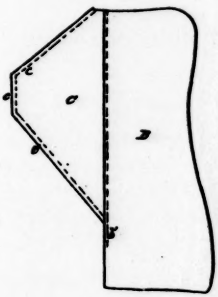


Fig 4.



No. 439.
Burt et al
vs.
Emory et al.
} p. 85a

Witnesses;

A. G. Henry
J. Fr. Hertel

Inventor;

Alexander H. Emory
Abner Heston
by Coburn & Co

of the shoe, and has attached to its front edge, *b*, as shown, a corresponding gore-flap (marked C). The front and back are sewed together at those parts of their contiguous edges marked *a'* and *b'*, and the flap C is arranged upon the flap D, bringing their corresponding edges *c* and *d* upon each other, which are then sewed together, the two flaps thus arranged forming a double extension-gore upon each side of the shoe, which readily expands to admit the foot, and which may then be folded forward over the instep, and be secured by a buckle or knot, or by a suitable lacing, as desired.

It may be observed, furthermore, that shoes can be constructed after the above-described plan much cheaper than in the ordinary mode, and the material used in their manufacture can be much more advantageously and economically used.

We do not claim, broadly, for an extension-gore flap inserted in the ankle of gaiter-shoes, for this is fully covered by the broad claim of Samuel Babbett's patent, issued March 7, 1865, to which our patent will be subject; but our mode of construction is an improvement upon that, and all the other modes since patented, in the following particulars, viz: First, it requires less stock in its construction, and is therefore cheaper than those in which the gore is inserted in the heel; second, it is neater in appearance, and, being adjustable to the ankle, it may be fitted even where there is a variation in the size of the shoe, thus rendering it more available in the construction of shoes for sale at wholesale; third, it avoids the wrinkle in the heel in Babbett's construction of shoes, which, being exposed to the friction of the leg of the pantaloon, soon wears into a hole; fourth, by giving expansion forward to the vamp in front of the ankle it admits of the more easy introduction of the foot, and allows a neater fit than is attainable when the gore is in the heel.

What we do claim as our invention, and desire to secure by letters patent, is—

A shoe when constructed with an expansion-gore flap, C D, the external fold, C, of which is attached to and in front of the quarter B, and the internal fold, D, of which is attached to and in rear of the vamp A, the said several parts and pieces being respectively constructed and the whole arranged for use substantially in the manner and for the purpose set forth.

ALEXANDER F. EVORY.
ALONZO HESTON.

Witnesses:
W. E. MAUS.
J. W. HERCHEL.

86 UNITED STATES PATENT OFFICE.

DAVID BROWN and WM. S. WOOTON, of Kokomo, Indiana.

Improvement in Shoes.

Specification forming part of Letters Patent No. 49076, dated August 1, 1865.

To all whom it may concern:

Be it known that we, David Brown and W. S. Wooton, of Kokomo, in the county of Howard, State of Indiana, have invented a new and useful improvement in boots or shoes; and we do hereby declare that the following is a full, clear, and exact description thereof, which will enable those skilled in the art to make and use the same, reference being had to the accompanying drawings, forming part of this specification.

(Here follows diagram marked p. 86*a*.)

The present invention consists in attaching to the back portion of the boot or shoe in which a vertical slit or opening has been made a folding flap or piece of sufficient size and shape that, when the boot or shoe is put on the foot, it can be folded or passed entirely around the instep, and there fastened by buckling, buttoning, or in any other proper manner, said flap being connected therewith by means of two wings or sectional pieces, each fastened by sewing, or in any other suitable way, at one edge to one side of opening or slit in the boot or shoe and at the other to the inner surface of the folding flap, and which wings, when the folding flap has been buttoned, as described, lie and are held between it and the exterior surface of the boot or shoe upper.

By forming the back portion of the boot or shoe with a folding flap or piece arranged and attached thereto, as described, the following among many advantages are secured, viz: First, it can be more easily and readily put on and taken off of the foot, as the flap, when unbottoned, necessarily enlarges the usual opening for inserting the foot. There are no eyelet-holes or any kind of apertures communicating with the interior of the shoe, as has heretofore been the case, thus making a perfect water-proof boot or shoe, so far as the leather or other material of which the shoe is made is capable of resisting the penetration of moisture; and also the peculiar construction and arrangement of the flap acts as a support to and prevent the breaking down of the counter of the boot or shoe.

In the accompanying plate of drawings our improvement is illustrated.

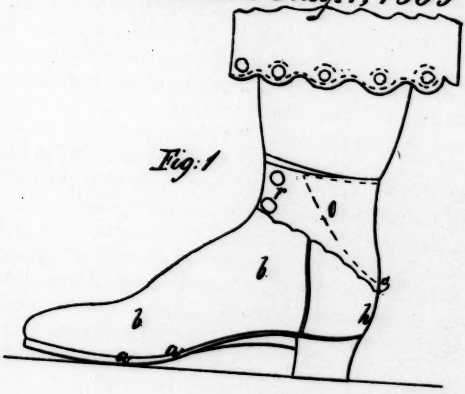
Figure 1 is a side view of a boot with our improvement applied, and represented as fastened about the foot; Fig. 2, a perspective view, showing folding flap unfastened and mode of securing it to the boot or shoe.

Brown & Wooton,

Shoe Upper,

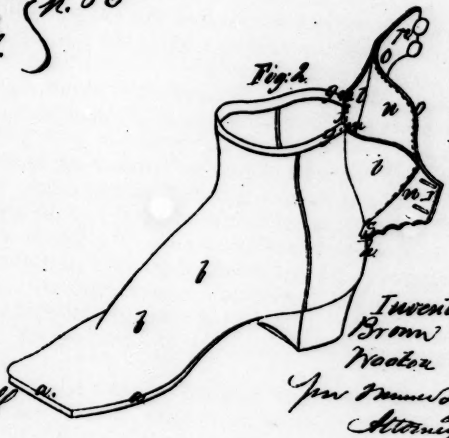
No. 49,076, Patented Aug. 1, 1865

Fig. 1



No. 439.
Burt et al.
v.
Curry et al.
} p. 86a

Fig. 2.



Witnesses:
M. Adams jr
W. Reamer dull

Inventors:
Brown
Wooton
per Munn & Co
Attorneys

a a represent the sole of a boot; *b c*, the upper-leather, attached to sole *a* by sewing or in any other proper manner; *d*, an opening at top of boot for inserting the foot; *f*, a vertical slit or opening made in back portion of upper-leather *c*, and extending from top edge, *g*, of same nearly to the top of counter *h*; *l l*, two wings or pieces, made of leather or other suitable material, and having a triangular shape, each attached, by sewing or other proper means, by one of their edges to each edge *m* of the slit *f* in boot, and by another edge, also by sewing, to the inner surface, *n*, of a folding flap, *o*, having the shape represented in the drawings, and of sufficient length to extend around the instep of the foot and have its two ends, *p* and *r*, meet and button, as represented in Fig. 1, the lower end, *s*, of which flap is fastened by sewing or in any other proper manner to the upper-leather *c*, at or near the top of counter *h*.

The boot, with its back folding flap attached to the same, as above described, when placed upon the foot, is fastened thereto and securely held thereon by simply folding or passing the flap around the instep or leg over the upper, bringing its two ends together in front of the foot, which are then buttoned, buckled, or braced together in any of the ordinary modes, the wings or connecting-pieces *l l* then lying on and held between the exterior surface of upper *c* and inner surface of flap, as is evident without further description.

From the above description it is evident that not only is a secure, tight, and reliable fastening provided for the securing of the boot or shoe to the foot without necessity of an eyelet-hole or any manner of an aperture in its upper-leather, but that the boot or shoe can be readily put on and taken off of the foot at pleasure.

We do not claim a folded gore applied to the lappet of a shoe, being aware that Samuel Babbit obtained a patent on the 18th of February, 1865, for a shoe in which the said device is employed. Our invention is superior to Babbit's in several respects: First, the increased thickness of leather is applied at the back of the shoe, where it is useful in preventing any running down of the heel, whereas if placed at the side it causes an unequal strength and stiffness, which is exceedingly liable to result in the running over of the shoe. Second, the fastening of our shoe, being in front, is not liable to
87 become soiled in muddy weather, as is common with side fastenings, and cannot, by being drawn tightly, produce any contraction or distortion on one side of the shoe. Third, our shoe is adapted to be much more easily put on and off.

What we claim as an improvement, and desire to secure by letters patent, is—

The combination of the slit *f* at the back of the boot, the double wings or gores *l l*, attached at the respective sides of the said slit, and the flap *o*, attached at the top of the counter and the outer edges of the gores *l l*, passing completely around the boot-top and fastening above the instep in front, all as herein represented and described.

DAVID BROWN.
WILLIAM S. WOOTON.

Witnesses:
J. E. HOUSE.
WM. RUSSELL.

88 UNITED STATES PATENT OFFICE.

FRED. PACKARD, of Brockton, Massachusetts.

Improvement in Shoes or Gaiters.

Specification forming part of Letters Patent No. 205,129, dated June 18, 1878; application filed May 16, 1878.

To all whom it may concern:

Be it known that I, Fred. Packard, of Brockton, in the county of Plymouth and State of Massachusetts, have invented a new and useful improvement in shoes or gaiters, of which the following is a specification:

My invention relates to an improvement in that class of shoes and gaiters known to the trade as the "Alexis gaiter;" and consists in a tongue or instep-piece of a peculiar construction, as will be hereinafter set forth.

Referring to the accompanying drawings, making a part of this specification, figure 1 is a plan view of one-half of the instep-piece or tongue embodying my construction. Fig. 2 is a like view, showing the part formed of two pieces. Fig. 3 shows the entire tongue formed from a single piece of material, and Fig. 4 shows a complete shoe embracing my invention.

(Here follows diagram marked p. 88*a*.)

Like letters indicate corresponding parts in all the figures.

A represents the body portion of the tongue, which is of the usual form, and the portion thereof marked B represents my improvement, which consists of a wing or flap, either integral with the main portion of the tongue or formed of a separate piece and united thereto. This flap is cut in the form shown, so that whether the tongue be made of one or two pieces, the corner slot or opening C is left between it and the other part of the tongue, for the purpose to be hereinafter explained.

When the pattern shown in Fig. 1 is seen, it will be obvious that two such pieces will be required to form a complete tongue. The two parts are to be united by a line of stitching down the center in a manner well known.

When the flaps or wings B are made separate they are first united to each of the pieces which compose the tongue, and the two parts are afterward stitched together in the usual manner.

It is evident the entire tongue may be made of a single piece of material, as shown in Fig. 3, or it may be formed integral with the vamp without departing from the spirit of my invention, which consists of a tongue or instep-piece provided with wings or flaps, as hereinbefore described.

When the tongue is constructed after the manner shown and de-

F. PACKARD.
Shoe or Gaiter.

No. 205,129. Patented June 18, 1878.

Fig. 4.

No. 439.
Burt shelf } p. 88½
Cerry shelf }

Fig. 1.

Fig. 3.

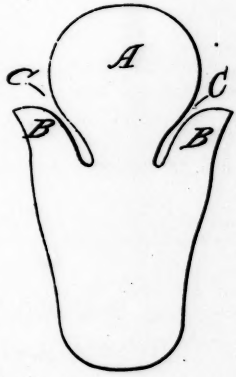


Fig. 2.

Attest:

Frank E. Shaw
H. M. Kingman

Inventor:

Fred Packard

scribed, the outer edges of the flaps or wings are stitched to the front edge of the quarters of the shoe, and by the operation of buckling or lacing form gores between the quarter and tongue-piece.

When the shoe is on the foot and the parts buckled or laced the wings or flaps are folded externally over the tongue-piece from the lower portion of the slots at each side, thus bringing the laps outside and leaving no projecting portions inside to hurt the foot.

The following are the advantages I claim for my improvement over the ordinary Alexis gaiter, viz: It will not gap open after a little wear. It will prevent sand and dirt from working its way into the shoe, and effectually excludes snow and water, and will not tear down at the side like a shoe of ordinary construction, as the strain is much less. Its chief point of superiority, however, is the facility with which the shoe having this construction may be put on the foot, as it opens much wider in front than the ordinary pattern, which is always difficult to put on.

Having thus fully described my improvement, what I claim as new, and desire to secure by letters patent, is—

1. A tongue or instep-piece for a shoe or gaiter provided with the side wings or flaps B and slots or openings C intermediate of said flaps and the body of the tongue, substantially as specified.

2. A shoe or gaiter having a tongue or instep-piece provided with the side wings or flaps B and slots or openings C intermediate of said flaps and the body of the tongue, substantially as set forth.

FRED. PACKARD.

Witnesses:
FRANK E. SHAW.
H. M. KINGMAN.

89 The following is the opinion of the court in accordance with which the decree was entered for an injunction and an account:

Circuit Court of the United States, District of Massachusetts.

ALEXANDER F. EVORY *et al.*
v.
JOHN W. BURT *et al.*
} No. 1478, Equity Docket.

Opinion of the Court.

(February 3, 1883.)

LOWELL, *J.*:

The plaintiffs are the owners of patent No. 59375, issued to two of them in 1866. The specification describes the invention as consisting of "a novel mode of constructing shoes and gaiters, whereby the ordinary elastic goring at the sides and the tedious lacing up in front are both dispensed with, while at the same time the tops will expand to receive the foot and fit neatly and closely around the ankle when the shoe is on, being also water-tight to the extreme top of the shoe."

The mode of obtaining these advantages is by inserting at the rear of the front or vamp of the shoe a triangular flap or gore and a similar gore at the front of the back part or quarter. These flaps or gores are sewed together at their edges, and when the shoe is to be put on they open and admit the foot, and then are closed again and folded outside the shoe and tied or buckled "forward over the instep." The patentees say: "We do not claim, broadly, for an extension-gore flap inserted in the ankle of gaiter shoes, for this is fully covered by the broad claim of Samuel Babbett's patent, issued March 7, 1865, * * *" and set out the advantages of
90 their mode of construction. Babbett's patent was for a flap inserted in the heel and carried round the foot and fastened at the heel again. Another patent, issued to Brown & Wooten, was for flaps inserted in the heel and brought round on each side of the foot. The English patent of Norris, of 1856, shows a gore flap like the plaintiffs', except that it folds inside the shoe; but such a flap would be uncomfortable, and the shoe containing it would not be likely to obtain a market.

The claim of the plaintiffs' patent is, "A shoe when constructed with an expansion-gore flap, C D, the external fold C of which is attached to and in front of the quarter B, and the internal fold D of which is attached to and in rear of the vamp A, the said several parts and pieces being respectively constructed and the whole arranged for use substantially in the manner and for the purpose set forth."

The defendants make shoes under the patent granted to F. Packard, one of the defendants, No. 205,129, dated June 18, 1878, for an improvement in that class of shoes and gaiters known as the Alexis gaiter, and represented in this case by the Exhibit Packard. It is a shoe with a tongue or instep piece provided with side wings or flaps between the tongue and the quarter, which fold over when the shoe is fastened. The patentee says: "The following are the advantages I claim for my improvement over the ordinary Alexis gaiter, viz: It will not gape open after a little wear. It will prevent sand and dirt from working its way into the shoe, and effectually excludes snow and water, and will not tear down at the side like a shoe of ordinary construction, as the strain is much less. Its chief point of superiority, however, is the facility with which the shoe having this construction may be put on the foot, as it opens much wider in front than the ordinary pattern, which is always difficult to put on."

This shoe of the defendants has the advantages of the plain-
91 tiffs' shoe to a greater or less extent, and they are obtained by means of a gore or flap. As a witness, Packard denies that this shoe has the advantage which his specification says is its chief merit—that of opening more widely than the ordinary pattern. He and his expert say that his gore or flap is a stay piece which limits the opening of the shoe, and that its only advantage is that it makes the shoe more water-proof. The propositions that it is more water-proof and opens more widely are identical. It is more fully water-proof simply because it opens and closes again by virtue of the gore

or flap. It is more fully water-proof than a shoe with an equal opening without a gore, and it opens wider than an equally water-proof shoe without a gore.

The Evory & Heston patent was held valid in Evory *v.* Candee, 2 Fed. Rep., 542, and its validity is not now assailed, unless a wide construction is given to the claim; and this, as is most usual, is the difficult point. The defendants' shoe has a single and not a double flap or gore. The quarter or an extension of it comes forward and contains the eyelets or buckle and strap necessary for fastening the shoe over the instep, and so takes the place of one-half of the double gore. This is an old form of fastening; but a gore between the vamp and the quarter, in a shoe which can be comfortably worn, appears to be new; and, though the Packard shoe presents a very great simplicity and cheapness as compared with the Evory & Heston, yet it effects the same results in substantially the same way.

Decree for the complainants.

92 The following is the rescript filed November 10, 1885, in accordance with which the order overruling defendants' exceptions to master's report was entered:

Rescript.

(Filed Nov. 10, 1885.)

COLT, *J.:*

The court is of opinion that the defendants' exceptions to the master's report should be overruled. We think the finding of the master, that the defendant should pay a certain royalty based upon an established license fee, correct. The damage consists in not receiving the royalty which such a license would have brought. In this case the complainants have mainly sought their profit in the form of royalty. Under these circumstances we deem the fact that one of the complainants, who made shoes for order for his retail trade, was not damaged in his business by the sale of defendants' shoes immaterial on the question of the proper rule of damages. We have read with interest the learned brief of defendants' counsel to the effect that only nominal damages should be found because no damages have been proved, but we think the fact that license fees were received from others and not from defendants is proof of damage.

Defendants' exceptions overruled.

93 Circuit Court of the United States, District of Massachusetts.
In Equity.

ALEXANDER F. EVORY *et al.*
v.
JOHN W. BURT *et al.*
} No. 1478.

Assignment of Errors and Prayer for Reversal.

And now come the said respondents and make assignment of errors in the opinion and decree therein:

I. That the court erred in holding that the patent in suit is valid.

II. That the court erred in holding that, in view of the antecedent state of the art, the patent in suit was infringed by the defendants.

III. That the court erred in construing the patent in suit.

IV. That the court erred in sustaining the master's report and in overruling the exceptions to said report.

V. That the court erred in holding that a license fee is the measure of damages, no damage to the business of the defendants having been proved.

VI. That the court erred in holding that the fact that license fees were received from others and not from defendants is proof
94 of damage, although the report shows that the complainants were not damaged, either in their business of manufacturing under the patent or of selling licenses.

VII. That the court erred in holding that damage consists in not receiving the royalty based upon an established license fee, the report finding that the defendants had no knowledge of the license fee to others and had made no agreement to pay anything to the complainants.

Wherefore the defendants pray that the decree in said cause may be reversed, and that the complainants' bill be dismissed with costs.

By their solicitor, GEO. D. NOYES.

95 UNITED STATES OF AMERICA, *Massachusetts District*, } *ss:*

I, John G. Stetson, clerk of the circuit court of the United States for the first circuit and district of Massachusetts, certify that the foregoing is a true copy of the record of said circuit court in the cause in equity entitled Alexander F. Evory *et al. v.* John W. Burt *et al.*, lately determined in said circuit court, and of all proceedings therein, and of the opinion and rescript of the court, and of the assignment of errors and prayer for reversal filed therein.

Seal of the Circuit Court, Massachusetts.

In testimony whereof I hereunto set my hand and affix the seal of said circuit court, at Boston, in said district, this seventh day of September, in the year of our Lord one thousand eight hundred and eighty-six, and of the Independence of the United States the one hundred and eleventh.

JOHN G. STETSON, *Clerk.*

96 *Bond to Party on Appeal.*

Know all men by these presents that we, John W. Burt and Fred. Packard, both of Brockton, in the State of Massachusetts, as principals, and Edward Crocker and William Ramsdell, both of said Brockton, as sureties, are held and firmly bound unto Alexander F. Evory, a resident of the State of New York; Alonzo Heston and J. B. Belcher, residents of the State of Michigan, in the full and just sum of four thousand dollars, to be paid to the said Evory, Heston,

and Belcher, their certain attorneys, executors, administrators, or assigns; to which payment, well and truly to be made, we bind ourselves, our heirs, executors, and administrators, jointly and severally, by these presents.

Sealed with our seals and dated the twenty-ninth day of January, in the year of our Lord one thousand eight hundred and eighty-six.

Whereas lately, at a circuit court of the United States within and for the district of Massachusetts, in a suit in equity depending in said court between the said Alexander F. Evory, Alonzo Heston, and J. B. Belcher, complainants, and the said John W. Burt and Fred. Packard, defendants, decree was rendered against the said defendants, and the said defendants having obtained an appeal to remove the said cause to the Supreme Court of the United States to reverse the decree in the aforesaid suit, and a citation, directed to the said complainants, citing and admonishing them to be and appear at a Supreme Court of the United States to be holden at Washington on the second Monday of October next:

Now, the condition of the above obligation is such that if the said defendants shall prosecute their said appeal to effect and answer all damages and costs if they fail to make their plea good, then the above obligation to be null and void; otherwise to remain in full force and virtue.

JOHN W. BURT. [L. S.]
FRED. PACKARD. [L. S.]
EDWARD CROCKER. [L. S.]
WILLIAM RAMSDELL. [L. S.]

Signed, sealed, and delivered in presence of—
HENRY C. GURNEY.
FRED. F. FIELD.

Approved:
LE BARON B. COLT,
U. S. Circuit Judge.

A true copy of the bond taken by the judge at the time of allowing the appeal named in said bond, which bond is on file in the office of the clerk of the circuit court of the United States for the first circuit and district of Massachusetts.

Attest: JOHN G. STETSON,
Clerk U. S. C. C., Mass. Dist.

97 *Citation.*

The United States of America to Alexander F. Evory, a resident of the State of New York; Alonzo Heston and J. B. Belcher, residents of the State of Michigan, Greeting:

You are hereby cited and admonished to be and appear at a Supreme Court of the United States, to be holden at Washington on the second Monday of October next, pursuant to an appeal claimed

and allowed by the circuit court of the United States for the district of Massachusetts, in a cause in equity wherein you are complainants and John W. Burt and Fred. Packard, of Brockton, in the State of Massachusetts, are defendants and appellants, to show cause, if any there be, why the decree rendered against the said defendants should not be reversed, and why speedy justice should not be done to the parties in that behalf.

Witness the Honorable Le Baron B. Colt, United States circuit judge for the first judicial circuit, this fifth day of February, in the year of our Lord one thousand eight hundred and eighty-six.

LE BARON B. COLT,
U. S. Circuit Judge, First Judicial Circuit.

98 [Endorsed:] Service of within citation is hereby acknowledged. Feb. 11th, 1886. Frederic H. Betts, counsel for appellees.

Endorsed on cover: Massachusetts C. C. U. S. No. 439. John W. Burt and Fred. Packard, appellants, *vs.* Alexander F. Evory, Alonzo Heston, and J. B. Belcher. Filed October 12, 1886.

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TRANSCRIPT OF RECORD.

SUPPLEMENTAL.

SUPREME COURT OF THE UNITED STATES.

OCTOBER TERM, 1889.

No. 164.

JOHN W. BURT AND FRED PACKARD,
Appellants,

v.

ALEXANDER F. EVORY, ALONZO HESTON, AND
J. B. BELCHER.

CONTENTS.

	Page.
Exhibit Norris and Rogers Patent	1
" Stephen Norris Patent	7
" License No. 1	13
" License No. 2	15
" National Rubber Company License	18
Clerk's Certificate	21
Order of Court as to Exhibits	22

SUPPLEMENT TO RECORD.

EXHIBIT NORRIS AND ROGERS PATENT.

A.D. 1860, 13th AUGUST. No. 1954.

MILITARY BOOTS.

Letters Patent to Stephen Norris, of Great Peter Street, in the City of Westminster, and Robert Rogers, of King Street, Covent Garden, in the County of Middlesex, for the Invention of "Improvements in the Manufacture of Boots particularly adapted to Military Purposes."

Sealed the 12th February, 1861, and dated the 13th August, 1860.

Provisional Specifications left by the said Stephen Norris and Robert Rogers at the Office of the Commissioners of Patents, with their Petition, on the 13th August, 1860.

We, STEPHEN NORRIS, of Great Peter Street, in the City of Westminster, and ROBERT ROGERS, of King Street, Covent Garden, in the County of Middlesex, do hereby declare the nature of the said Invention for "Improvements in the Manufacture of Boots particularly adapted to Military Purposes," to be as follows: —

This Invention relates to the manufacture of boots for military purposes in such a manner that when on the feet they shall have all the appearance and comfort of Wellington boots by cutting the front and back parts thereof so that the opening or gap between such parts before the seam is sewn shall resemble the shape of the letter V, but when closed will form a straight vertical seam the tongue of the front part being made hollow instead of rounded, and the backs rounded instead of straight, as patented by the above-named Stephen Norris, on the 23rd day of January 1856,

No. 185, Figs. 11 and 19, the object being to prevent the tongue slipping down. The side seams are made near the heel, the same as in the Wellington boot, by which means the above results are produced, or another seam may extend from the vertical seam in an inclined line towards the toe. We propose in some cases cutting the upper in one piece with a seam behind, and opening the ancle in a curved line on each side thereof towards the sole or toe, in such case we attach our pieces to fasten over the instep, thus dispensing with side seams, or we open the centre of the top part of the front forming the ear pieces in the solid leather, in which case the tongue would have to be closed on to and across the top part of the front, and of such a form that the edges thereof can also be closed to the inner part of the ear pieces, the object being to dispense with the side seams.

Another important feature in our Invention is making boots for trench work, mining, and shooting, to extend up the leg and fit close, thus forming a gaiter on the boot either of soft or other leather, or the same front extended to be cut on precisely the same principle as those before-mentioned.

Specification in pursuance of the conditions of the Letters Patent, filed by the said Stephen Norris and Robert Rogers in the Great Seal Patent Office on the 13th February 1861.

To all to whom these Presents shall come, we, Stephen Norris, of Great Peter Street, in the City of Westminster, and Robert Rogers, of King Street, Covent Garden, in the County of Middlesex, send greeting.

Whereas Her most Excellent Majesty Queen Victoria, by Her Letters Patent, bearing date the Thirteenth day of August, in the year of our Lord, One thousand eight hundred and sixty, in the twenty-fourth year of Her reign, did, for Herself, Her heirs and successors, give and grant unto

us, the said Stephen Norris and Robert Rogers, Her special licence that I, the said Stephen Norris and Robert Rogers, our executors administrators, and assigns, or such others as we the said Stephen Norris and Robert Rogers, our executors, administrators, and assigns, should at any time agree with, and no others, from time to time and at all times thereafter during the term therein expressed, should and lawfully might make, use, exercise, and vend, within the United Kingdom of Great Britain and Ireland, the Channel Islands, and Isle of Man, an invention for "Improvements in the Manufacture of Boots, particularly adapted to Military Purposes," upon the condition (amongst others) that we, the said Stephen Norris and Robert Rogers, our executors or administrators, by an instrument in writing under our, or their, or one of their hands and seals, should particularly describe and ascertain the nature of the said invention, and in what manner the same was to be performed, and cause the same to be filed in the Great Seal Patent Office within six calendar months next and immediately after the date of the said Letters Patent.

Now know ye, that we, the said Stephen Norris and Robert Rogers, do hereby declare the nature of our said Invention, and in what manner the same is to be performed, to be particularly described and ascertained in and by the following statement, that is to say: —

This Invention relates to the manufacture of boots for military purposes, in such a manner that when on the feet they shall have all the appearance and comfort of "Wellington" boots, by cutting the front and back parts thereof so that the opening or gap between such parts before the seam is sewn shall resemble the shape of the letter V, but when closed will form a straight vertical seam. The tongue of the front part being cut hollow instead of round, as shown at *a*, Fig. 1, and the front part of the backs rounded instead of straight, as shewn at *b*, Fig. 1, as patented by the above-named Stephen Norris, on the Twenty-third day of January,

One thousand eight hundred and fifty-six, No. 185, (Figs. 11 and 19,) of his former Specification, the object being to prevent the tongue from slipping down. The side seams being made near the heel, the same as in the "Wellington" boot, by which means the above results are produced; or another seam may extend from the vertical seam in an inclined line towards the toe.

Another important feature in our Invention is, making boots for trench work, mining and shooting purposes, to be extended up the leg and fit close, thus forming a gaiter on the boot, either of soft or other leather; or the same front extended, to be cut on precisely the same principle as those before mentioned.

In order to explain our said Invention as completely as possible, we now proceed to describe the best means we are acquainted with for carrying the same into practical effect, reference being had to the illustrative Sheet of Drawings hereto annexed, and to the numerical figures and letters of reference marked thereon respectively, as follows: —

Description of the Drawings.

Fig. 1 is a side view of a vamp and quarter, cut upon our improved principle for short military boots, in which position the lowest extremity of each side seam is made to touch each other, and thereby shew the V-shaped space between the edges of the seam previous to being sewn. The quarter being fixed on the fronts for military and common purposes.

Fig. 2, being a plan view of the gusset intended to be used for the above boot; Fig. 3, being a view of the same gusset folded ready to be inserted in the boot.

Fig. 4 represents a front or vamp of a boot intended for private wear, the side seam being cut on a slight curve, as shewn, instead of straight; Fig. 5 shews a view of a quarter or back part laid open to be attached to the vamp or front part, Fig. 4, the seam of the boot to be sewn inside, similar to a Wellington; Fig. 6, view of Fig. 5 as it would appear

when doubled in half; Fig. 7, front of military boot, so cut that by the addition of another piece it may be extended to a long military, shooting, mining, or fishing boot, thereby economizing material.

Fig. 8 is an ordinary graft cut on our improved principle as prepared to be attached to short boots; Fig. 9, being a front of a Wellington boot, the side seam being cut on our improved principle, as described at Fig 4, or the same kind of boot may be made with the front or vamp, as shewn at Figs. 1, 4, and 7, by making a side gusset of softer material on each side to neatly fit in between the vamp and long back or leg part.

Fig. 10, being shape of half-gusset required for the Wellington boot, Fig 9.

Fig. 11 is a side view of back part of a shooting, fishing, or mining boot; Fig. 12, being the same piece or part laid flat, the boot being shewn complete at Fig. 14.

Fig. 13 is a side view of short boot, having one ear or side piece drawn down, shewing gusset folded on opposite side, or interior of boot, shewing its proper position when on the foot; Fig. 14*, side view of the same boot laced, or as it would appear when on the human foot; Fig. 15, being front view of the same boot; Fig. 16 shews a side view of the same description of boot as that shown at Fig. 13, shewing gusset on each side; Fig. 17, front view, shewing gussets on both sides when the ears are laid open; Figs. 18, 19, and 20, being views of long boots, with or without gussets; Fig. 19, being side view of long boot, with the seam extending from the side seam towards the toe, as shewn.

Having now described the nature of our said Invention of "improvements in the manufacture of boots particularly adapted to military purposes, and the manner in which the same is to be performed, we would remark in conclusion, that what we claim as our Invention, and therefore intend

to be secured to us by the herein in part recited Letters Patent is, —

Firstly, the construction of boots for military and other purposes, by cutting the various parts as shewn in the accompanying Drawings, more especially at the Figures 1, 4, 5, 6, 7, 8, 9, 11, 12.

Secondly, the shape of the gussets shewn at Figs. 2, 3, and 10.

And lastly, the general construction and arrangement of the various parts shewn in the accompanying Drawings, and herein fully described for the purposes set forth.

In witness whereof, we, the said Stephen Norris and Robert Rogers, have hereunto set our hands and seals, this Twelfth day of February, in the year of our Lord One thousand eight hundred and sixty-one.

STEPHEN NORRIS. [SEAL]
ROBERT ROGERS. [SEAL]

Witness to the signatures of
S. Norris and R. Rogers,
L. J. WETHERELL,
Clerk to Messrs. Prince and Co.,
Agents for Patents,
4, Trafalgar Square,
Charing Cross.

EXHIBIT STEPHEN NORRIS PATENT.

A.D. 1856 . . . No 185.

BOOTS, SHOES, &c.

Letters Patent to Stephen Norris, of New Peter Street, Westminster, in the County of Middlesex, for the Invention of "Improvements in the Manufacture of Boots and Shoes and other Coverings for the Human Feet."

Sealed the 22nd July 1856, and dated the 23rd January 1856.

Provisional Specification left by the said Stephen Norris at the Office of the Commissioners of Patents, with his Petition, on the 23rd January 1856.

I, Stephen Norris, of New Peter Street, Westminster, in the County of Middlesex, do hereby declare the nature of the said Invention of "Improvements in the Manufacture of Boots and Shoes and other Coverings for the Human Feet," to be as follows: —

These improvements consist in adapting "gussets" of novel and improved construction, in combination with certain fastenings, for the purpose of enabling boots and shoes and other coverings for the human feet to be readily adapted and secured to and detached from the feet. These improvements being applicable to coverings for the feet generally, the nature of this Invention will be sufficiently explained by giving a few examples of the mode of adapting these improvements to certain descriptions of boots, shoes, and other coverings for the human feet, as follows: —

First, as regards ladies' boots, I propose to employ side

gussets of cloth or leather, so combined with elastic material as that the said gussets shall always be preserved flat, instead of wrinkling or overlapping, as heretofore.

Another mode is to secure an elastic band to that part of the boot which encircles the ankle of the foot, and this in combination with folding side gussets and fastenings, composed either by interlacing into two rows of hooks strips of elastic or eyelets. The openings for the gussets I propose to make at each side of the boot, and to extend it from the top in an ornamental direction, either towards the toe of the boot or the sole thereof, or towards the heel; and for ladies' slippers I propose to place the gusset at the instep thereof, and to use said gusset in combination with straps of elastic material.

And as regards gentleman's boots and other similar coverings, I propose, in manufacturing boots known and distinguished as Bluchers, to form the side seams thereof, or close the fore and back parts, somewhat after the manner of Wellington boots, so as to resemble the same when on the feet, and to enable Blucher boots to be more readily put on and taken off than heretofore, by employing the aforesaid gussets in combination with boots of the above construction.

And as regards Wellington boots, I propose to connect the fore and back parts together by gusset pieces, waterproof or otherwise, by which they may be used as overboots, and thus admit of wrappers being placed around the legs and feet in travelling, and be less unsightly than heretofore, by employing fastenings composed either of eyelets, buckles and straps, studs and holes, or such other convenient and simple fastenings as will enable the fore and back parts to be readily brought together and securely held, and easily released when desired.

Specification in pursuance of the conditions of the Letters Patent, filed by the said Stephen Norris in the Great Seal Patent Office on the 23rd July 1856.

To all to whom these Presents shall come, I Stephen Norris, of New Peter Street, Westminster, in the County of Middlesex, send greeting.

Whereas Her most Excellent Majesty Queen Victoria, by Her Letters Patent, bearing date the Twenty-third day of January, in the year of our Lord One thousand eight hundred and fifty-six, in the nineteenth year of Her reign, did, for Herself, Her heirs and successors, give and grant unto me, the said Stephen Norris, Her special licence that I, the said Stephen Norris, my executors, administrators, and assigns, or such others as I, the said Stephen Norris, my executors, administrators, and assigns, should at any time agree with, and no others, from time to time and at all times thereafter during the term therein expressed, should and lawfully might make, use, exercise, and vend, within the United Kingdom of Great Britain and Ireland, the Channel Islands, and Isle of Man, an invention for "Improvements in the Manufacture of Boots and Shoes and other Coverings for the Human Feet," upon the condition (amongst others) that I, the said Stephen Norris, my executors or administrators, by an instrument in writing under my, or their, or one of their hands and seals, should particularly describe and ascertain the nature of the said Invention, and in what manner the same was to be performed, and cause the same to be filed in the Great Seal Patent Office within six calendar months next and immediately after the date of the said Letters Patent.

Now know ye, that I, the said Stephen Norris, do hereby declare the nature of the said Invention, and in what manner the same is to be performed, to be particularly described and ascertained in and by the following statement thereof, that is to say: —

My improvements consist in adapting to boots, shoes, and other coverings for the human feet gussets of novel and improved construction in combination with ordinary fastenings, for the purpose of enabling boots, &c. to be readily adapted and secured to and detached from the feet, and at the same time preserved water-tight at such parts when necessary. The following are a few examples of the mode of adapting my said improvements to certain descriptions of boots, shoes, and other coverings for the human feet.

First, as regards ladies' boots, I propose to employ side gussets of cloth or leather, so combined with elastic material as that the said gussets shall always be preserved flat, instead of wrinkling or overlapping, as heretofore.

Another mode is to secure folding side gussets and fastenings, composed either by interlacing into two rows of hooks strips of elastic or eyelets. The openings for the gussets I propose to make at each side of the boot, and to extend it from the top in an ornamental direction, either towards the toe of the boot or the sole thereof, or towards the heel.

And as regards gentlemen's boots and other similar coverings, I propose, in manufacturing boots known and distinguished as Bluchers, to form the side seams thereof, or close the "fore" and "back" parts, somewhat after the manner of Wellington boots, so as to resemble the same when on the feet, and to enable Blucher boots to be more readily put on and taken off than heretofore, by employing the aforesaid gussets in combination with boots of the above description.

In order to explain my said Invention as completely as possible, I now proceed to describe the best means I am acquainted with for carrying the same into practical effect, reference being had to the illustrative Drawings hereunto annexed, and to the numeral figures and letters of reference marked thereon respectively, as follows: —

Description of the Drawings.

At Sheet 1, Figure 1 exhibits a side elevation of a Blucher boot with my said improvements adapted thereto; Figure 2 shews the upper part of said boot laid open; Figures 3, 4, 5, 6 are detached parts, herein-after referred to; Figure 7 is a side elevation of another description of boot termed highlows, such as are worn by sportsmen and excavators; Figure 8 exhibits said boot with the upper part laid open; Figure 9 is a detached part, herein-after referred to. Figures 10, 11, 12, 13, 14 exhibit other modes of manufacturing Blucher boots according to my said improvements; Figures 15, 16, 17, 18, 19, are detached portions thereof, herein-after referred to. At sheet 2, Figures 20 to 24 inclusive, exhibits several pairs of ladies' boots constructed according to my said Invention. At each of the foregoing Figures of each Sheet of Drawings I employ similar letters of reference to denote corresponding parts in so far as such parts appear or can be seen at each of such said Figures respectively. At Figures 1, 2, 3, 4, 5, 6, of Sheet 1, A is the front or "vamp" of an ordinary Blucher boot; B, the back thereof; C, the gusset or gore of leather or other material, shewn detached at Figures 3 and 4. Figure 3 represents the gusset laid open; and Figure 4 the gusset doubled up and as it would appear when the boot is laced up; Figure 5 shews the back part of the boot as it would appear when doubled. The peculiar shape given to this back part enables the upper part of the boot to adapt itself more closely to the leg of the wearer than Blucher boots as heretofore made. Figure 6 shews the said back part laid open, and the "counter" attached thereto. In manufacturing the above improved boot the workman proceeds as follows: — The closer proceeds as at present practiced, except that he makes a row of stabbing very near the lace holes on the outside of the front part of the boot on both sides thereof, from *a* to *b*. The gusset is attached to the front or

vamp A along the line *c* and to the back D along the line *d*, and this mode of connecting gussets to boots applies to all of the boots exhibited by the accompanying Drawings except that exhibited at Figure 14, at which Figure it will be seen that the gusset is let into the back part of the boot, and the lacing is at the back instead of at the side or front of the boot, as heretofore. As regards the boots exhibited at Figures 1, 2, 10, 11, 12, 13, 19, of Sheet 1, the gussets are in all cases affixed to the boots by a row of stabbing and sewing, extending from the top part of the vamp to the seams which connect the front and back parts of the boot together. Instead of "lasting" boots in the manner commonly practised with Blucher boots, I propose to "last" them in the same manner as wellington boots, by placing the lower part of the centre part of the back of the boot up high on the back part of the last and pulling the front of the toe part over the toe part of the last and fixing it there, as heretofore practised. I then drive the last up the inside of the whole of the "upper" of the boot until the bottom edges of the "upper" are level with the bottom of the last, and this mode of "lasting up" applies to those boots exhibited at Figures 1, 2, 8, 9, 10, of Sheet 1. Figure 19 shews the vamp and gusset of the boot exhibited at Figures 10, 11, 12. And as regards the several forms of ladies' boots exhibited at Sheet 2, the same principle of construction applies to all of them, namely, the so affixing such said gussets to the front and back parts of the boot as that they shall fold flat within the boot when laced up or otherwise fastened, observing that I employ two gussets instead of one, as heretofore. In conclusion, I would remark, that the principle points to be attended to in these improvements are to have the gussets the proper size, and to connect them to the front and back parts of the boot or to the back part only thereof by sewing and stabbing, or other known means, so that they may, when necessary, be rendered waterproof; and this applies more particularly to men's boots. And as regards the fasten-

ings for securing the boots on the feet, I employ any of the known means for that purpose.

Having now described the nature and object of my said Invention of "improvements in boots and shoes and other coverings for the human feet," together with the best means I am acquainted with for carrying the same into practical effect, I hereby declare that I claim as my Invention,—

Firstly, the modes above particularly described, set forth, and represented at Figures 1, 2, 3, 4, 10, 11, 12, 13, 18, 19, of Sheet 1, of manufacturing Blucher boots, and more particularly the cutting of the back part of such boots, in the manner exhibited at Figures 5, 6, 15, 16, 18, for the purpose set forth.

Secondly, the inserting of the gusset at the back part of the boot, as at Figure 14.

And, lastly, as regards the boots exhibited at the several other Figures of the Drawings, I claim the adapting thereto of two gussets, as above described.

In witness whereof, I, the said Stephen Norris, have hereunto set my hand and seal, this Twenty-third day of July, in the year of our Lord One thousand eight hundred and fifty-six. STEPHEN NORRIS. [SEAL]

Witness, ALEX. PRINCE, Patent Agent,
4 Trafalgar Square,
Charing Cross.

EXHIBIT LICENSE No. 1.

LICENSE AND AGREEMENT.

Whereas, Letters Patent of the United States dated the 6th of November 1866, numbered 59,375 were lawfully granted unto Alexander F. Evory and Alonzo Heston for a new and useful invention consisting of a "Double Expansible Flap

used in the manufacture of Boots and Shoes, and Whereas, said Alexander F. Evory and Alonzo Heston did on the 26th day of January 1877, assign, transfer and release unto J. B. Belcher of Charlotte Michigan an equal undivided half interest in and to said Letters Patent and also on the same date made said J B Belcher their attorney duly authorized by an instrument in writing and recorded in the Patent Office of the United States on the 2nd day of February 1877, in Liber J 21 page 50, and whereas Mess Lee and Brown of the city of Buffalo State of New York are desirous of acquiring the privilege and License of using said invention in the manufacture and sale of shoes. Now therefore it is agreed by and between said J. B. Belcher of the first part and said Lee and Brown of the second part as follows — 1st That said party of the second part in consideration and upon condition of the due and faithful adherence to and performance of the admission and agreement herein contained and each of them, shall have the right and License to manufacture and sell shoes containing the invention described in said Letters Patent or in any reissue thereof during the balance of the unexpired term of said Letters Patent.

2nd That said party of the second part shall pay to said party of the first his assigns or legal representatives for said privilege and License the sum of three cents per pair on all shoes which they may manufacture or sell during the said term for which said Letters Patent have been granted containing said invention or inventions.

3rd That said party of the second part shall cause to be placed on each and every pair of such shoes a stamp with the words — "Double Expansible Flap Evory and Heston Pat Nov 6th 1866," and the date of any subsequent reissue if granted.

4th That said party of the second part shall keep correct books of accounts showing all the said shoes which may be so manufactured or sold by said party of the second part containing said invention which books of accounts shall be

free for the inspection *if required* of said party of the first part his assigns or legal representatives at all seasonable times.

5th Upon a failure of the party of the second part to conform to any one of the admissions or agreements herein contained and upon continuing in such default for a period of thirty day then the party of the first part may terminate this License by serving a written notice to that effect upon the party of the second part but said party of the second part shall not thereby be discharged from any liability to the party of the first for any License fee due at the time of the service of said notice nor shall the effect of the admission of validity of said Letters Patent or reissue thereof be thereby impaired.

6th That said first party shall not grant additional License to manufacture shoes containing said invention or inventions to any party or parties within the said city of Buffalo during time in which this License may remain valid and the party of the second part continue to use the right and privilege herein conveyed.

7th That this License is personal to the said party of the second part and is in no way divisable or assignable and shall take effect from and after the 5th day of November 1877.

In witness whereof the aboved named parties have hereto set their hands and seals this day and date above mentioned

J. B. BELCHER
for himself and as atty in fact for ALEXANDER F. EVORY *and* ALONZO HESTON
LEE & BROWN Buffalo, N.Y.

EXHIBIT LICENSE No. 2.

LICENSE AND AGREEMENT.

Whereas, Letters Patent of the United States, dated the 6th day of November, 1866, numbered 59,375, were law-

fully granted unto Alexander F. Evory and Alonzo Heston for a new and useful invention consisting of a Double Expansible Gore-Flap, used in the manufacture of Boots and Shoes, and Whereas, said Alexander F. Evory and Alonzo Heston did on the 26th day of January, 1877, assign, transfer and release unto J. B. Belcher, of Charlotte, Mich., an equal undivided one half interest in and to said Letters-Patent, and also, on the same date, made said J. B. Belcher their attorney duly authorized by an instrument in writing and recorded in the Patent Office of the United States on the 2d day of February, 1877, in Liber J 21, page 50, and Whereas, Mess. J. K. Tillotson & Co of Elmira New York are desirous of acquiring the privilege and License of using said invention in the manufacture and sale of shoes; Now, therefore, it is agreed by and between said J. B. Belcher of the first part and said J. K. Tillotson & Co of the second part as follows:

1st. That said party of the second part in consideration and upon condition of the due and faithful adherence to and performance of the admissions and agreements herein contained and each of them, shall have the right and License to manufacture and sell shoes containing the invention described and specified in the aforesaid Letters-Patent or in any reissue thereof during the balance of the unexpired term of said Letters-Patent.

2d. That said party of the second part hereby admits the validity of said Letters-Patent and the worthy utility and practicability of the invention therein described and claimed, or that may or can be described and claimed in any reissue thereof and hereby agree to and shall pay to said party of the first part, his assigns or legal representatives for said privilege and license the sum of three cents per pair on all shoes which they may manufacture or sell during the said term for which said Letters-Patent have been granted, containing said invention or inventions.

3d. That said party of the second part shall cause to be

placed on each and every pair of such shoes a stamp with the words Evory & Heston Double Expansible Flap Pat Nov 6th 1866, and the date of any subsequent reissue if granted.

4th. That said party of the second part shall keep correct books of accounts showing all the said shoes which may be so manufactured or sold by said party of the second part containing said invention or inventions, which books of accounts shall be free for the inspection of said party of the first part, his assigns or legal representatives at all reasonable times.

6th. Upon a failure of the party of the second part to conform to any one or more of the admissions or agreements herein contained and upon continuing in such default for a period of thirty days then the party of the first part may terminate this License by serving a written notice to that effect upon the party of the second part, but said party of the second part shall not thereby be discharged from any liability to the party of the first part for any License fee due at the time of the service of said notice, nor shall the effect of the admissions of the validity of said Letters-Patent or reissue, or of the worthy, utility and practicability of the said invention or inventions be thereby impaired.

8th. That this License is personal to the said party of the second part and is in no way divisable or assignable and shall take effect from and after the 15th day of December 1877.

In Witness Whereof the aboved named parties have hereunto set their hands and seals this 24th day of December 1877.

J. B. BELCHER
for himself and as atty in fact for ALEXANDER F. EVORY *and* ALONZO HESTON.

J K TILLOTSON & CO.

EXHIBIT NATIONAL RUBBER COMPANY LICENSE.

Agreement between Alexander F. Evory, Alonzo Heston and J. B. Belcher, parties of the first part, and the National Rubber Company a corporation organized and doing business under the laws of the State of Rhode Island party of the second part, dated the 2nd day of September 1878.

Whereas the parties of the first part are the owners of certain letters patent for improvements in boots and shoes granted to said Evory and Heston dated November 6th 1866 No 59375. And whereas said party of the second part has infringed said letters patent and is desirous of settling for said infringement, and of obtaining a license under said letters patent and compromising the suit now pending against it in the Circuit Court of the United States for the District of Rhode Island.

Now, therefore, in consideration of the premises it is mutually agreed as follows:

1st. The said party of the second part agrees to pay to the parties of the first part the sum of five hundred dollars in cash in full for all costs, expenses, and damages, in said suit, and to pay to said parties of the first part the further sum of five thousand dollars for the license hereinafter granted: said sum of five thousand dollars to be payable in three notes of said party of the second part to the order of said parties of the first part, one for One thousand six hundred and sixty six $\frac{66}{100}$ dollars due September 1st 1879 at 1st National Bank of Charlotte Michigan with interest from Sept 1st 1878 at 7 per cent; one for the same amount, and at the same place with like interest from same date due September 1st 1880: and one for the same amount and at the same place with like interest from the same date due September 1st 1881

2d The said parties of the first part hereby grant to the party of the second part a license to manufacture and sell boots and shoes, under said letters patent of which rubber or rubber composition is the principal constituent, but not of leather or any other material than rubber or rubber composition No license other than this to manufacture boots or shoes of which rubber or rubber composition is the principal constituent, is to be granted by said parties of the first part, or either of them, in the future to any person or corporation but the sole and exclusive enjoyment of said letters patent in the manufacture of rubber or rubber composition shoes, and of the usufruct of said patent as applied to such manufacture, is by this instrument granted to the party of the second part.

3rd The parties of the first part hereby assign to the party of the second part a certain license granted by them to the Goodyear Metallic Rubber Shoe Company, dated August 1st 1877, together with all rights they may or can have to cancel the same or collect royalties thereunder.

4th The parties of the first part hereby agree to give notice of cancellation of a certain license heretofore granted by them dated July 10th 1877 to L Candee & Co of New Haven Connecticut, the said parties of the first part understanding that they have the right so to do, owing to default by said L Candee & Co.

5th The party of the second part shall have the right to bring suits under the said letters patent for infringement of the same, in the name of the parties of the first part, upon duly notifying said parties of the first part, or their attorney, of its intention so to do — and giving to them a bond of idemnity against all costs and expenses therein. And all sums of money recovered against the defendants in such action by way of damages or profits and all sums paid by way of royalties for a further use of said patent under any license executed to such defendants shall be received by and belong to the party of the second part.

6th If subsequent to the cancellation of said license of L Candee & Co. — by notice from said parties of the first part, said L Candee & Co. shall persist in manufacturing the shoe referred to in said license, and if said party of the second part shall thereafter commence suit against said L Candee & Co in the names of said parties of the first part for infringement of said patent; and if, in said suit, said L. Candee & Co shall set up in their answer that said license is still in force, and if, in said suit, said parties of the first part, or their attorney, to be named, shall have due notice of all proceedings and full opportunity to assist therein, then all said notes, falling due after said answer is filed, shall not become due or payable until the decision of the Circuit Court shall be rendered, and if, notwithstanding the premises the judgement or decree of the said Circuit Court shall declare that said cancellation, or notice of cancellation, is void or ineffectual and that said L Candee & Co are still licensees under said letters patent, then the payment of each of said notes shall be further postponed until such time, if ever, as said judgement or decree shall be reversed or set aside.

Interest shall however, continue to run until time of payment.

Provided, however that said party of the second part shall use its best endeavors to support and sustain the cancellation of said license.

In witness whereof the said parties have hereto set their hands and seals and delivered the same, October 10th 1878

ALONZO HESTON [SEAL]
by J B BELCHER *Atty*
ALEXANDER F. EVORY. [SEAL]
by J B BELCHER *Atty*
J. B. BELCHER. [SEAL]
NATIONAL RUBBER CO [SEAL]
by A. O. BOURN, *Treasurer.*

We hereby recognize and confirm the power of Attorney to J. B. Belcher to sign our names to the above instrument

ALONZO HESTON
ALEXANDER F. EVORY.

A true copy. Attest: GEO. O. EDDY,
Secretary National Rubber Co.

UNITED STATES OF AMERICA.

DISTRICT OF MASSACHUSETTS, ss.

I, John G. Stetson, clerk of the Circuit Court of the United States for the district of Massachusetts, certify that the foregoing are true copies of "Exhibit Norris and Rogers Patent" ~~(except that the drawings thereof are omitted)~~, "Stephen Norris Patent" ~~(except that the drawings thereof are omitted)~~, "Exhibit License No. 1," "Exhibit License No. 2," and "Exhibit National Rubber Company License," in the cause in equity entitled, *Alexander F. Evory et al., Complainants*, v. *John W. Burt et al., Defendants*, determined in said Circuit Court at the October term, 1885, thereof, and carried to the Supreme Court of the United States on the appeal of the defendants, and there entered at the October term, 1886, thereof.

This certificate is made at the request of said defendants for the purpose of correcting the omission of said exhibits from the transcript of the record in said cause.

In testimony whereof I have hereunto set my hand and affixed the seal of said Circuit Court, at Boston [SEAL] in said district, this seventeenth day of October, A.D. 1889.

JOHN G. STETSON,
Clerk.

CIRCUIT COURT OF THE UNITED STATES.

DISTRICT OF MASSACHUSETTS.

IN EQUITY.

No. 1478. ALEXANDER F. EVORY ET AL. *v.* JOHN W. BURT ET AL.

ORDER OF COURT.

OCTOBER 16, 1869.

COLT, J.

On motion of George D. Noyes, Esq., of counsel for defendants, it being made to appear to the court that it is proper that the following paper exhibits, put in evidence in the above entitled cause, namely, —

Exhibit Stephen Norris Patent,
" Norris and Rogers Patent,
" License No. 1,
" License No. 2,
" National Rubber Company License,
" Stamps,

should be open to the inspection of the Supreme Court of the United States upon the appeal in said cause: it is ordered that the said paper exhibits inclosed in a package marked "To be returned to the Circuit Court for the District of Massachusetts," be forwarded to the Clerk of the Supreme Court with the other exhibits in the cause, provided, however, that the defendants shall file in this court printed copies of said paper exhibits.

By the Court,

JOHN G. STETSON,
Clerk.

A true copy. Attest: JOHN G. STETSON, *Clerk.*

Office Supreme Court, U. S.
FILED.
NOV 18 1889
JAMES H. McKENNEY,
CLERK.

SUPREME COURT OF THE UNITED STATES.

OCTOBER TERM, 1889.

No. 164.

JOHN W. BURT AND FRED PACKARD,
Appellants,

v.

ALEXANDER F. EVORY, ALONZO HESTON, AND J. B. BELCHER.

APPELLANTS' BRIEF.

GEORGE D. NOYES,
of Counsel.

Supreme Court of the United States.

OCTOBER TERM, 1889.

JOHN W. BURT *and* FRED PACKARD, *Appellants*,

v.

ALEXANDER F. EVORY, ALONZO HESTON,
and J. B. BELCHER.

APPELLANTS' BRIEF.

THE CASE STATED.

This is an appeal from the Circuit Court for the District of Massachusetts on a decree for complainants, who alleged infringement of Letters Patent of the United States granted to Evory & Heston November 6, 1886, for "improvement in shoes."

January 26, 1877, the patentees assigned an interest to Belcher; October 10, 1878, an exclusive license to make rubber goods was granted to the National Rubber Company.

The bill prays for an injunction and account of profits and for damages.

The claim of the patent in suit is correctly recited in the complainants' bill as follows: "A shoe when constructed with an expansion gore flap C D, the external fold C of which is attached to and in front of the quarter B, and the internal fold D of which is attached to and in the rear of the vamp A, the said several parts and pieces being respectively

constructed and the whole arranged for use substantially in the manner and for the purpose set forth."

It is also alleged that the defendants have made and sold shoes under a patent granted to the defendant Packard June 18, 1878, and also *other* shoes containing the invention claimed and which is described in the Evory & Heston patent.

The Packard patent does not belong to the complainants, and there is no allegation or pretence that it does. The only possible issue is whether the defendants have made *other* shoes than those which are described in their own patent; that is, shoes which are described and claimed in the Evory & Heston patent.

As there is no mention in the claim of that part of a shoe commonly called a sole, it obviously relates to a "shoe upper," and the drawing is so labelled. And as the complainants did not exhibit any form of shoe or "shoe upper" designed by them, the defendants made and put in evidence, for the convenience of the Court, a sample of the invention alleged and shown in the drawing. On cross-examination, the complainants' expert conceded that the exhibit correctly represents the upper described in the patent in suit (p. 30, ans. 25; p. 37, ans. 4; *Evory & Heston Shoe*).

The defendants deny infringement, and that the patentees are the original and first inventors of the shoe described in the patent in suit. They admit that they have made and sold shoes described in the Packard patent; but deny that such making and vending was in violation of the complainants' rights. They deny, in substance, that they have made what the complainants concede to be *other* shoes described and claimed in the patent in suit (pp. 6, 7).

If, by possibility, the complainants can be regarded as alleging mere matters of opinion, it is obvious that they have sought to make an issue *whether the Packard patent is to be subordinated to* the patent in suit. That issue, of course, was not accepted by the defendants who set up the Packard

patent as covering a shoe which has no gore flap and no substitute for it; for it is impossible for a single gore to expand or close a shoe unless it be elastic as in the old style of shoe called the congress.

The only evidence of infringement is the "Exhibit Packard Shoe," which, as is clear from inspection, has no gore flap. The wings of the vamp are turned down and stitched to the quarter, thus forming a single gore or gusset precisely as described in a patent granted to Norris in England, No. 185 of 1856. Another way of constructing the same shoe would be to turn in the front end of the quarter and stitch it to the vamp.

Assuming that the complainants mean to be understood as alleging that their invention includes the Packard shoe, the defendants answer that the alleged invention is fully described in said British patent. It will be seen that the Packard and Norris shoes are constructed in precisely the same way; and, therefore, that if it be true that the Evory & Heston patent is capable of being construed so as to contain the shoe made by the defendants, said patent is void. The defendants' patent must have been granted without any knowledge of the Norris patent, and was to all intents and purposes regarded by them as void after they were informed of that publication.

The Court found that the shoes manufactured and sold by the defendants contain, as is obvious from inspection, a single gore. But as they have the function of the shoe described and claimed in the patent in suit, an interlocutory decree was entered for the complainants and an injunction granted; and the case was referred to a master to ascertain and report the profits the defendants have received, from the invention, and the damages, if any, in addition to the profits, the complainants have sustained.

In a statement filed by the defendants they admit that they have made 49,000 pair of Alexis shoes, but how many

contained a gore they were unable to say, and offered their books and accounts to the complainants and to assist in the object of the examination (p. 9).

Thereupon the complainants charged that 48,000 pairs of the shoes made by the defendant had the invention described and claimed by the complainants; that is, that they had the single gore arranged as in the "Exhibit Packard Shoe, J. G."

That they were sold in the market in direct conflict with the manufacture and sale of the shoes made by the complainants.

That the profit of defendants on such shoes was at least fifty cents per pair, which, but for the infringement, could have been made by the complainants.

That the use of the invention increased the sale of the Alexis shoes and was the reason of their marketability.

That defendants have granted licenses at the rate of three cents for each shoe to various parties; and that the value of the invention was twenty-five cents per pair.

That "by reason of these wrongful acts of the defendants the complainants have suffered damages to the amount of $25,000."

The defendants denied the allegations of the charge, and the complainants offered no evidence in their support except as to that part which alleges a license to have been granted to various parties.

The master reports that the defendants derived no gain or advantage from the invention, and that it does not appear that damage was sustained in business by the only one of the complainants who was doing business under the patent. There is no finding that the complainants have sustained damages. But the master finds that the complainants had a fixed royalty, and concludes that the defendants "should pay this royalty," which is computed on 41,297 pairs of shoes to be $1238.91 (pp. 11, 13, 14).

There is no pretence that the defendants had ever agreed

to pay this royalty fee, which had been solicited from others but not from the defendants.

The complainants excepted because the report does not find that the defendants' profits were $7200, or 15 cents on each of 48,000 pairs. These exceptions are not based on anything in the evidence, but it may perhaps be claimed that the complainants *waived* a claim to profits with a view of getting damages (p. 23).

The defendants objected to the evidence in relation to license fees, and filed the following exceptions: —

1. That the objection made to the evidence of a license fee [to others] and to the sufficiency thereof to charge the defendants with the payment of $1238.91, or any other sum, ought to have been sustained.

2. That the evidence was insufficient to show that a license fee had been established within the meaning of the law.

3. That, on the findings of the report and on the evidence, the master should also have found that the complainants are not entitled to recover even nominal damages.

The Court, after a hearing on the defendants' exceptions, *assessed damages* to an amount equal to the royalty which the master had computed to be due, and entered a decree therefor. Thereupon the defendants duly appealed, and assigned the following errors: —

1. That the Court erred in holding that the patent is valid:

2. In holding that, in view of the antecedent state of the art, the patent has been infringed by defendants:

3. In construing the patent in suit:

4. In sustaining the master's report and in overruling defendants' exceptions:

5. In holding that a license fee is the measure of damages, no damage to the business of the complainants being proved:

6. In holding that the fact that license fees were received from others and not from defendants is proof of damages, although the report finds that the complainants were not

damaged either in their business of manufacturing under the patent or of selling licenses:

7. In holding that the damage consists in not receiving the royalty based on an established license fee, the report finding that the defendants had no knowledge of the license fee and there being no finding of an agreement to pay it.

[It also appears from the record that neither of the complainants appeared as a witness except before the master. Belcher then testified that one of the patterns of shoes made by him was "shoe received by express" (p. 12, § 2, note 1; p. 13, § 5; exhibits p. 13).

The effect of this testimony was, as it seemed to me, to prove that the complainants' practice was inconsistent with their expert's theory that a shoe in which an extension of the vamp is turned within the shoe is uncomfortable.

It does not appear which style of shoe Belcher preferred. However that may be, the fact remains that Belcher would not have made and sold this style of shoe if it is so inherently uncomfortable as Brevoort claims it to be. In a recent case, *Bené* v. *Jeantet*, 129 U.S. 683, there was a similar diversity between theory and practice, and this Court held that infringement was not proved.]

The exhibits "Norris Patent," "Norris & Rogers Patent," "License No. 1," "License No. 2," "National Rubber Co. License," and "Stamps," not having been printed in the record, are, for the convenience of the Court, made an appendix.

["Exhibit Stamps" consists of 30 paper diamond-shaped stamps, marked "Double Expansible Flap," "Pat. No. 6, 1866, Evory & Heston," "Lic. Stamp," the opposite side of the paper having an adhesive preparation.]

THE COMPLAINANTS' PRIMA FACIE CASE.

There is nothing in the pleadings to justify the extraordinary method adopted for making out a *prima facie* case. It is submitted that the only way to prove infringement is to compare the thing made by the defendants with the patent in suit. Instead of doing so, the complainants called an expert to explain to the Court the shoe described *in the Packard patent;* but, as Judge LOWELL justly finds, he explains what is not there. There is nothing new in the Packard shoe except a single gore arranged so as to lie wholly between the front part of the quarter and the vamp. And, as already suggested, there is nothing patentable in that.

It is only by confusing things of a distinct and tangible manufacture and by indulging in a play upon words that Mr. Brevoort is able to find a "gore flap" in the Packard shoe. It is idle to call a "quarter" a *flap*. The two things are regarded in the patent as having distinct functions.

It is true that, a week after this extraordinary deposition in which Mr. Brevoort attempted to explain to the Court a shoe of his own imagination, the complainants put in evidence the shoe marked "Packard Shoe, J.G." It is a refutation of the opinions of Mr. Brevoort; for, as the Court finds, it has only a single gore. (Opinion, p. 65.)

Notwithstanding the reasoning of the Court below, it seems to me to be very clear that a gore, in order to open a shoe, must be elastic if single, and double if inelastic.

In the well known congress shoe, a sample of which is exhibited, it appears to have been thought necessary that a single gore, in order to be an expander, should be elastic; and according to the theory of the patentees, it seems to have been taken for granted that an inelastic substitute for it should be double. But in the light of Mr. Brevoort's researches and discoveries, a single inelastic gore answers the purpose just as well, except, perhaps, where it is made

and stitched to the quarters as shown in exhibits "Norris Shoe" and "Shoe Received by Express" (p. 55, ans. 20, 21).

THE PATENT CONSTRUED IN VIEW OF THE STATE OF THE ART.

A shoe is so common a fabric that judicial notice will be taken of it. As the language of the patent denotes, and as every one knows, the essential parts of a shoe are the vamp or front part, the quarters, and the sole. The several parts are made of a great variety of shapes. Sometimes the vamp extends to the front edge of the heel, thus compelling the use of short quarters; and sometimes the quarters extend from the heel to that part of the vamp designed to cover what is known as the "instep" of the foot. When the several parts are sewed together in such a way as to form a garment for the foot, they are called a shoe. Even when it does not fit the foot very well it answers a very useful purpose. A "shoe upper" is a completed and useful fabric because a sole may be attached to it.

But the patent in suit relates only to that particular class of shoes which are known as water-tight. It is a matter of history, and the fact is stated in the patent in suit, that shoes were improved by Samuel Babbit, who cut and folded the parts of an ordinary shoe upper constructed in such a way as to form a single gore. And other antecedent patents are alluded to in the specification.

Objection was made to the introduction of these patents (the Babbit and the Brown & Wooton) because they are not set up in the answer (p. 38). It is too well settled to need the citation of cases that evidence denoting the state of the art at the time of an alleged invention is admissible without being set forth in the answer.

Evidence, therefore, was admissible to show the limitations

which are necessary in order to give the patent such a construction that it may stand.

If a steam-engine were to be described it would be necessary to use the terms "boiler," "cylinder," "piston." And if an expert in attempting to describe a steam-engine should confuse the terms and speak of the piston when he meant the cylinder, or of the cylinder when he meant the boiler, it would be taken for granted that he had but a very vague and imperfect understanding of what he was talking about.

In describing a shoe it is necessary to know that its upper consists of a vamp and quarters, or front and sides. The patentees assume that every one knows what vamps and quarters are, and that they may be cut in a great variety of forms. But a *gore flap* is something new; and, as will presently be seen, it means a gore which folds and unfolds, thus enabling the shoe in which it is used to be worn or taken off of the foot.

Now, although the complainants' expert would not fail to give the Court an accurate description of the most complicated machine; yet when he comes to explain this very simple shoe which the patentees explain so clearly that any further attempt to do so is simply to obscure judicial vision, he interchanges flaps and quarters, and speaks of the extension of quarters which cannot be extended without making it impossible to use a gore flap or the invention of Evory & Heston.

While Mr. Brevoort speaks of a "quarter" as a flap, Judge Lowell, giving the opinion of the Court, speaks of a "gore" as a flap, and of a shoe as something in which the vamp and quarters are sewed together, thus making it waterproof. But that is the way to spoil a shoe. If you then make an opening and put in a gore, the shoe would of course open wider than an equally waterproof shoe without a gore. It seems to me, therefore, that the reasoning of that learned judge in reply to the views of Mr. Packard

is incorrect. The truth is, that neither the parts of a shoe as made on a last, nor the same parts sewed up, constitute "*a shoe*" within the meaning of the patentees.

It is equally clear that the single gore of the defendants' shoe is, in substance, a stay-piece which strengthens the union of the vamp and quarters; and that, while an incidental function is to exclude, to a certain extent, extraneous substances, it has nothing to do with the closing or opening of the shoe. This seems to be a wholly unimportant matter; but as Mr. Packard's patent had been put in evidence by the complainants, it seemed to him proper to correct an obviously erroneous statement therein (p. 57).

In delivering the opinion of the Court, Judge LOWELL observed, "The validity of the patent is not now assailed unless a wide construction is given to the claim." But on the construction assumed by him, at least three fifths of the body of the specification is eliminated, and the claim is construed as if it read "a shoe having a single gore lying between the front edge of the quarter and the rear edge of the vamp, so that it will rest wholly on the outside of the vamp when the shoe is worn." In the Norris exhibit the gore is partially within the shoe.

The question is, what is the true construction of the claim? In the first place, it may be conceded that the words "a shoe when constructed" may have reference to the mode or manner of construction, that is, to the gradual way in which it is completed, or to the article of manufacfacture *when completed*. The patentees claim a shoe when constructed. If the claim be limited by giving force to that part of the specification and claim which describes the construction of the only thing which is novel, it is not material to inquire whether the patent is valid or not. If the patent be construed so that it *may* stand, it can be *only by excluding from the scope of the claim a shoe as an article of manu-*

facture, and confining the claim to the described method of making a shoe.

In that event, it is plain that the defendants have not infringed, because the process of manufacturing their shoe is very different from that described. It is equally plain that if the patent covers an article of manufacture, and not the way of making it, the patent is void, because the shoe is a mere aggregation of old parts, with such change of form as a rearrangement might require, and nothing more.

If reference be had to the particular intent of the patentees, Evory & Heston, it would seem that they could not have expected to get a patent on an article of manufacture, but that they might slip through the Office on a specification and claim which would confine their supposed invention to the mode of making a shoe.

The opinion of the Court appears to be based on the notion that the defendants' shoe is an infringement, because "it has to a greater or less extent the same advantages." The opinion seems to follow *Evory* v. *Candee*, although it will be seen that in that case no mention is made of the state of the art as shown by the patents alluded to in the specification. The claim appears to have been regarded as covering an article of manufacture. There may be something of inventive genius in what is called a gore flap, but no claim is made for it. And it is too plain for argument that, in combination with the other parts, it has no new function; nor does the shoe have any new function in consequence of the use of a gore flap of this form.

The patentees say, "We do not claim broadly for an extension gore flap inserted in the ankle of gaiter shoes, for this is fully covered by the broad claim of Babbit's patent, to which our patent will be subject; but our mode of construction is an improvement upon that and all the other modes since patented in certain particulars." But in not one of the particulars mentioned is there any allusion to the notion of Mr. Brevoort that the essential difference between it and

other shoes depends on the fact that the gore flap lies wholly on the outside of the shoe proper (p. 25, ans. 14).

The complainants' theory of their patent is that it is not valid unless it covers a "mode of construction," that is, a process of constructing what they call a double extension gore, or gore flap, as distinguished from elongating the quarters and folding them. In the process of constructing an upper, Babbit merely manipulated the vamp and long quarters. He constructed his shoe by folding these quarters so as to make a single gore, which might be disposed so that the quarters would need to be tied together at the instep when the shoe was worn; in which case, of course, the seam would be at the heel. This kind of shoe is illustrated by "Exhibit Snow Excluder."

Babbit seems to have thought that a preferable mode of construction was to fold the elongated quarters *at the heel* and button them on the side, as shown in the drawing (p. 58).

Now, instead of elongating and folding one of the original parts of a shoe, Evory & Heston made a new piece, which required that the *quarters* should be cut short. They made, not a single gore which had been formed by Babbit; but they cut the quarters so that they could not be folded. Then they cut a vamp which could not be folded; then a "flap" and sewed it to the quarter; then another "flap" and sewed it to the vamp. Then they sewed the free ends of the flaps together, so that *by folding them* the edges of the vamp and quarter were drawn together, and drawn away from each other when these two flaps were unfolded.

This *mode of constructing a shoe* is, by the concession of the patentees, the only novelty within the scope of the specification. "Our said invention consists in a novel mode of constructing shoes and gaiters whereby the ordinary elastic goring and the tedious lacing up at the front are both dispensed." That is, instead of inserting a single elastic gore, or forming a single inelastic gore as was done by the folding

of quarters in the Babbit shoe, we make two corresponding flaps, stitch them to the rear of the vamp and front of the quarter, and the ends so that they may be folded.

Whatever might be the shape of the quarters or the vamp, it was necessary that a *gore flap* should be constructed. If that be omitted, its place might be supplied by "the ordinary elastic goring," but there is no suggestion that the functions of the shoe might be obtained by splicing out the quarters and folding them so that they would rest on the outside of the vamp.

On the contrary, the specification is based on a concession, apparent on its face, that *a shoe having* (in the language of the Babbit patent) *a folding extension of the quarters is not claimed*, and that only another mode of constructing a shoe with the same fuctions is claimed. And the only novelty in "our mode of construction" consists in cutting exactly the opposite form of quarters, thus necessitating the use *of a double flap*, which, by folding or unfolding, will close or open the shoe.

That double flap C D is now said to represent an extended quarter. That is, it is said that the parts C B may denote a quarter, and the part D, which lies under the "external fold C," a single gore. But the mode, method, or process of constructing a shoe in that way is obviously very different from that specified by the patentees. That is the way the shoe described by Norris is made and the way the Packard shoe is made. A quarter, long or short, is always a single piece.

A few months after Babbit's patent was granted, Brown & Wooton obtained a patent expressly on the ground that the method of extending the quarters and folding them might be improved upon. They thought that the true mode of constructing a shoe was to cut the quarters short, sew them directly to the vamp, and stitch a flap to the rear ends, which flap was to be folded over and tied at the instep, as shown in the drawing (p. 62). Brown & Wooton varied

the "flap" lies on the outside of the "shoe proper" of all shoes in which a double expansion gore or its equivalent is used (p. 38, ans. 7). Mr. Brevoort was, therefore, compelled to abandon the original ground that the patentability of the Evory & Heston shoe depends on the relation of the gore flap to the shoe proper, that is, that the flap does not fold directly against the foot as in the Norris shoe and Belcher's "shoe received by express;" and to assume that patentability depends *on the comfort* of the shoe when worn (p. 54, ans. 14–18).

In his second deposition Mr. Brevoort tries to establish a distinction between a shoe which has the flap folded at the heel, as in Brown & Wooton, and a shoe in which the flap is folded at the sides. The former is an uncomfortable shoe, while the latter is comfortable and patentable, not because it is useful, but because it is *comfortably* useful (pp. 53–55). Shift the means for making a shoe water-tight to *the side* of the shoe, and it is patentable because more comfortable. But Mr. Brevoort seems to have forgotten that Babbit had described how the principal parts of a shoe might be cut, and that he had claimed any folding extension. He thereby says, in substance, that if the fold at the heel is uncomfortable, it may be made elsewhere.

On the whole, it seems that the opinion of the patentees, as indicated in the form of licenses for leather shoes, is preferable to that of their expert. They recite that they have invented "a double expansible flap used in the manufacture of boots and shoes," meaning thereby that they have not invented a shoe with a single gore. The single-gored shoe had been described in publications ten years old; and if there was any invention in making a shoe with the flap on the outside of the shoe proper, Babbit, or Brown and Wooton had shown how it might be done.

It does not expressly appear that the Court below adopted the theory that the complainants' shoe was patentable because it was assumed to be *comfortable* as compared with

the shoes described in the American patents. However that may be, it seems to be sufficient to suggest that it is not a statutory requirement of any article of manufacture that it shall be comfortable. Mr. Brevoort admits that the item of comfort is a mere matter of comparison (p. 50, ans. 6, cross 14–16). But, the suggestion that the patentability of shoes depends upon an increase of comfort derived from forming a gore by stitching one end to the vamp and the other to the quarter, is repugnant to the entire spirit and tenor of the drawings and specification.

If it can be assumed that the patent in suit covers a shoe like that which is put in evidence by the complainants, then, as it seems to me, it is void, in view of the description of the Norris shoe in English patent 185 of 1856. Indeed, the method of making a shoe water-tight, as there defined, is so simple as hardly to come within the meaning of the term *invention* as understood in the law of this country. Either of these reasons is sufficient to account for the absence of any allusion by the patentees to the fanciful ideas of their expert.

The drawings of Norris present a great variety of forms in which his shoe may be made. After alluding to the merits of his invention, Norris says, "The principal points to be attended to in these improvements are to have the gussets of the proper size, and connect them to the front or back part of the shoe by sewing or stabbing, so that they may, when necessary, be rendered waterproof. As regards the fastenings, I employ any of the known means for that purpose."

In the provisional specification he says, "For ladies' slippers I propose to place the gusset at the instep thereof."

In view of this description of a water-tight shoe by Norris it seems that even Babbit could not cover an entire shoe, even if he had expressly stated that his elongated quarters might be folded so as to lie over the vamp at the instep. It is true that Norris does not expressly say that the gore may

be made in such a way that it will lie *wholly* outside of the shoe; but where could it lie *at the instep*, except on the outside of the vamp? Besides, in any kind of a shoe, the gore must lie on the outside, if the folding is made for that purpose, that is, if the gore, is of the proper size to be stitched to end of the quarter, instead of just above the buttonholes.

If the patent in suit be construed as including a fabric having a single gore, it is void, inasmuch as, in view of the instructions detailed by Norris, the question as to the precise point at which the fold is to be made and stitched to the quarter is one to be determined by the judgment or taste of the manufacturer. (*U.S. Corset Co.* v. *Cohen*, 93 U.S.)

It seems too plain for argument that if the patent had been reissued so as to cover a shoe having the form and construction of the defendants' manufacture, it would have been void by force of the principle laid down by Judge Baldwin nearly fifty years ago, but finally established by this Court in recent cases too numerous to be cited. (*Stimson* v. *West Chester R.R. Co.*, 4 How. 380.) It ought not to have been construed as though it had been reissued. It is submitted that the decree of the Court below should be reversed, and that the bill should be dismissed with costs.

THE MASTER'S REPORT AND THE FINAL DECREE.

If it be assumed that the defendants have infringed, it remains to show that they are not liable for *damages*. By saying that the defendants are not liable for damages, I mean to be understood that it is conceded that no damage was actually sustained, unless it consists in not receiving from the defendants a license fee, which some others paid; or, in other words, unless "the fact that license fees were received from others, and not from the defendants, is proof of damage" (p. 67).

It being conceded that the defendants conducted the in-

fringing business with diligence, and used every reasonable effort to derive as much advantage as was possible from the manufacture and sale of the infringing shoe, is the evidence that the complainants sought a profit by selling, or rather by trying to sell, licenses material or applicable to the facts of the case?

Section 4921 of the Revised Statutes (act of 1870, sec. 55) provides that the courts vested with jurisdiction of cases arising under the patent laws shall have power to grant injunctions to prevent the violation of any right secured by a patent; and upon a decree being rendered in such case for an infringement, the complainant shall be entitled to recover, in addition to the profits to be accounted for by the defendant, the damages the complainant has sustained thereby, and the Court shall assess the same, or cause the same to be assessed under its direction.

Section 4917 provides that "damages for infringement of any patent may be recovered by an action on the case."

Both sections authorize the Court to enter judgment or decree for three times the actual damages.

The conclusion of the master is that the defendants should pay a royalty on each shoe made by them, based on a license fee, which, in dealings with some others, had been fixed at three cents per pair.

It is very probable that, although the complainants' bill prays for an account of profits and for damages, and not for a royalty, its real object was to compel the payment of license fees, on the ground that that was the way the complainants sought their profit from others. Why should not the defendants pay a royalty as well as those who had bought the complainants' stamps? For that was the only way others got a right to manufacture leather shoes. According to the law adopted by the circuit courts, may not a bill be maintained for the payment of license fees, at least where the defendant has agreed to pay them? The master seems to

have thought that the principle might be extended to a case where the defendants were never even asked to take a license.

It will be conceded, of course, that the master was in error; and although it is not necessary to consider now any matter not involved in the assignment (p. 68), it may be observed that the error consists in not perceiving that the practice of maintaining bills nominally for injunction and account, but really for the purpose of compelling payment of license fees, has been condemned and virtually overruled by this Court. (*Bailey* v. *Eureka*, 11 Wal. in *Root* v. *Railway Co.*, 105 U.S. 105.)

We have, however, to deal now with the errors of the Court as involved in the rescript or opinion on which the final decree was ordered (p. 67).

In order to get a just conception of the errors of the complainants' position and of the errors of the Court, it is necessary, in the first place, to recur to certain allegations of the bill by reason of which the case was referred to a master, and to discriminate between those which are material and those which are not. For it is submitted that no issue, either of law or fact, was determined by the interlocutory decree, except that the complainants' patent is valid, and has been infringed by the manufacture and sale of shoes having a single gore, as in "Exhibit Packard, J.G."

The complainants allege that by the acts and doings of the defendants, and others acting in concert with them, they were and are now prevented and hindered from making a profit (p. 3). They also allege that they have been prevented by the defendants from putting the invention into successful operation (ib.).

These are allegations of fact, and as such it will presently appear that they *were known*, when the bill was signed, to be untrue, unless by *profit* a license fee is meant.

They also allege that the defendants, well knowing the premises and the rights and privileges secured to your

orators, and in order to deprive them of the profits, benefit, and advantages which might and otherwise would have accrued to them, unlawfully made and sold shoes (p. 3, par. 3). Finally they allege that they have been greatly injured.

These allegations cannot be regarded merely as of opinion or of supposed law. They are allegations of facts which are to be proved in order to entitle the complainants to profits or to damages.

The bill also alleges that your orators "put the invention into use and manufactured large numbers of shoes, and granted licenses to others where they deemed it advisable to do so, and when such licenses could be granted without detriment to their own business" (p. 2). In the charge it is alleged that their fee for a license was three cents for every shoe made (p. 10). These allegations are not material.

There is no allegation that a license was ever offered to the defendants. On the contrary, it would seem that such an offer was not deemed "advisable."

There is an allegation that complainants "are deprived and prevented from receiving the gains and profits to which they are lawfully entitled" from the exclusive rights and privileges granted and received to them (p. 3). But what is the true intent and meaning of this?

In view of the position of the complainants, presently to be stated from the brief of their able and learned counsel, it is too plain for argument that this means that if the defendants made no profits, *the complainants are entitled to the profits they would have made if they had sold the defendants a license and the defendants had made shoes which required a three-cent stamp before they could be sold.*

The bill prays not only for a decree for all such gains and profits as have accrued *to the defendants*, but for "all such gains and profits as your orators would have received but for the said wrongful acts and doings of the said defendants,

and all damages your orators have sustained thereby;" that is, because they did not receive the license fee which is alleged to have been paid by others.

It is true that there is a prayer for an injunction; but, as will be seen presently, that was a mere form, the fact being, as already suggested, that the complainants did not want an injunction, and that they must have known that it would do them no good to get it, because they were not carrying on business expressly granted by the patent.

According to the usual practice, and therefore without knowledge of the facts, the Court granted an injunction, and referred the case to a master, who was instructed "to take and report to the Court an account of the profits accrued to the defendants from the infringement, and to ascertain and report the damages, if any, in addition to the profits which the complainants have sustained thereby" (p. 7).

At the request of the parties, the master reports all such portions of the evidence as bear on the questions involved. Apart from the opinion of the Court, it appears that no evidence was offered in proof of the allegations of damage. The testimony was objected to, not because there was doubt whether the complainants sought their profit by escaping the risk of establishing a manufacturing and selling business, but because the fact is immaterial (p. 16, ans. 33, 43; p. 17, ans. 4–46; p. 17, ans. 97).

The licenses to make leather shoes show that the complainants were to receive three cents for every "double extension gore flap" used. But they do not appear to have granted a license to use a single gore as in "Shoe Received by Express" and "Packard Shoe." The master seems to have assumed that, if any such license had been granted, it would have been at the same price put on the double extension gore flap. (Exhibits License 1 and 2; Belcher, p. 16, 17, ans. 104.)

There was no evidence that a shoe was ever made under

the patent in suit by any licensee. The Rubber Company license recites that it was granted because the company was desirous of compromising a suit against it in Rhode Island. The objection to this license, therefore, might be rested on a somewhat narrower ground than that to licenses 1 and 2. Balderstone gives an amusing account of the purchase, and confesses that his only object was to use the right as a sort of body-guard to the Williams patent, another of the numerous patents, I suppose, which followed that of Babbit (p. 18).

Nor does Belcher himself pretend that the shoes constructed by him in which he used a double expansion gore were any more profitable than those which were constructed without one.

The defendants had every incentive of self-interest to establish a market for their shoe, and proved facts which are conceded to justify the finding that the infringing business was conducted in such a way as to yield them the largest profit. It was for them to decide what price the shoe would bear, and the price was fixed without knowledge of any competing shoe made by the complainants or any one else. Indeed, there was no competing shoe, and the defendants had no knowledge of the complainants or their business (p. 19).

The issue referred to the master in relation to profits was fully investigated. The complainants waived no right to an exhaustive examination of the defendants' books and accounts, and no complaint was made or evidence adduced tending to show that they were not intelligently and accurately kept.

With respect to the profits alleged to have been made *by the defendants*, the master reports that they succeeded in establishing a good market for the shoe with a single gore (which the complainants never attempted to find for the form they licensed under the patent), and conducted the

business "prudently and for the sole purpose of making as much profit as possible;" but the use of the alleged invention was of no gain or advantage to them. They made and sold 41,297 pairs at the highest price they could get, but derived no profit from the invention.

In establishing this market for their shoe the defendants did not in any way interfere with the complainants, or even with the licensing business which they are said to have established (p. 14, sec. 6).

Belcher was doing a retail shoe business at Charlotte, Mich., and between 1878 and 1883 he made to order a few shoes containing a double extension gore. But the defendants knew nothing of him or his trade or of his co-complainants (p. 18). So far were the defendants from doing anything to injure the complainants that, unconsciously, everything was done that could be done to promote the complainants' interests.

The finding that Belcher "does not appear to have been damaged," either in his business of making and selling shoes, or in that of selling, or trying to sell, licenses to use a double extension gore flap in shoes, is not regarded by the defendants as of any importance, inasmuch as the question was whether he and his co-complainants had sustained damages within the intent and meaning of the word as used in section 4921 of the statutes.

Although Belcher retired from business in 1882, it is not claimed that he was forced to do so by the infringement, or because he found a poor sale for stamps (ans. 104). Nor is it claimed that his co-complainants were prevented from going into business, or that he sold a stamp less on account the infringement. On the contrary, the entire case rests upon the assumption that the allegations of the bill in that particular are groundless, and on the admission that the complainants preferred that others should run the risks of their capital in commercial business while Belcher sold stamps as a condition of anything being done towards sup-

plying the market with shoes having a double expansion gore-flap. (*Vide* liccnses 1 and 2.)

It will be observed that one of the objections to the report was that "no license was established within the meaning of the law." By this the defendants mean to be understood as insisting that in cases where evidence of a license fee is applicable, it is wholly immaterial whether more than one license has been granted, or whether the rate was uniform or not. No license fee can be said to have been "established" except between the parties to it (p. 13 sec. 5). It is not claimed that the complainants had ever solicited a license from the defendants, or that they had refused to take one.

There appears to be no finding on the issue whether the complainants had sustained damages. There was evidence showing that the complainants had an established license fee, meaning thereby that they sought a profit by selling them instead of shoes. Therefore, as already stated, the master concludes that the defendants "should pay this royalty."

As a matter of construction, it seems to me that the inevitable conclusion from the material facts stated in the report is that the complainants were not damaged, inasmuch as the report does not find that they were. Accordingly the master was requested to report that the complainants *are not entitled to recover any sum whatever* (p. 14, sec. 7). The reason for the proposed departure from a usual form will presently appear.

As it was for the interest of the complainants that the patent should be infringed, provided the infringing business was honestly and diligently conducted for the sole purpose of getting as much profit therefrom as possible, it seems to me that the master had before him a case in in which it was impossible to say that damages had been sustained by the complainants.

Possibly the master was a little doubtful with regard to the extraordinary statement of the law as laid down by a recent text writer, and determined to refer the question of damages to the Court. Certainly, under the provisions of the statute, it was competent to do so.

The substance of the defendants' exceptions was that there is no such law as is implied in the conclusion of the master, and that the only rational conclusion, either from a logical or an equitable point of view, was that the complainants are not entitled to recover *even nominal damages* (p. 21; p. 14, sec. 7).

The opinion of Mr. Justice COLT recognizes the fact that it does not appear from the report that damages have been sustained unless they consist in the non-payment of license fees. "The damages consist," says the learned judge, "in not receiving the royalty which such a license fee would have brought. The complainants have mainly sought their profits in the form of royalty. Under these circumstances we deem the fact that one of the complainants, who made shoes to order for his retail trade, was not damaged in his business by the sale of the defendants, immaterial on the question of the proper rule of damages. We think that the fact that license fees were received from others, and not from the defendants, is proof of damages" (p. 67).

Hence, the report being modified and amended, an order was entered overruling the defendants' exceptions, and a decree entered accordingly.

It seems to be contrary to the principles of equity to construe a master's report as insinuating that, if the complainants had not sustained damages in one way, they must have sustained them in another. But if it be said that the Court assumed a correct construction of the report, and that the master intended to admit the evidence objected to as proof of damages, the result is that *the master also* held that the only proof that the complainants had sustained damages

is the proof that the complainants had licensed others and had a fixed fee, and that the defendants had not paid it.

The master's report informed the Court that there was no chance that an injunction would subserve any right or interest of the complainants. The injunction was dissolved on the expiration of the patent, nearly a year before the report was returned to the Court. If the patent had not expired, there would have been equally good ground for its dissolution, in the case developed by the complainants themselves after the reference to the master. For, though the *ostensible* basis of the case was a prayer for injunction, that was what they did not want, except as a measure of coercion; for they were doing no business, and did not want to do any.

In *Root* v. *Railway*, Mr. Justice MATTHEWS, referring to the decision in *Bailey Co.* v. *Eureka Co.*, 11 Wal. 488, said that the object of the bill was to collect a license fee which the defendant had agreed to pay, meaning that in such a case a court of equity is not the proper jurisdiction; for "an injunction is not to be used as an execution or for extortion." (*Vide Saunders* v. *Logan*, 2 Fisher Pat. Cases, 168.)

Where it is plain from an inspection of the record that a complainant has attempted to compel an alleged infringer to pay a license fee, it seems to me that this Court has the power to say so, as in *Root* v. *Railway*, and therefore to issue an order than the decree should be reversed and the bill dismissed. How can this Court be protected from such an abuse of process in any other way?

On what principle can it be said that the prayer for an injunction gives jurisdiction, when, *on facts confessed by the complainants themselves*, it appears that they knew there was no ground for an injunction? The right to profits depends on the right to an injunction; and that does not exist except in the discretion of the Court acting on the assumption that the allegations of the bill are true. In the present case the

Court has found, in effect, that the allegations *must have been known* not to be true; for it is said that the complainants had elected not to go into the business protected by the patent, — not that they had been prevented from doing so, or that they wished to do so in the future. (*Vide Parker* v. *Cotton Co.*, 2 Black, 545; *New York Co.* v. *Memphis Co.*, 107 U.S. 205; *Wright* v. *Ellison*, 1 Wal. 16.)

But assuming that the real object of the bill was to obtain an injunction, and that the complainants had a well-grounded belief that the defendants were deriving great profits from the alleged invention, it is clear that the case is the converse of *Marsh* v. *Seymour*, 93 U.S. In that case it was found that the infringing business was imprudently conducted, meaning, it is to be presumed, that the non-receipt of profits was attributable to the neglect of business or to competition with that of the complainant, thus causing a diminution of profit either on their own part or on that of the complainant. In the case at bar no such conditions were possible, and the master has found that the non-receipt of profits is not attributable to any fault on the part of the defendants. It will hereafter be shown that the mere fact that no profit has been derived from the invention is no reason for imposing damages, within the true intent and meaning of the statute; and that if a claim for profits is abandoned the jurisdiction to examine the question of damages is abandoned with it.

"Damages" is what the owner of a patent has lost in consequence of infringement. If they are proved, it may be said that the patentee is compensated for the damage done. But the law does not recognize a right of the patentee either to compensation or to profits when he has not lost anything and when the infringer has not made a prifit. (*Rude* v. *Westcott*, 130 U.S. 152.)

At best, the alleged damage in this case is a profit of three cents a pair, which the complainants might have made if the

defendants had agreed to pay it, and if they had made 41,297 pair of shoes.

The principal question is, then, whether the non-payment of a license fee which was sought from others but not from the defendants (except perhaps by the bill for an injunction) is an element of damages within the intent and meaning of section 4921 of the Revised Statutes. In all cases the question, *in what do damages consist?* is a question of law. And it is well settled that a court of equity is governed by the same evidence in respect to the competency of the evidence offered to prove damages as is a court of law. *Parks* v. *Booth*, 102 U.S. 96; *Philp* v. *Nock*, 17 Wal. 460; *Tees* v. *Huntington*, 23 How. 2, where it was held that counsel fees are not allowed as damages.

If it had not been for the fact that the old rule is supposed to have been abrogated by this Court, and that the weight of *authority* is against the defendants' position, I should hardly deem it necessary to ask the attention of the Court to the errors assigned on this part of the case.

In *Root* v. *Railway*, the bill was filed after the expiration of the patent, and prayed an injunction and an account of profits. The decision did not require a construction of that clause of section 4921 authorizing the Court to decree, in certain cases, "in addition to the profits to be accounted for, the damages." But it did require that certain antiquated errors should be corrected and a statement of the principles on which jurisdiction to decree profits in equity and damages at law depends.

The report discloses an important fact, decisive, as it seems to me, of the correctness of the appellants' position. The master finds that the defendants derived no gain or advantage from the alleged invention, and that they made every reasonable exertion to make a profit (pp. 11, 12, sec. 3). The master considered the fact material in respect to the question of damages.

Mr. Justice COLT holds, in substance, that the only ma-

teriality of this finding is to indicate that the complainants are, nevertheless, entitled to damages; because, prior to the act of 1870, there was a rule by which damages are to be proved by proof of a license fee in cases where the owner of the patent sought a profit by selling licenses; and that rule has been incorporated into the 4921st section of the Revised Statutes.

I apprehend that, although "damages," as used in the two sections cited, have the same signification, there is a distinctive difference in relation to the rights of parties dependent on the distinction between the forums and on the grounds on which a complainant is decreed to account for profits. The notion that the statute recognizes, in the same section, two classes of damages, one of which is by an equitable fiction called profits, is a fallacy, the avoidance of which will save a great deal of confusion.

The position of the defendants was and is based on the theory that, inasmuch as damages are not proved (unless evidence of an established license fee is proof of damages), the only form of decree appropriate to the case is that which recites the fact, or which is silent on that subject as well as in respect to the alleged profits. If the case had been brought under section 4917, the Court, according to the practice which prevails in the legal forum, might have ordered a verdict for nominal damages.

There seems, therefore, to be a singular mistake on page 67, either on the part of the typewriter or the printer, by which defendants' position is represented as exactly the opposite of that insisted upon.

It will be observed that the form of the third exception is based on an objection to the logic and law implied in the concluding statement of the master. If it be assumed that, by "this royalty," the master meant damages, the same objection applies; and, on either construction, the form of the exception denotes the exact distinction between the methods of administration which obtain

in cases arising under section 4921 and those arising under section 4917. It is obvious, therefore, that the word "only" before "nominal" should be read "not even." The reason for the position will, I apprehend, commend itself to the judgment of this Court.

Practically, of course, it is not material whether (if this Court finds that the defendants have infringed the patent) the form of the decree is for nominal damages, or whether it recites the fact, which is apparent, that no damages have been sustained; for both forms mean the same thing. (*Whitney* v. *Emmett*, 1 Bald. 133.)

I am aware that this Court has affirmed decrees for nominal damages, and that it has ordered such a decree to be entered where a decree for substantial damages was reversed. (*Garretson* v. *Clarke*, 111 U.S.; *Black* v. *Thorne*, ib.; *Rude* v. *Westcott*, 130 U.S. 152.) The mere matter of form does not appear to have been brought to the attention of the Court. But, inasmuch as this Court decided in *Root* v. *Railway* that it was no part of the intention of the act of 1870 to confuse the boundaries between the law and equity jurisdiction, it would be impossible to present the argument in behalf of the defendants by conceding that the decree should be for nominal damages.

There is another anomaly in the present case. The master alludes to what he calls the "infringing device" — that is, the single-gore attachment as in the "Packard Shoe, J.G." But it may be suggested that the Court had held that the patent covered an entire shoe, and not, as the master thinks, that the Packard patent infringes the Evory & Heston. It may be urged, therefore, that the complainants have waived an inquiry into the profits to which they are entitled, and that they are entitled to damages as a slight approximation to the great loss they have sustained.

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For this reason, among others, it becomes necessary to consider the case last mentioned somewhat more minutely than would otherwise be necessary.

It was urged by the able and learned counsel for the complainants in the Court below, and will be here, that "as prior to the act of 1870, the wrong-doer was liable for his profits, now, since that act, he should be liable in the damages expressly allowed by that act. Failing to show such profits, the complainant is entitled to recover damages." "There never was an intimation in any case that profits could not be recovered because complainants' particular business was not damaged."

It was also urged that "the infringement of complainant's rights is in itself an injury to complainants, and the measure of that injury is assuredly a matter of law, established by proof of liccense fees." For, it is said, the "owner of Letters Patent may choose to enjoy the rights secured to him in either of two different ways."

Walker on Patents, page 388, and *Seymour* v. *McCormick*, 16 How. 480, are cited in support of these propositions. But the case at bar is a suit in equity. The question is not whether the complainants could have got substantial damages at law, although I think it will very clearly appear that, on the authority of the famous case cited, and others to be considered, they would, in the legal forum, be entitled to a verdict for only nominal damages.

If it were true that this alleged licensing privilege is an estate granted by the government, and cognizable in the federal courts as something which might be infringed, still the fact remains that the complainants were not damaged in respect to that right (p. 14, sec. 6).

There is another fallacy in the position assumed by the complainants, and apparently approved by the Court below. They say, "It has never been intimated that profits could not be recovered because complainants' particular business was not damaged."

On the contrary, the law is, and always has been, that profits cannot be recovered at law. Profits are not damages or in the nature of damages, and are therefore recov-

erable only in equity. And as the Court can entertain an application for an injunction only during the term of the patent, it follows that profits cannot be allowed in any case after the patent has expired. (*Root* v. *Railway*.)

There are, undoubtedly, many cases in which juries have found that the damage or loss to the plaintiff in consequence of the infringement was equal to or exceeded the profit received by the defendant. But a moment's reflection is sufficient to show that evidence of the defendant's profits is of no consequence in a court of law, except with reference to the question what have the plaintiffs lost by the establishment of competing prices, or by some other artifice by which the market or the prices established by the patentee has been restricted or diminished? Nothing is better settled than the doctrine that *the statute* does not authorize a recovery of a defendant's profits, or the position that the plaintiff would have made them had it not been for the infringement. (*Whitney* v. *Emmett*, 1 Bald. 133; *Hogg* v. *Emerson*, 11 How. 580; *Seymour* v. *McCormick*, 16 How. 480; *Root* v. *Railway*; *Tilghman* v. *Proctor*, 125 U.S. 136).

In *Tilghman* v. *Proctor*, Mr. Justice GRAY, giving the opinion of the Court and restating with great clearness the principal doctrines of *Root* v. *Railway*, says, after having defined the meaning of "profit," "If there was no such advantage in the use of the defendant's invention, there can be no decree for profits, and the plaintiff's only remedy is by an action at law for damages."

Tilghman v. *Proctor* had not been decided at the time the case at bar was tried. I do not see how it is possible to resist the dictum of the Court above quoted, if the construction of the statute in *Root* v. *Railway* and the principles there established after a thorough sifting out of the errors of old cases, are to be accepted. But I think that the true meaning of the dictum is not ascertained except by assuming that it is to be limited to cases where, as here, profits were diligently pursued. For it seems to me that

although, as was observed in *Root* v. *Railway*, one of the provisions of the act of 1870 was borrowed from St. 21 Vic., its construction requires that the question of damages is to be considered *as supplementary;* and therefore that, if no profits are made, the only question remaining is to inquire whether the failure to get a profit was attributable to the defendant's fault or not. In other words, the statute was intended to supply the obvious defect in equity jurisdiction illustrated in *Livingstone* v. *Woodworth*, or *Dean* v. *Mason*, 15 How. 546, 20 How. 198. An owner of a patent has in equity a right to expect that, if infringer uses his patent at all, he shall use it to the best advantage possible. And that was what the defendant did.

If, therefore, as in the case at bar, it turns out that a defendant has discharged the equitable obligation which it was the design of the statute to recognize and protect, it follows that, in an action at law, a verdict of only nominal damages could be allowed; and that, in equity, the decree should declare the fact that no damages have been sustained by the complainants, or else be silent on the subject, as in *Tilghman* v. *Proctor*.

Any other construction would deprive the statute of its true intent and meaning as completely as if it were based on the errors of prior dicta and adjudication, instead of on a recognition of just and equitable principles and of *the law* as stated in cases like *Whitney* v. *Emmett*, and *Whittemore* v. *Cutter*, 1 Gal. 478.

What principles, then, were established in *Root* v. *Railway?* And is it not certain that some of the formal orders of this Court in other adjudications have involved a violation of those principles the assertion of which makes the case of rare importance and interest?

In the first place, it may be observed that, in the case cited, there are certain dicta which seem on first impression to suggest that profits are a legal measure of damages; that

is, that profits are recoverable at law. But these do not mean, as it seems to me, that, in actions at law, it is enough to show that the defendant has received a profit. That may be owing to superior facilities and enterprise in doing a business which he has no right to do, but which the owner of the patent, for want of such opportunities, could not do. The mere fact that the defendant has made a profit does not entitle the plaintiff to it in an action on the case; and the mere fact that a profit has not been made by the infringer does not entitle the owner of the patent to damages.

It is true that one of the causes of demurrer was that there was a plain, adequate, and complete remedy at law. But the opinion of the Court does not recognize a right to recover profits *as damages* after the patent has expired.

Prior to the exposition of the statute in *Root* v. *Railway*, profits had been spoken of in equity as "unliquidated damages;" it being assumed that, as damages might be recovered at law if proved, such part of the damages as consisted of the profits made by the defendant might be decreed in equity. (*Dean* v. *Mason*, 20 How. 357; *Silsby* v. *Foote*, ib.; *Perry* v. *Littlefield*, 21 Wal. 205.) And the idea prevailed that, by the fiction of converting a trespasser (who had been compelled to surrender a merely possessory title to the true owner) into a trustee, compensation might be allowed under the name of profits. Such notions involved a violation of the well settled principle that a plaintiff cannot prove damages by general evidence merely in the nature of conjecture or speculation.

But on the principles established in the great judgment above referred to, a court of equity does not hold an infringer as trustee *de son tort*, but merely borrows the rule in equity where an actual trustee has used his title for his own advantage. (Per GRAY, J., in *Tilghman* v. *Proctor*.)

It does not, therefore, decree profits *as damages*, or as compensation, which is merely another word for damages.

The infringer of a patent is liable for profits on the principle that he who is equitably entitled to an estate is entitled to the profits which would result from a prudent management of it; but a court of equity will not enforce this principle unless the bill is filed before the expiration of the patent. *The plaintiff in an action on the case is not entitled to profits, nor to damages if profits only* are proved. It is just as true that an infringer may make very large profits without causing damage to the owner of a patent, as that he make a very small profit and damage the owner of the patent to a large amount. The statute of 1870 was not based on the notion that the owner of a patent is entitled to recover, at his election, either profits or damages, but serves to make clear the law that a court of equity is the only forum in which profits may be recovered, and a court of law the only forum in which damages may be recovered.

It was not the intent of the statute to confuse the jurisdictions of law and equity or even the boundaries between them, either in practice or in principles. It is only by losing sight of the trespass that the Court can investigate the question of profits. If there have been no profits, the only question is, therefore, whether the fact is attributable to imprudence or negligence on the part of the defendants.

It is true that, under the British act 21 Vic., chapter 27, the complainant must elect whether he will take profits or damages (*De Vitre* v. *Betts*); but, under our act, the only right of the owner of a patent is to select his forum. If he selects the equity forum, his claim to damages is *supplementary* to a jurisdiction not given by statute; so that if there is no investigation of the claim for profits, there can be none for damages.

The court in equity exercises the power of a court at law in respect to damages only when fault or mismanagement is proved.

Although it cannot be true that *Root* v. *Railway* was dismissed because the complainants had a remedy at law for

the profits they prayed for; and although it is true that a correct analysis of the opinion necessarily proves that the owner of the patent never had a right at law to profits, and that they could not be proved as damages, it seems to me that the opinion must stand as holding there is no tribunal in which the owner of a patent *is entitled* to recover damage or profits. It follows from the reasoning of the Court in the case considered that, if the taking of an account be abandoned, the right to damages and to inquire about damages is abandoned also, and that no agreement can give jurisdiction to the Court in that particular. (*Birdsall* v. *Coolidge*, 93 U.S. 64; *Tilghman* v. *Proctor*, dicta above quoted.)

It is therefore wholly immaterial whether the patent in suit covers an entire shoe, or only a "gore flap," or a single gore arranged under the front part of the quarter as in the infringing exhibit. The statutory rule under section 4921 must be the same in all cases, whether they relate to an entire machine or only to what is called a combination. All patents are for combinations, and the extent of a patentee's rights depends on the state of the art. And the profits on an invention begin where the invention begins.

It may be more difficult, for instance, to ascertain the gain and advantage derived from a reaping machine with a raker's seat attachment than from the same machine without such attachment. But it seems to be too plain for argument that the equitable rights of the patentee in the case supposed differ, not in principle, but in extent only. Hence when the discrimination which the statute makes between the equitable rights to profits and the legal right to maintain an action on the case for damages is maintained, the primary source of the difficulty adverted to above is removed.

But it may be urged that, although principles insisted upon in behalf of the defendants are correct, they are applicable only where the owner of a patent has elected to maintain in

his own hands the monopoly of manufacturing and selling the thing patented; that they are not applicable where the proof is that he has made a business of selling, or trying to sell, licenses to others.

"In support of the complainant's views, it was urged that for the purpose of suits the ownership of the patent is the complainant's business, and the grant of licenses is his business; and any interference with ownership and its rights and appropriating the invention without paying for it is injury to that business and entitled to compensation."

Besides Walker on Patents, *Seymour* v. *McCormick*, 16 How. 480; *Philp* v. *Nock*, 17 Wal. 462; *Packet Co.* v. *Sickles*, 19 Wal. 611; *Berdell* v. *Denig*, 92 U.S. 716, were cited. The case last mentioned was supposed to support the proposition that "the law is well established that a complainant in equity can recover profits and damages. And in the absence of either, proof of the other is sufficient to entitle the complainant to compensation."

Most of these cases were considered in *Root* v. *Railway;* and in so far as they suggest anything contrary to the judgment or dicta in that remarkable case, they are, as I understand, virtually overruled. But as two or three subsequent cases might seem to imply a doubt whether this Court intended to recognize the view above presented, it is submitted that if the Court has power to recognize and apply the forms of practice and the principles of statute law which prevail in the legal forum, the complainants (in case infringement be proved) are entitled to a decree only for a nominal sum. From this point of view there can be no doubt, as it seems to me, that the opinion of the Court in *Root* v. *Railway* recognizes the law as laid down by Mr. Justice BALDWIN in *Whitney* v. *Emmett*, and by Mr. Justice STORY in *Whittemore* v. *Cutter*, 1 Gal. 429. The mere form denotes nothing even in actions on the case.

The opinion of the Court below adopts the very common

error of assuming that it is the function of the courts to find, if they can, "a rule of damages," even if it be extraneous to the business relations of the parties rather than actual damages; thus resolving the whole problem into the multiplication, by a license fee, of the number of infringing articles made, whenever it is shown that such fee had been established. The statute is very different now from what it was in 1793.

Undoubtedly that was considered a just and convenient method of disposing of cases during the barbarous age of the patent law in this country. But it has never been adopted by this Court. The apprehension that such a rule exists might imply that there are exceptions to it.

In the first place, a rule which would justify the owner of a patent in proving his dealings with others as a basis of damages is founded on a misconception of the changes which have been effected in the statute of patents since it was originally enacted.

The early acts of Congress which provided a remedy for the infringement of patents appear to have confused the distinction between damages and penalty. They were based on the idea that an infringer was an *offender* against the law as well as a trespasser on a property granted by the government. Thus by the original act of 1790 it was provided that the infringer should "forfeit and pay such damages as shall be assessed by a jury, and shall forfeit to the person aggrieved the thing made contrary to the true intent of this act, which may be recovered in an action on the case founded on this this act." (1790, sec. 4.)

This act was repealed in 1793, and was succeeded by an act the same in principle, but which provided that if any person should make, sell, or use a thing the exclusive right of which shall have been secured by patent, without the consent of the patentee in writing, every person so offending shall forfeit and pay to the patentee a sum equal to three

times that for which the patentee has usually licensed other persons to use the invention. (1793, sec. 5.)

This original notion that infringement is an offence against the statutes as well as, in substance, a trespass on the property of the patentee, is preserved in the statute of 1800, which provided that every person so offending shall forfeit and pay to the patentee a sum equal to three times the actual damage sustained, to be recovered by an action on the case founded on this and the above-mentioned act. (1800, sec. 3.)

If this act were to be construed literally, it would be impossible to hold that it was not a punitory act. For that reason it was construed strictly. The distinction between a penalty and damages was uniformly recognized by the courts, juries being instructed that it was their province to to find the actual damages and nothing more. The notion that infringement should be visited with a penalty did not commend itself to Judge STORY, or to Judge BALDWIN, or to any judge who has occcupied a seat on this bench.

Thus in 1813 Judge STORY charged a jury, in effect, that the law does not presume that a penalty is to follow proof of making, selling, or using without a written license. "In the absence of all other evidence, the law presumes a nominal damage." (*Whittemore* v. *Cutter*.) That has been the law ever since, whether a license fee is provable or not. (*Whitney* v. *Emmett*, 1 Bald. 133; *Seymour* v. *McCormick*, 16 How. 480; *Birdsall* v. *Coolidge*, 93 U.S. 64.)

Hence, when the statutes were revised in 1836, the notion that infringement was in the nature of an offence to be visited with a penalty did not reappear. On the contrary, the act recognizes only that a property right may be interfered with, and gives a right of action on the case for its infringement. But as the question is for the jury, the form of verdict is merely a matter of practice and regulated by the court.

The courts did not assume that damages had been sustained, and seek to find a measure of them. It was for the

jury to say whether actual damages had been sustained, but no assumption of anything more than nominal was allowable, nor was it allowed to conjecture or guess at damages.

Thus in *Whitney* v. *Emmett*, Mr. Justice BALDWIN says, "If you think the plaintiffs have made out their case you will find such damages as they have proved they have actually sustained. They must prove their damages; *if they have not done so you are not at liberty to supply the defect.*"

And Mr. Justice HOPKINSON says in the same case, "The act of congress gives the rule of damages . . . *Although no damages can be recovered by the provisions of the act of congress in a case where no damages have actually been sustained*, the patentee has nevertheless a remedy for the invasion of his right, peculiarly appropriate for such a case. He may have an injunction on the wrong-doer which will prevent the unauthorized use of his invention and put it in his power to compel the invader either to abandon it or make him a just compensation for the use of it. The Court would exercise this power to do what is right and equitable between the parties, and so as to prevent imposition and wrong by either."

For in 1819 congress had vested the circuit courts with power to take "original cognizance, as well in equity as at law, of all actions, suits, controversies, and cases arising under the statutes in relation to patents, and to grant injunctions according to the principles of equity to prevent the violation of the rights of inventors, secured to them by any law of the United States, that is, the right to manufacture, sell, or use.

This act was construed in *Sullivan* v. *Redfield*, 1 Paine, 441. In substance, it was re-enacted in 1836; and in 1870 the power to award damages, if any had been sustained, was also vested in the Court. But, as already shown, the addition of this power did not affect the right of a com-

plainant. It merely gave the Court a new power, without giving the parties alternative rights.

Now when the statute of 1793 was repealed, the principle that the owner of a patent has it in his power to fix his own measure of damages by granting a dozen or more licenses had been seen to be a bad one. For it might happen, as in the present case, that those who took a license would never manufacture under the patent; while one who had never heard of a license, and who had done business under color of his own title, and without the slightest injury to the patentee, might be held as an infringer.

The statute of 1800 was uniformly construed as limiting the power of the court to impose a penalty except in cases where damage was actually proved. Before the revision of 1836 was adopted there had been a radical change in the theory on which the prior statutes were enacted, and the notion that an infringer was an *offender* against the law was entirely eliminated. That is to say, a penalty was not to be inflicted except in malicious, aggravated, or wilful cases.

But after the act of 1836 was passed, the notion grew up, in spite of the opinion in *Whitney* v. *Emmett*, that a plaintiff was *entitled* to recover profits, and that such profits as could be proved were recoverable as damages at law. A great deal of confusion was occasioned because the distinction on which the right to profits rests was not stated. For more than forty years patents were infringed and licenses granted; but during all that time it was never heard that a license fee to others is a proper measure of damages in action on the case. Such evidence was regarded as all other evidence *inter alios* is regarded, and was never offered by a plaintiff from the date of the repeal of the act of 1793 until after counsel in their search for a rule of damages had misapprehended the dicta of the Court in *Seymour* v. *McCormick*, and *New York* v. *Ransom*, 23 How. 487.

If the right to license, which is, as it were, an appurte-

nance of the estate granted by the government, were an estate within the protection of the federal courts, that is, if it be an estate which by an election to do business under the patent could be acquired, or carry with it a right of the proprietor to fix his own measure of damages in suits against infringers, he has in substance revived the principle of the statute of 1793.

It is not surprising that, when counsel for both parties appeared to concede that Mr. Justice GRIER had discovered a new rule, the circuit courts should apply it, although, if the case be analyzed, it will be found that nothing was farther from the intent of that great judge than to suggest any rule of damages beyond the simple rule which had been acted upon for nearly half a century. And yet it is not doubted that, ever since the decision of the case cited, it has been the custom of circuit courts to admit evidence of a license fee to others, whether there be proof of actual damages or not.

If, then, the cases cited by the complainants be considered, it will be found that they tend to sustain the suggestion that it is not material to determine a criterion of damages, except possibly where there has been an agreement to pay a license fee which has been repudiated by the licensee, and that no case decided by this Court sanctions the doctrine that a fee which, if paid, is the complainant's profit, may be used to prove damages, or as a criterion of damages not otherwise proved. A review of the cases will, as it seems to me, demonstrate the error of the learned text writer above referred to, and therefore that of Mr. Justice COLT in this case.

Seymour v. *McCormick* is a case which was tried on the assumption that profits on an entire machine were the measure of damages in action on a patent which had been granted on a driver's seat affixed to a reaping machine covered (except the seat) by prior patents. The presiding judge charged that damages may be determined by ascertaining the profits which, in judgment of law, the plaintiff would have made,

provided the defendants had not interfered with his rights, and that no distinction exists in regard to the rule of damages between an infringement of an entire machine and an infringement of a mere improvement. Instructions were also given for ascertaining the net profit on each machine. By this process, it was said, the jury might approximate to something like the actual loss that the patentee sustains in a case where his right has been violated.

The action was tried on an allegation that a patent on a reaping machine furnished with a driver's chair was infringed. The question was not whether the statute authorized a recovery of the profits derived from the use of the chair as distinguished from those of the entire machine. Nor was there any occasion for this Court to lay down a measure of damages in an action on a patent for what is generally known as a "combination," as distinguished from an entire machine. It was merely held that the instructions given were erroneous; and in holding that the plaintiffs were not entitled to the profits of the entire machine, there is no implication that they were entitled to the profits which depended on the construction or use of the chair or to any part of it, or on the fact that the patentee had sought a profit by granting the defendant a license.

It appeared that the plaintiff sold exclusive licenses to the defendant *to make and vend* machines under three patents for thirty dollars for each machine, or an average of ten dollars for each patent. The defendants paid that price on several hundred machines, but refused to pay it on the last three hundred on the ground that the patent on the raker's seat was invalid.

Hence when the Court refers to a usual license the allusion was to one which had been established *by agreement with the plaintiff*. Besides the exclusive license to make and sell, the patentee exacted a license from the purchaser; but with that the defendants had nothing to do; and the Court expressly said that beyond *the refusal* of the defendant to pay

the plaintiff showed no actual damages. The argument of the Court is that the plaintiff, in an action of infringement, has no right to profits; and that, if he has agreed to take a license fee, the fact should prevent him from recovering any greater measure of damages than he has agreed to take. The Court does not say that the patentee has *a right* to elect whether he will maintain a monopoly or sell licenses, and if the latter, that the courts will make his own profit on a license the measure of damages against an infringer.

It was also suggested by the Court that where "the nature of the invention," as for instance a railroad turnout, is such that it cannot be manufactured and sold except on a special application for the use of the thing patented, a fee for the right to use would be the proper measure of damages. (*Vide Simpson* v. *West Chester Co.*, 4 How. 380, where, however, the question of damages did not arise.)

If the nature of a shoe were like that of a railroad turnout; that is, if it could not be manufactured and sold in the market, possibly some of the dicta of the Court in that case might be in point. Otherwise the only safe dictum applicable to a case like the present is that actual damages must be proved by evidence, and that if no proof be offered the defect cannot be supplied by proof of a criterion of damages adopted in other cases where damages were conceded or proved.

Philp v. *Nock*, 17 Wal. 460, is a singular example of the general misapprehension of counsel as to what was decided in *Seymour* v. *McCormick*. That was an action on the case on a patent for alleged improvement in inkstands.

The bill of exceptions showed that the plaintiff proved that the defendants had sold seventy-five dozen of the infringing article, and that the royalty which the plaintiff received was at the rate of two dollars per gross. The Court charged that "if they should find a verdict for the plaintiff they will give such sum as would remunerate him for the

loss sustained by the wrongful act of the defendants, and to reimburse him for all such expenditures as have necessarily been incurred by him in order to establish his right." The plaintiff had a verdict of $500.

In arguing the case before this Court, the counsel for plaintiff in error suggested in argument that all the injury proved was that the defendants withheld royalty to the amount of $12.50. The decision of this Court is, "that the instruction under consideration was too broad and too vague. The jury could hardly have doubted that it was their duty to allow the counsel fees paid or to be paid by the plaintiff, and perhaps other charges and expenditures equally inadmissible."

In the case cited, the evidence of a license fee to prove damages was offered by the complainants; it does not appear that objection was made, nor does it appear that, as in *Seymour* v. *McCormick*, a license fee had been repudiated on the ground of the invalidity of the patent. On first impression it might seem from the dicta of Mr. Justice SWAYNE, that the law furnished a test for finding actual damages, and that the Court is to find whether, on the facts of the case, the test exists. "Where the plaintiff has sought his profit in the form of a royalty paid by his licensees, and there are no peculiar circumstances in the case, the amount to be recovered will be regulated by that standard. If that test cannot be applied he will be entitled to an amount which will compensate him for the injury to which he has been subjected by the piracy."

Nevertheless it is equally true that the plaintiff *was entitled* only to a verdict of nominal damages unless actual damages were proved. The Court says that the plaintiff must prove damages, but does not overlook the distinction between proof of damages and proof of what has been received as a criterion of damages sustained. This distinction was alluded to in the request that the master should hold

that a license fee had not been "established within the meaning of the law."

It hardly need be said that the judgment of the Court below was reversed. But it does not appear that the evidence of a license fee was competent *to prove the damages*, without other proof that actual damages had been sustained.

The next case cited is *Packet Co.* v. *Sickles*, 19 Wal. This was originally an action on a contract held to be void by the statute of frauds. By leave of Court, the plaintiffs amended their declaration by an allegation that "the plaintiffs sue the defendants for money payable to the plaintiffs for the use of a certain apparatus;" and by another "that the plaintiffs sue for money received by the defendant for the plaintiffs. And the plaintiffs claim $25,000." The case was heard on the plea of non-assumpsit. Under the objection of the defendant, the plaintiff proved his special contract, how much fuel had been used by the apparatus, and how the defendant used it.

The defendant put in evidence the sales of licenses made by the plaintiff, ranging from $250 to $1500, and asked the Court to rule that the measure of damages was the established rule for the license to use the invention.

Now in a case like *Packet Co.* v. *Sickles*, "nothing can be more reasonable than that the price fixed by the patentee for the use of his invention in his dealings with others, and submitted to by them before using it, should govern." But there is nothing in the opinion of the Court indicating that evidence of the value is admissible on the ground that the patentee made it his business to seek a profit by the sale of licenses, or as tending to sustain the notion that there is any class of cases which, by reason of the fact that the patentees have elected to do a licensing business, furnish a legal test for computing damages in the sense the word is used in infringement cases. That was the rule under the original statute of 1793, and it was abrogated with the statute.

Mr. Justice MILLER argues that there is an analogy between the case and *Seymour* v. *McCormick*, and holds that the rule there adopted is applicable to the case. In both cases the evidence was offered *by the defendants*. In both cases the defendants had repudiated their agreement. The latter action was on an implied contract to pay what the invention was worth, while the former was an action of tort in which the Court had suggested that the defendant was not liable beyond what the plaintiff had agreed to accept, and which would have been the measure of damages if the contract for license were valid.

The next case cited by counsel for complainant is *Berdell* v. *Denig*, 92 U.S. 716, an action on the case for alleged infringement of Wilson's patent feeding device for sewing machines. Judgment for plaintiff was reversed.

It appears that evidence was given by the plaintiffs tending to show that they had advertised to sell their machines, and that they had sold a shop right to use one of them for $12.50, and another for $5, but that they afterwards refused to sell a license, and told defendants that they desired to retain the use of the machine as a close monopoly. They asked the Court to instruct the jury that "this testimony was not sufficient to change the rule of damages from the profits which the plaintiffs would have made if they had not been embarrassed by the interference of the defendants, to a mere license price."

The defendant made no objection to evidence that one license had been sold for $12.50 and another for $5. It was expressly proved that the plaintiffs had no fixed license price and that they refused to grant any other licenses. And that seems to have been thought by them a good reason for being allowed to recover "the profits which the plaintiffs would have made if they had not been embarrassed by the interference of the defendants."

Now, in holding that this request was properly refused, this Court held that the defendant's profits on that part of

the machine which consisted in the Wilson feeding device were recoverable only in equity. "It cannot be admitted," says Mr. Justice MILLER, "that, in an action at law, the profits which the other party might have made is the primary or controlling measure." "We have repeatedly held that sales of licenses of machines constitute the primary and true criterion of damages in the action at law." In all those cases, however, it has also been held that the rule established in the early cases is not changed, even if a license be proved. (*Birdsall* v. *Coolidge*, 93 U.S. 64.)

And again it is said, "In the absence of satisfactory evidence of either class [that is, of profits or damages] in the forum to which it is most appropriate, the other may be resorted to as one of the elements on which the damages or the compensation may be ascertained."

I understand this to mean that, in an action at law, the evidence of the defendant's profits may be received, not because the plaintiff is entitled to them, but for the purpose of testing the question whether he has lost anything. On the other hand, in equity the plaintiff is entitled to whatever profit the defendant's accounts show has been derived from the infringing business. If there be proof that the want of profit is owing to mismanagement, imprudence, negligence, or trick of any kind, that is an element of damage and may be proved.

The next case which came before this Court is *Birdsall* v. *Coolidge*, which was tried in the Court below on the assumption by both parties that evidence of a license fee to others is proof of damages. The action was against the *user* of twenty patented mining pans which had been purchased by the defendant from some one supposed to have a good title.

The infringement being proved, the plaintiff offered evidence of an established license fee. From the bill of exceptions it seems that the defendants conceded that an

established license might be proved, and that it thereon became incumbent on them to show that damages, estimated on that basis, would greatly exceed the actual damages sustained. Accordingly they proved that the invention was of little or no use to them, and that it was taken off of sixteen pans and sold for old iron. They also proved that none of the patented pans had been used more than six weeks.

In the Court below the charge was identical with the doctrine of Mr. Walker, and with that of Mr. Justice COLT in the case at bar. "When a person without license appropriates the patented invention of another, the measure of damages, if a royalty has been established, is the regular royalty paid by purchasers and licensees; if the jury find find for the plaintiff, the damages will be the royalty which the plaintiff established for that part of the invention used by the defendants; if the royalty was $100 on each pan, then the jury will allow that sum on the pans used." Accordingly the jury found damages amounting to $2000 and interest thereon.

In the opinion reversing a judgment on the verdict, Mr. Justice CLIFFORD states that the old rule "remains unchanged to the present time," and that the verdict of the jury must be for the actual damages sustained by the plaintiff. But there is no suggestion in the opinion as to what the damage was, or how it should be ascertained.

The principle of the case is, as it seems to me, that the mere fact that a patentee has elected to license others to manufacture and sell is of no consequence until it has been shown that the alleged damage consists in something besides the loss of a license fee. That is not *damages* within the meaning of the word as used in the statute of patents. Something else, therefore, must be proved, even in actions at law, to justify evidence of dealings with others as a standard by which damages may be estimated. And there must be reason to believe from the evidence, or the conces-

sion of a defendant, that the actual damages are equal to a license fee before evidence of a license fee to others is competent to measure them. (*Rude* v. *Westcott.*)

Mr. Justice CLIFFORD also said, "Evidence of an established royalty will undoubtedly furnish the true measure of damages in an action at law where the unlawful acts consist in making and selling the patented improvement, or in the extensive and protracted use of the same without palliation or excuse; but where the use is a limited one and for a brief period it is error to apply that rule arbitrarily and without qualification."

It is not perceived that there is anything in these dicta indicating that, if the plaintiff has an established license fee, he may prove it and compel the defendant to show that the complainant's damages were not equal to the license fee, for the old rule is unchanged.

Nevertheless it would seem that a contrary notion has prevailed, and that it depends on the dicta of the Court in *Seymour* v. *McCormick*, which, according to the analysis above presented, establishes the principle that a defendant cannot be called upon to rebut a presumption of damages. This leads to a consideration of the case of *Clark* v. *Wooster*, 119 U.S.

The third point of the appellant was that the Court erred in finding that the measure of damages was an established license fee, and that such license fee was proved. The argument of counsel virtually conceded that damages had been sustained, and was aimed to show nothing beyond the *insufficiency* of the evidence in support of the complainant's position that the evidence was sufficient. No objection to the *competency* of the evidence or to its applicability to the case was made, and none was considered by the Court. It was admitted that there were damages which might be measured by a license fee of ten cents if only the *establishment*

of such a fee were proved. The only question considered was one of fact.

Mr. Justice BRADLEY, giving the opinion of the Court, says, "The third point, as to the measure of damages and the want of proof thereof, is untenable. It is a general rule in patent causes that established license fees are the best measure of damages that can be used. There may be damages beyond this, such as the expense and trouble the plaintiff has been put to by the defendant, but these are more properly the subjects of allowance by the Court under the authority given it to increase the damages. As to the sufficiency of the proof we see no occasion to disturb the conclusion reached by the master on this point. . . . We think that the defendants have no occasion to complain of the amount awarded."

Inasmuch as it is well settled that the question of how much damages have been actually sustained is a question of fact, I do not understand the Court to mean that there is a general rule *of law* which governs this class of cases.

It seems to me, therefore, that the dicta first mentioned have reference to those cases which led to the extension of the powers of the courts of equity, or to the experience of presiding judges in subsequent cases where it did not appear that the infringement was prosecuted with diligence and for the purpose which the owner of the patent may be presumed to have had in view when he exercises his right expressly granted.

The reasons why the defendants in that case have no occasion to complain of the amount awarded are not given. But, referring to the record of the case, it will be seen that the evidence tended to show that the business of the defendants was the sale of sewing machines, which they received from the Gold Medal Sewing Machine Company, and that they made a profit by increasing the number of machines sold, or the price by furnishing a binder as a part of their equipment.

But the parties, for the purpose of saving the expense of further investigation, agreed that 15,000 guides had been purchased and disposed of; and in consideration thereof complainant waived all further examination in relation to profits, relying "upon such proof of damages as he is able to show in place of profits."

Here, then was a case in which the defence in the Court below assumed that a reissue could be set aside without putting it in evidence, and the equally extraordinary proposion that when you come to the question of damages, the Court is sitting as if at law; that actual damages are to be presumed; that the complainant may measure them by evidence *inter alios;* and that, as the complainants sought their profits by the sale of licenses, the burden of proof was on the defendants to show that the damage sustained by the complainants was less than a license fee.

Divesting the agreement from the errors of law with which it bristles, it amounts to nothing more than an agreement that a decree might be entered for a sum equal *to the defendant's* profit on 15,000 binders, estimated to be at least ten cents on each binder.

But on the principles stated in *Root* v. *Railway*, the agreement broadly construed was fatal to the complainants' claim for damages under the section investing the Court with a certain power to decree damages in addition to profits, and which therefore is limited to cases where the usurped power of the infringer has been abused. For, as already seen, the Court held that though, under the British act, the complainant may elect whether he will have an account of profits or an inquiry as to damages, "it is manifest that the recovery of profits is not intended to be double, but that, *when necessary, the damages are to supplement that loss of the complainant which the profits found to have been received are insufficient to compensate.*"

No language could more aptly describe the limitation of the power of the Court to cases where it appears that the

non-receipt of profits is attributable to the fault of the defendants in the management of the infringing business.

And this view of the law is, as above suggested, recognized and applied in the next case which came before the Court, *Tilghman* v. *Proctor*.

In that case the report of the master was based on the opinion that damages are to be computed on the basis of a license fee, and that they are to be added to the profits, which were found to be $129,000. On exceptions the Court held that, having sought a profit by licenses, damages was all the complainant was entitled to, and entered a decree for damages only. Both parties appealed to this Court. The adjudication was that it was error to decree damages, and that the account of profits was incorrect.

It seems to be very clear that the defendants were not charged with profits on the theory that profits were in the nature of damages or "unliquidated damages;" or that complainants would have made the whole or a part of the defendants' profits if their rights had not been infringed.

It is equally clear, as it seems to me, that the reason why the defendants were not charged with damages is that the facts showed the defendants had prosecuted the infringing business with diligence and for the sole purpose of getting as much profit as they could. The profits reported by the master were more than doubled by the order of this Court, but not on the principle that the complainant was entitled to anything *as compensation*. On the contrary, is it not plain that the doctrine of compensation has no place in equity, except with reference to the question whether it was the defendant's fault that he did not make more?

Assuming that the jurisdiction in respect to damages is to be determined by a consideration of the class of cases which gave rise to it, I submit that the dictum that "if there was no advantage in the use of the invention, there can be no decree for profits, and the plaintiffs' remedy is by an

action at law for damages," correctly states the true meaning of the clause authorizing the Court to decree "in addition to the profits, the damages."

The next case is *Rude* v. *Westcott*, 130 U.S. 152, which was a bill for the infringement of two patents for improvements in seeding machines.

It appeared from the report "that the complainants waived all claim for profits and relied on the proofs produced as establishing a fixed license fee or royalty as the measure of damages." It does not appear that the defendants denied and that they had made a profit on the machines made and sold by them.

The master reported that, although several licensees had paid a license of one dollar for one-horse machines and of two dollars for two-horse machines, it was difficult to say whether a license fee was established or not; but as the defendant had made eight hundred one-horse and sixteen hundred two-horse machines, the damage, on the basis of the fee, was $2400.

The Court, being of opinion that further evidence was necessary, recommitted the report with instructions to admit further evidence as to damages, and to report the same with his conclusions of law.

The master then made a second report, in which he stated that the new evidence did not strengthen the proof that the complainants had an established royalty fee; but he found that the defendants in eleven years had put on the market about 2000 drills, one half of one-horse and the other of two-horse. He then considered the value of the claim of the patent to the defendants; that some manufacturers had paid a stipulated license, and afterwards said that it was worth little or nothing; that values were estimated from nothing to six dollars per drill. He therefore reported that complainants were entitled to seventy-five cents on 1000 one-horse drills and $1.50 on 1000 two-horse drills, making in all $2250.

The Court decreed that the complainants recover $1800 as damages. On appeal the decree was reversed, with directions to enter a decree for nominal damages.

The owner of the patents had not manufactured the drill described. There was no proof that he had lost anything in consequence of the infringement; and unless he had lost something there was no damage to be measured.

The case appears to have been tried without any objection to the proposition that proof of an established license fee is proof of damages; the only argument being as to the sufficiency of the evidence that a license fee had been established. This Court, after citing some of the cases above considered, says, "In order that a royalty fee may be accepted as a measure of damages against an infringer who is a stranger to the license establishing it, it must be paid or secured before the infringement complained of; it must be paid by such a number of persons as to indicate a general acquiescence in its reasonableness by those who have occasion to use the invention. Tested by these conditions, the sums paid in the instances mentioned cannot be regarded as evidence of the value to the defendants of the invention patented."

But the Court was not called upon to decide, and did not decide, that it was competent for the Court below to decree damages when it is impossible to determine that the non-receipt of profits was attributable to the fault of the defendants.

No authority is cited in support of the tests alluded to by the Court, and it is believed that none can be. Is the question whether D has been damaged when A has paid one dollar, B two dollars, and C three, any more speculative or conjectural than when it has been proved that all who have paid anything have paid three cents?

All such decisions seem to indicate that the circuit courts restrict the rule which is supposed to have been established by Mr. Justice GRIER. The truth is, I submit, there is no

such rule; and no cases which have come here based on the assumption that damages in equity may be assumed are of authority in support of Walker's view of the law, because the complainants are entitled to *legal* damages only in a legal forum. In that forum is there any principle of law on which the plaintiff would be entitled to damages, in an action of tort, *on account of the loss of a license fee* even if the defendant had agreed to pay it? Is not his only remedy assumpsit in the state courts, unless jurisdiction can be obtained in the federal courts on an allegation of citizenship, as suggested in *Root* v. *Railway?*

If it could be admitted that the owner of a patent *is entitled* to recover defendant's profit in an action at law, there would be reason in the theory that he is entitled to show, in an action of tort, how he made his profits; and in such a case a finding (like that of the master) that his licensing business was not damaged might be material.

I think, therefore, that there is nothing in the dicta of *Rude* v. *Westcott* which ought to oppose the doctrines or the result of the doctrines stated in *Root* v. *Railway* and *Tilghman* v. *Proctor*. It is more important to observe that the Court also said, "There was no question in this case of damages arising from lost sales or injurious competition, for no machines had been manufactured and put on the market by the patentee or his assignees." In a such case there can be no damages if the infringer has not abused his power.

If it be true that the statute was not intended to confuse the distinction between the legal and the equity jurisdiction, it seems to me, for reasons already sufficiently explained, that the conclusion should have been that the complainants had not proved damages, and an order entered that the final decree should be reversed.

The case at bar is like *Rude* v. *Westcott* only in respect to the fact that there was no proof of damages in the sense in which the word damages is used in the statute. In the present case the evidence of a license fee was persistently

objected to, and there is no ground whatever for any suggestion that the complainants waived a claim for the profits of the defendants.

In *Cornely* v. *Marckwald*, 131 U.S. 159, the master reported that the defendant had made a profit of $142.92 on the sale of twenty-six machines, and that he was not a wilful and deliberate infringer. The defendant also claimed damages based on payment of $50 for the compromise of several suits. The master also reported that the plaintiff claimed that he had been forced to lower his prices to compete with the defendant, and that there was no evidence in support of this claim; that as to damages from the loss of the sales made by the defendant, it did not appear what profits the plaintiff made on his machines, or what it cost to make them (which is the case here), and therefore that such damages could not be computed as exceeding the nominal sum of six cents. The plaintiff appealed from so much of the decree as awarded to him no damages beyond the six cents.

This case appears to have been tried on the assumption that it was for the master to find whether the evidence of the complainant's transactions with others is *sufficient* to show that a fixed rate of license fee has been established. The Court held that a uniform sum paid in the settlement of ten law suits was incompetent to establish a price as for a fixed royalty, and decreed the profits and a nominal damage of six cents; and this decree was affirmed.

The master and Court below in the case cited appear to have adopted the belief that, if it had been shown that the complainant had issued licenses to others than the defendants in infringment suits and that he was willing to license at the same price all who wished to use the invention, it would have justified a conclusion that damages might be ascertained by multiplying the established fee by the number of machines made. The theory of the appellant was that he should receive *in addition* to $142 profits of the defendant,

the $1500 profits which he (the complainant) would have made if the defendant had taken a license to make twenty-six machines. The *form* of the decree ordered by this Court appears to involve principles repugnant to those asserted in *Root* v. *Railway* and *Tilghman* v. *Proctor*.

In view of what has been said, it submitted that there is nothing in the adjudications of this Court which supports the decree of the Court below; and that, the defendants are entitled to a dismissal of the bill and to full costs.

GEORGE D. NOYES,
Counsel for Appellants.

Supreme Court of the United States,

OCTOBER TERM, 1889.

JOHN W. BURT ET AL.,
Appellants,

AGAINST

ALEXANDER F. EVORY ET AL.,
Appellees.

No. 164.

BRIEF ON BEHALF OF APPELLEES.

Statement.

This suit was brought to restrain infringement of Letters Patent granted to the complainants Evory and Heston for Improvements in Boots and Shoes, dated November 6th, 1866, No. 59,375.

The bill of complaint (Record, pp. 1–5) is in the usual form, and alleges the grant of the patent, title of the complaints, and infringement by defendants by reason of defendants "having made and sold shoes or gaiters constructed in accordance with the description and drawings of Letters Patent granted to the defendant Frederick Packard, dated June 18th, 1878, No. 275,129, and also other shoes and gaiters."

The answer (pp. 5–6) admits the grant of the Evory

and Heston patent, denies the novelty of the invention by reason of the existence of British Letters Patent No. 1954, of 1860, and No. 185, of 1856, and admits that the respondents have made and sold shoes or gaiters constructed according to the invention shown and described in Letters Patent of the United States granted to Fred. Packard, June 18, 1878, No. 275,129 (f. 8), but denies that the making and vending of such shoes constitutes an infringement.

Replication was filed February 25th, 1881 (f. 10).

Proofs were taken at some length, and the cause was heard before his Honor Judge LOWELL, and an opinion rendered sustaining the novelty of the invention and decreeing that the Packard shoes were an infringement (R., p. 65–67).

A decree for an injunction and for an account of profit and assessment of damages, was rendered February 3, 1883 (R., pp. 7; f. 11–12).

Henry L. Hallett, Esq., was appointed Master (f. 11).

The case proceeded before the Master, and on July 25th, 1884, a draft report was rendered by the Master, finding that the defendants had made and sold forty-eight thousand pairs infringing shoes; that complainants had an established royalty of three cents a pair for the patented shoes, and that this royalty was a fixed one, and was paid by the licensees; and that the amount of damages to be assessed was, at that rate, $1,440 (R., pp. 10–11).

Exceptions were filed to the draft report by both parties (p 11–12).

Defendants were permitted to amend their account and reduce the number of infringing shoes to forty-one thousand two hundred and ninety-seven (p. 14, f. 21).

Both parties filed exceptions to the final report (p. 21).

As the complainants have not appealed, it is unnecessary to consider their exceptions.

The exceptions of defendants were three in number, and were to the effect that the evidence as to a license fee was insufficient.

Under a practice which obtains in the Massachusetts District, the Master did not file with his report *all* the evidence which had been taken before him, but only certain portions and certain particular questions and answers.

On hearing of exceptions before the Court, the Court rendered an opinion (COLT, J.) confirming the Master's Report (p. 67).

A final decree was thereupon entered (p. 23) for the sum of $1,238.91, damages, and the cost of this suit.

From this decree an appeal was taken (p. 67–70).

The Adjudications upon the Patent.

The Evory and Heston Patent has been the subject of considerable litigation, and in two cases opinions have been rendered sustaining its validity.

The opinion in *Evory* vs. *Candee*, 2 Fed. Rep., 542, was rendered by his Honor Judge SHIPMAN, in the District of Connecticut, and was as follows:

" SHIPMAN, D. J.: This is a bill in equity to restrain " the alleged infringement of letters patent granted to " Evory and Heston on November 6, 1866, for an improve- " ment in shoes. The National Rubber Company is " an exclusive licensee to use the patent in the manu- " facture of rubber boots and shoes. The invention " consisted in a double extension gore-flap upon each " side of the shoe, the external fold of which flap is at- " tached to and in front of the quarter, and the inter- " nal fold of which is attached to the rear of the vamp. " The gores are folded outside of the shoe proper, and " forward over the instep, so that the ankle and foot " are inclosed by the shoe proper. The claim is as " follows: 'A shoe, when constructed with an expan- " sion gore-flap, C, D, the external fold, C, of which is

" attached to and in front of the quarter, B, and the " internal fold, D, of which is attached to and in rear " of the vamp, A; the said several parts and pieces " being respectively constructed, and the whole ar- " ranged for use, substantially in the manner and for " the purpose set forth.'

" The material point of difference between this shoe " and the one shown in the English patent of Steven " Norris consists in the fact that the Norris' gore folds " within the shoe, while the gores of the plaintiff's " patent fold outside the shoe. If the gore of the " English shoe is made of stiff leather, there is a stiff " crease on each side of the shoe which hurts the foot. " If the gore is made of thin and pliable leather, the " folds are apt to wrinkle and to become easily displaced " when the shoe is worn. The plaintiff's shoe avoids " both difficulties.

" The novelty of the patented device is not denied. " The Norris' and the defendant's shoes are described in " the opinion in the case of Williams and The National " Rubber Co. vs. L. Candee & Co., which has just been " decided. In the defendant's shoe the foot is incased " by the vamp and that part of the quarter which is " behind the hinge of the fold at the ankle, and the " jointed flaps, or the earpieces, fold without the shoe " proper.

" It is claimed by the defendants that there is no " infringement because their shoe is the Norris shoe. " In the Norris shoe the sides of the quarter come for- " ward and are buckled or fastened over the instep, " covering the fold made in the gusset, while in the " Evory & Heston the quarter comes only to the front " line of the heel covering, and the fastening is made " by uniting the two gussets folded outside of the shoe. " In the defendant's shoe that part of the quarter which " serves as a support and protection for the foot is the " Evory & Heston quarter. That part of the quarter " which is forward of the hinge, or the fold in the

" quarter, is folded with the vamp extension outside of " the shoe proper. There is no substantial difference " in the manner in which the extensions are folded in " the respective shoes. The confusion, if there be any, " consists in the fact that the Evory & Heston quarter " is a narrow one, extending a little beyond the ankle " joint, and the gores are hinged at the ankle-seam. " The defendant's quarter is a wide one, and the vamp " extension and the front part of the quarter fold upon " each other and swing forward outside of the shoe " proper at about the same point at which the Evory & " Heston gores are hinged.

" In addition to the evidence derived from the " manner of construction of the respective shoes, the " defendants had taken a license in the year 1877, from " Evory & Heston, and had displayed in their trade " circular for that year pictures of the shoes which they " then manufactured, and which they are still manufac- " turing, and which they then represented to be made " under the Evory & Heston patent. That was un- " doubtedly their opinion at that time, and I do not " think that they were mistaken. Infringement is " clearly proven.

" Let there be a decree in the usual form for an in- " junction and an accounting."

The opinion in the present case was by his Honor Judge LOWELL, and is found at pages 65 to 67 of the transcript of record.

That the opinions of Judge SHIPMAN and Judge LOWELL were correct will, we think, be demonstrated by the following considerations.

FIRST POINT.

The Nature of the Invention.

All shoes are coverings for the feet, and the merit of any particular shoe must lie either in the nicety of its fit, the perfection of the protection it affords, or ease of adjustment.

All the qualities are dependent (aside from mere changes of material), upon the cut or shape of the different parts.

As soon, therefore, as we admit—as must be admitted—that shoes are patentable at all, then all patentable improvements must be improvements in the cut or arrangement of the different parts, as conducing to one or more of the ends above stated. That shoes and other articles of clothing are patentable is settled by long practice, and by numerous adjudicated cases relating to such articles. The defendants, themselves, as we shall see, have patented their shoe, and their patent is a subordinate one to that of plaintiff's.

The changes introduced by the plaintiff, apparently slight in themselves, are yet important as adapting the shoes to a proper fulfillment of their uses, and hence are properly deserving of protection.

Emerson vs. Howe, 8 Fed. Rep., 327.

All shoes consist of three main parts, which together constitute the complete covering for the foot.

These three parts are: 1, the sole; 2, the quarter; 3, The vamp.

The functions of these three parts are well known. Their shape or cut and their arrangement with reference to each other and the mode of attaching or fastening them together, are the things which determine the excellence or want of excellence of any given shoe.

The patented shoe of Evory & Heston is an improved

form of shoe designed to provide advantages of all of the kinds enumerated.

The patentees state in their preamble that:

> "Our said invention consists in a novel mode of "constructing shoes and gaiters, whereby the "ordinary elastic goring at the sides, and the "tedious lacing up at the front are both dispensed "with, while at the same time the tops will expand "to receive the foot, and fit neatly and closely "around the ankle when the shoe is on, being also "water-tight to the extreme top of the shoe."

The patentees in this case apparently live at La Porte, Indiana, and the desirability of a strong, serviceable, water-tight shoe, which also fitted well, had doubtless made itself known to them.

There were three objections they wished to overcome.

(1) The "elastic goring" was to be dispensed with. No shoe provided with it at the ankle is water-tight. Such goring is also, as is well known, of comparatively little durability.

(2) "Tedious lacing" was to be dispensed with. It made the shoe fit well, but it required time and labor to adjust it. The fastenings of the improved shoe must therefore be substantially at a single point, and one where force could be applied *to make the shoe fit properly the ankle.*

(3) The expansion of the shoe to admit the foot was to be in front; "flaps or gores" at the heel were to be dispensed with.

The Heston & Evory shoe supplied all these wants. The patentees constructed a shoe with sole, vamp and quarter.

These were to be made to fit the foot, and though

the best fitting shoe is necessarily somewhat loose below the ankle bone *(Brevoort, p. 51)*, yet they were, as far as possible, to "fit neatly and closely round the ankle."

So far as this can be done by forming the parts it is accomplished in the art of shoemaking by constructing a "last" in accordance with the measurements from the foot, or where shoes are made in quantities by adopting an ideal last and then fitting the parts of the shoe neatly and closely over the last.

The parts which come in contact with the last, and hence with the foot form the true foot covering or shoe proper *(Brevoort, p. 51)*.

The "shoe proper" being formed, some means for connecting the parts together were to be provided, which means should have the following requisites which characterize the Evory & Heston invention.

(*a*) They should permit the expansion of the top in front to insert the foot. This would accomplish the function of the "elastic goring," but

(*b*) They should be of material similar to that of the shoe itself, so as to exclude water better than the displaced "elastic goring."

(*c*) They should be so located, with reference to the parts of the "shoe proper," as to not interfere with the fitting "neatly and closely around the ankle."

(*d*) The fastening should be substantially at a single point, and thus avoid "tedious lacing."

The means of connecting the vamp and quarter together so as to accomplish all these objects was by adding to the "shoe proper" an addition or extension of the parts which came in contact with the "last," forming "a double extension gore upon each side of the shoe, which readily expands to admit the foot, and which may then be folded forward over the instep, and be secured by a buckle or knot or suitable lacing, as desired."

This "expansion gore" or "expansion gore flap,"

as it is also called, consists of triangular extensions of or additions to the vamp and quarter, and outside of both, the fastening being at the points of these triangular flaps.

By these means all the desired objects were secured.

(a) The shoe expands at the top and in front by the enlargement made by the flaps.

(b) The flaps can be of the same material as the shoe, and equally water tight, because their expansion depends not on the elasticity of the material, but upon the unfolding of the flaps.

(c) The flaps do not interfere with the shoe, being constructed to fit neatly and closely, for they are applied outside of the vamp and quarters, after they (the vamp and quarter) have been fitted to the last. And

(*d*) Tedious lacing is dispensed with, and the close fitting of the shoe assured, by the parts being drawn together and fastened at the point of the flaps.

It would seem, of course, that the flaps might be folded either forward over the instep or backward over the heel without material variation *(Brevoort, p. 30, Q. 26)*.

The claim of the patent sums up these features of construction.

"What we claim and desire to secure as our invention, and desire to secure by our letters patent, is:

"A shoe, when constructed with an expansion gore "flap C, D, the external fold C, of which is attached "to and in front of the quarter B, and the internal "fold D, of which is attached to and in the rear of the "vamp A. The said several parts being respectively "constructed, and the whole arranged for use, sub-"stantially in the manner and for the purpose set "forth."

This is a claim for a shoe having on each side an expansion gore flap of substantially the shape indicated,

practically, closing the opening, and thus water-proof, and arranged *outside of the shoe*, so that the parts of the *shoe proper* may fit neatly and closely, the fastening being substantially at a single point, which also contributes to such fitting.

It is true that the claim does not, in words, say that the "gore flaps" are to be outside the shoe, but that is the only position and arrangement shown; it is the only one which would not interfere with the fitting, and it is the only one which answers to the "manner and for the purposes set forth."

Treadwell vs. Parrott, 5th Blatch., 369, 373.

Mr. Brevoort, the complainant's expert, concisely but clearly points out the distinguishing features of the Evory & Heston shoe, as above set forth *(Brevoort*, pp. 24 & 50).

That this invention is useful is attested by the patent; by the adoption of the invention by others *(Evory* vs. *Candee & Co.*, 2 Fed. Rep., 542), by proof of use by a number of licensees, and, if the infringement is made out, by its appropriation by the defendants themselves.

SECOND POINT.

The Infringement by the Defendants.

It is plain that the defendants infringe the claim of the Evory & Heston patent.

Their answer, admitting the charge of the bill, avows that they have made and sold shoes constructed in accordance with the patent of Frederic Packard, dated

June 18, 1878, and the specimen of their shoes introduced in evidence (Exhibit Packard Shoe, p. 30) and proved to have been made by them (Crocker, p. 32) is clearly made under that patent.

Mr. Brevoort, on behalf of the complainant, proves conclusively that the shoe above described in the Packard patent, and the Exhibit Packard Shoe, embody the invention of Evory & Heston (Brevoort, p. 24, Q. 3, and p. 50, Q. 7).

An inspection of the defendant's patent and their shoe, "Exhibit Packard Shoe," made under it, confirms Mr. Brevoort's statements.

(*a*) The Packard shoe consists of a shoe proper made of three pieces, sole, vamp and quarter.

(*b*) It dispenses with "elastic goring."

(*c*) It is provided at each side with expansible flaps formed of a triangular addition to the rear of the vamp, and a triangular extension of the quarter.

(*d*) The shoe expands at the top and in front by the enlargement made by these flaps.

(*e*) The flaps are of leather, and, as far as they extend, are as watertight as the shoe.

The defendant's patent expressly says: "It (the "wing, or flap) will prevent sand or dirt from working "its way into the shoe, and effectually excludes snow "and water."

(*f*) The flaps are arranged to fold outside the shoe proper, and do not interfere with the fit at the ankle.

The defendant's patent says:

"The wings or flaps are folded *externally* over the "tongue piece from the lower portion of the slots on "each side, thus bringing the laps outside, and leaving "no projecting portions inside to hurt the foot."

(*g*) Tedious lacing is dispensed with and the fastening is substantially at a single point. This is obvious.

But the defendants urge that their shoe does not infringe for several reasons:

(*1*) Their expert, Spencer, denies that the Packard shoe has "gore flaps," and calls the "wings or flaps" of their patent a "stay piece" (p. 35).

Names, however, are quite immaterial.

(*2*) He says that their shoe "has no gore running to "the tops of the front and back part of the shoe so as "to keep out dirt and water" (p. 35).

It is, indeed, true, that the defendants' flap, owing to the "slot" in it, does not extend in a waterproof condition as high as the plaintiff's. But this is a mere question of degree. It is evident on inspection that the "gore," "flap" or "wing" will exclude dirt and water from the shoe as far up as it does extend, and will so exclude more than would be excluded if the "gore" was absent.

The defendants' patent indeed claims the exclusion of dirt and water as one of the features of his shoe. It says:

"It will prevent sand and dirt from working its way "into the shoe, and effectually excludes snow and "water."

On cross-examination even the defendants' expert has to admit that the fact that a gore or flap is lower than the parts of the shoe proper does not take the shoe out of the complainant's patent (Spencer, p. 44, Qs. 30–31).

Mr. Brevoort's evidence on this point of difference between the Packard and Evory & Heston shoes clearly shows that the lowering of or the presence of a slot in the gore does not enable the defendants to escape the charge of infringement (Brevoort, p. 25 and p. 52, Q. 11).

(*3*) Again it is claimed that the defendants' shoe does not infringe, because it has no device "serving to enlarge the opening for the insertion of the foot," but on the contrary has a "stay piece" "serving to limit the opening."

This objection is founded upon a misconception or misstatement of the function of the "extension gores" of the Evory & Heston shoe.

The Evory & Heston's gores do not "serve to enlarge the opening" of the shoe, except in the sense that they permit the shoe to be opened further at the top than would be the case, if there were no cuts at all in the sides of the shoe, or if the vamp and quarter were sewed rigidly together to their tops. In fact the Evory & Heston gores restrict the opening, just as elastic gores would, so that the shoe will not open as far as it would if there was an opening between the vamp and quarter with nothing to occupy the space.

The defendants' gore, or flap, or wing acts in precisely the same way. It permits the shoe to open at the top for the insertion of the foot just to the extent of the material of the flap, and as the vamp or tongue is the flexible portion of the shoe proper. It is clear on inspection that the Packard shoe opens forward, precisely as Evory & Heston's does, as distinguished from opening at the heel (Brevoort, p. 53, Q. 13.

The defendants' patent expressly admits this mode of opening of the shoe, saying of the Packard shoe:

"Its chief point of superiority is, however, the facil-
"ity with which the shoe having this construction may
"be put upon the foot, as it opens much wider in front
"than the ordinary pattern, which is always difficult to
"put on."

(4) But, again, it may be urged that the defendants' shoe differs from that of Evory & Heston, because in the Evory & Heston shoe the part of the "flap" which is attached to the quarter is a separate piece of material, sewed to the front line of the quarter; whereas, in the Packard shoe the corresponding part of the flap is an integral part of, or extension of the quarter from the same piece of material.

But this difference is plainly immaterial.

Mr. Brevoort points out that this variation does "not

alter the substantial construction of the shoe" (p. 25 and p. 53, Q. 12). A variation from Evory & Heston's shoe of precisely the same character was made in defendant's shoe, in the case of Evory vs. Candee (Brevoort, p. 53, Q. 12; 2 Fed. Rep., pp. 543 and 684), but was then ruled by the Court, not to escape the complainant's patent.

On cross-examination the defendant's expert, Spencer, in substance admits that this feature of difference does not materially affect the character of the shoe (p. 45, x-Q. 42).

All points of difference between the Evory & Heston and Packard shoes fail, therefore, to avail the defendants, and their shoe clearly infringes.

THIRD POINT.

Complainant's patent is valid, notwithstanding the prior references.

The sole patents relied on by the defendants are the English Patents of Norris, No. 185, of 1856 (Supplemental Record, pp. 7–12), and of Norris and Rogers, No. 194 of 1860 (Sup. R., pp. 1–6; the United States Patent of Babbitt of 1865 (R., pp. 58–60), and Brown and Nooden, August 1, 1865 (R., pp. 62–63).

The patent of Babbitt and the patent of Brown and Wooden were not cited or relied upon in defendant's answer, and when offered in evidence were duly objected to for that reason (R., p. 38, fol. 54).

They show openings and flaps at the *heels*, and are expressly disclaimed in the Evory & Heston patent.

They need no extended consideration.

More stress was laid upon the two English patents

of Norris, and Norris and Rogers, but it was not contended, even as to them, that they showed the construction of Evory and Heston, except on a very broad construction. Defendants' expert himself admitted (p. 39):

"I have, however, considered that the Evory and "Heston invention was limited to the thing specifically "described in the patent in suit, for which a limited "claim was granted, *and that if limited, as its terms "would imply, it would not embrace the exact construc-"tion of shoes shown in the two British patents, and "in the shoe-upper now shown me.*"

Mr. Brevoort (p. 49, Q. 5), is asked:

"Do you agree with the expert for the defendants, "Mr. Spencer, when he says that, in his opinion, the "Evory and Heston invention would not embrace the "construction of shoes shown in the said two British "patents of Norris?

"A. I do."

Mr. Brevoort then proceeds to point out the essential differences between the Norris shoe and that of Evory and Heston, as follows (R., p., 50 fols. 70–71):

In the Norris shoe there is inserted in the opening, between the quarter and vamp, a "gusset" which, when attached, lies wholly *within the shoes*, and is folded in a crease at the ankle. This presents serious disadvantages.

(*1*) If the "gusset" is made of thick leather, like the body of the shoe, it will make an uncomfortable fold on the inside of the shoes, and particularly just at the ankle, which is particularly subject to abrasion.

(*2*) If the gusset is of thin material it will become tucked up and wrinkled on the inside of the shoe, will not lie flat and will be equally objectionable. Neither of these difficulties are found in the plaintiff's shoe. The edges of the vamp and quarter, which are naturally of a stiff material of the shoe, abut, more or less, closely

and protect the foot from wearing, by contact with either.

(*3*) In the English shoe, inasmuch as the gusset is to lie on the inside, the quarter and vamp cannot be accurately fitted to the "last," for if the fit is accurate, there will be no room for the inside gusset.

If the fit to the "last" is not accurate the shoe will not fit the foot well.

The English shoe cannot therefore be made to fit "neatly and closely around the ankle," as expressly prescribed in the Evory and Heston patent.

(*4*) The extension pieces from the shoe proper, or gore flaps, are naturally of thinner material than the body of the shoe proper.

Hence they are less liable to keep their shape. If they are arranged in the inside of the shoe, after the "manner" shown in the English patent, they are difficult to keep smooth and flat. If "arranged" on the outside after the "manner" shown in the Evory and Heston patent, they are directly controlled and fastened and held in a neat position by the tie or buckle at their points.

The comparatively stiff parts of the shoe proper can properly hold themselves.

Both Judge SHIPMAN and Judge LOWELL approved of the correctness of these views.

Judge SHIPMAN said as follows:

"The material point of difference between this shoe "(Evory & Heston's) and the one shown in the En- "glish patent of Stephen Norris, consists in the fact "that the Norris gore folds within the shoe, while "the gores of the complainant's patent folds out- "side the shoe. If the gore of the English shoe is "made of stiff leather there is a stiff crease on each side "of the shoe, which hurts the foot. If the gore is made "of thin or pliable leather, the folds are apt to wrinkle

" and become easily displaced when the shoe is worn.
" The plaintiff's shoe avoids both difficulties."

And Judge LOWELL said as follows (R., 65–66):

" The plaintiffs are the owners of Patent No. 59,375,
" issued to two of them in 1866. The specification de-
" scribes the invention as consisting of 'a novel mode of
" 'constructing shoes and gaiters, whereby the ordinary
" 'elastic goring at the sides, and the tedious lacing up
" 'in front are both dispensed with, while at the same
" 'time the tops will expand to receive the foot and fit
" 'neatly and closely around the ankle when the shoe
" 'is on, being also water-tight to the extreme top of
" 'the shoe.'"

" The mode of obtaining these advantages is by in-
" serting at the rear of the front or vamp of the shoe a
" triangular flap or gore, and a similar gore at the front
" of the back part of the quarter. These flaps or gores
" are sewed together at their edges, and when the shoe
" is to be put on they open and admit the foot, and
" then are closed again and folded outside the shoe,
" and tied or buckled forward over the 'instep.' The
" patentees say: 'We do not claim broadly for an ex-
" 'tension—gore flap inserted in the ankle of gaiter
" 'shoes, for this is fully covered by the broad claim of
" 'Samuel Babbett's patent, issued March 7, 1865,
" * * *' and set out the advantages of their mode
" of construction. Babbett's patent was for a flap in-
" serted in the heel and carried round the foot and
" fastened at the heel again. Another patent issued to
" Brown and Wooten was for flaps inserted in the heel
" and brought round on each side of the foot. The
" English patent of Norris of 1856, shows a gore flap
" like the plaintiff's, except that it folds inside the
" shoe; but such a flap would be uncomfortable, and
" the shoe containing it would not be likely to obtain a
" market."

FOURTH POINT.

There was no error in the Master's Report.

The Master's Report was a very conservative one.

He declined to allow complainants any profits whatever, and limited the finding to the award of damages based upon an established license fee.

The material part of his report is:

"There is evidence showing that the complainants "had an established royalty for shoes made under their "patent of three cents a pair, and that they issued "licenses and sold stamps to persons who desired to "use their patent. This royalty was a fixed one, and "was paid by their licensees."

This was purely a question of fact, and the correctness or incorrectness of his ruling cannot be reviewed, unless the complete evidence which was before him is sent up, and even if it were, the finding of the Master would not be disturbed if there was any evidence upon which to base it.

The entire evidence was not filed nor is it sent up, but certain questions and answers only.

These questions and answers (R., pp. 16–17 and p. 21) fully support the findings of the Master.

There was much further evidence on the same point, which was not returned by the Master, as the defendants' request for the return of evidence only called upon him to send up certain particular questions and answers (R., p. 13, fol. 20).

So far as appears, the license or royalty stamps on *leather* goods was uniformly at the rate of three cents per pair.

It makes no difference that certain *rubber* goods were licensed for a gross sum (p. 17–18).

The defendants' goods were *leather* goods, and, hence, the three cent royalty is applicable to them.

The grant of royalties in a number of instances, in which the license fees were paid, is sufficient to justify recovery against an infringing defendant.

Burdell vs. Denig, 92 U. S., 716–720.
Sanders vs. Logan, 2 Fish., 167–170.
Livingston vs. Jones, 2 Fish., 207–210.
Judson vs. Bradford, 16 O. G., 171–174.

In *Wooster vs. Clark, 119 U. S., p. 322–326,* this Court said :

"As to the sufficiency of the proof, we see no occasion to disturb the conclusion reached by the Master on this point. The complainant proved several instances of licenses given by him to large sewing machine companies, the fees of which were regularly paid, and corresponded with the rate allowed by the Master. We think that the defendants have no occasion to complain of the amount awarded."

The Court below (COLT, J.) was entirely correct in overruling the defendant's exception and confirming the report.

It said (R. p., 67) :

"We think the finding of the Master, that the defendant should pay a certain royalty, based upon an established license fee, correct. The damage consists in not receiving the royalty which such a license would have brought. In this case the complainants have mainly sought their profit in the form of royalty. Under these circumstances, we deem the fact that one of the complainants, who made shoes for order for his retail trade, was not damaged in his business by the sale of defendants' shoes, immaterial of the question of the proper rule of damages. We have read with interest the learned brief of defendants' counsel, to the effect that only nominal damages should be found because no damages have been proved, but we think the fact that license fees were received from others and not from defendants is proof of damage."

"Defendants' exceptions overruled."